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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 78775491 |
| Applicant | Light Sciences Corporation |
| Applied for Mark | VASCULAR RECONDITIONING |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
ON APPEAL

Applicant : Light Sciences Oncology, Inc.
Serial No. : 78/775,491
Filed : December 16, 2005
Mark : VASCULAR RECONDITIONING

TM Attorney : Joanna M. Dukovcic
Law Office : 101
Docket No. : 600057.201
Date : June 12, 2007

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

APPLICANT'S APPEAL BRIEF

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I. INTRODUCTION

Applicant appeals the Examining Attorney's refusal to register the mark VASCULAR RECONDITIONING on the basis that the mark appears to be merely descriptive of "catheters" and "pharmaceuticals, namely, energy-activated compounds used for the treatment of cardiovascular systems."

The Examining Attorney has failed to meet its burden of establishing that VASCULAR RECONDITIONING is merely descriptive of catheters and energy-activated compounds used for the treatment of cardiovascular systems. The Examining Attorney relies almost exclusively on evidence that simply illustrates that the term "reconditioning" has a broad meaning incapable of describing Applicant's goods with any "degree of particularity." As such, Applicant submits that VASCULAR RECONDITIONING is not merely descriptive of its goods and is therefore registrable on the Principal Register without a showing of acquired distinctiveness.

II. PROCEDURAL HISTORY

In an Office Action dated October 23, 2006, the Examining Attorney continued and made Final the refusal to register the mark VASCULAR RECONDITIONING under Section 2(e)(1) on the grounds that the mark is merely descriptive of the identified goods. Applicant seeks registration of VASCULAR RECONDITIONING for use in connection with "catheters" in International Class 10 and "pharmaceuticals, namely, energy-activated compounds used for the treatment of cardiovascular systems" in International Class 5.

Applicant filed a request for reconsideration on January 30, 2007, which was subsequently denied by the Examining Attorney on February 28, 2007.

Applicant filed a Notice of Appeal on April 20, 2007.

III. ARGUMENT

A. VASCULAR RECONDITIONING is Not Merely Descriptive of Applicant's Goods

Applicant appeals the Examining Attorney's finding that VASCULAR RECONDITIONING is merely descriptive of "catheters" and "pharmaceuticals, namely, energy-

activated compounds used for the treatment of cardiovascular systems.” Applicant's mark is not merely descriptive because VASCULAR RECONDITIONING does not immediately convey information as to the ingredients, qualities or characteristics of the goods with any “degree of particularity.” Furthermore, a review of the evidence of record fails to establish that VASCULAR RECONDITIONING is merely descriptive of Applicant’s goods or that VASCULAR RECONDITIONING is a term in general use in the relevant market. Lastly, any doubt as to whether the mark is merely descriptive must be resolved in Applicant’s favor.

1. VASCULAR RECONDITIONING Does Not Immediately Convey Information as to the Ingredients, Qualities or Characteristics of the Goods with a “Degree of Particularity”

A mark is merely descriptive if it “*forthwith* conveys an *immediate* idea of the ingredients, qualities or characteristics of the goods.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11, 189 U.S.P.Q. 759, 765 (2d Cir. 1976) (emphasis added); *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978). Moreover, the immediate idea must be conveyed forthwith with a “degree of particularity.” *Plus Products v. Medical Modalities Assocs., Inc.*, 211 U.S.P.Q. 1199, 1204-05 (T.T.A.B. 1981). See also *In re Diet Tabs, Inc.*, 231 U.S.P.Q. 587, 588 (T.T.A.B. 1986); *Holiday Inns, Inc. v. Monolith Enters.*, 212 U.S.P.Q. 949, 952 (T.T.A.B. 1981); *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978); *Airco, Inc. v. Air Products and Chemicals, Inc.*, 196 U.S.P.Q. 832, 835 (T.T.A.B. 1977). In contrast, a term is suggestive if it requires imagination, thought or perception to reach a conclusion as to the nature of the goods or services. *TMS Corp.*, 200 U.S.P.Q. at 58 (T.T.A.B. 1983). Thus the ultimate question is whether the term VASCULAR RECONDITIONING conveys information about Applicant’s goods with the immediacy and particularity required under the law.

Applicant seeks registration of the mark VASCULAR RECONDITIONING in connection with “catheters” and “pharmaceuticals, namely, energy-activated compounds used for the treatment of cardiovascular systems.” Applicant’s catheters and energy-activated compounds

are highly specialized products used in a unique surgical procedure in which catheters are used to activate a compound through the use of a light emitting diode array. The purpose of the procedure is to prevent restenosis following intervention in the superficial femoral artery in patients with Peripheral Artery Disease (PAD) and to stabilize the formation of vulnerable plaque in patients with coronary artery disease at risk from acute coronary syndromes. This proprietary procedure is enabled by a photoreactive drug that has an affinity with atherosclerotic plaque and sites of vascular injury caused during endovascular intervention. A significant feature of the procedure is that it allows for *regional* endovascular intervention treatment, whereas prior technology, such as angioplasty and stenting, is more focused.

Applicant's procedure may be described as a minimally invasive regional endovascular intervention treatment for coronary atherosclerosis. Similarly, Applicant's goods may be described as catheters or energy activated compounds for use in a minimally invasive regional endovascular intervention treatment. The term "endovascular intervention" is a descriptive term that is used in the relevant field to describe procedures such as balloon angioplasty, stent implantation, atherectomy, endografting, laser angioplasty, and thrombolysis. Likewise, the terms "regional" and "minimally invasive" may be descriptive of the nature of Applicant's proprietary procedure.

The term VASCULAR RECONDITIONING, on the other hand, is not descriptive of Applicant's procedure or the goods used therein. The term VASCULAR RECONDITIONING does not immediately convey with any "degree of particularity" significant features, qualities or characteristics of applicant's goods (e.g. catheters having a diode array or compounds having an affinity with atherosclerotic plaque) or the purpose for which such goods are used (i.e. to prevent restenosis following intervention in the superficial femoral artery and to stabilize the formation of vulnerable plaque). The term VASCULAR RECONDITIONING is simply too vague to describe Applicant's highly specialized goods with any "degree of particularity" and therefore fails to be merely descriptive.

In contrast, the Examining Attorney argues that VASCULAR RECONDITIONING is merely descriptive of Applicant's goods because the purpose of the goods is "bringing blood vessels into a good condition." However, under this broad and nebulous description, VASCULAR RECONDITIONING would similarly describe other surgical procedures (as well as non-surgical procedures) to repair the vascular system, such as stents and angioplasty. If the term VASCULAR RECONDITIONING were in fact merely descriptive as applied to Applicant's goods or competitors' similar goods, we would expect to see more numerous and more clearly descriptive uses of VASCULAR RECONDITIONING in the press and literature. The lack of evidence showing third-party use of VASCULAR RECONDITIONING to describe any vascular procedure supports the conclusion that VASCULAR RECONDITIONING is not merely descriptive of Applicant's goods.

2. VASCULAR RECONDITIONING Has No Dictionary Definition, Is Not Generally Used to Describe Applicant's Goods, and Is Not Used in the Medical Industry

If a composite mark has no dictionary meaning, is not generally used to describe the types of goods identified in the application, and is not used in the relevant industry, the mark is not merely descriptive. *In re Harrington*, 219 U.S.P.Q. 854 (T.T.A.B. 1983). In *Harrington*, the Examining attorney refused to register the mark COLLEGE ACADEMY under Section 2(e)(1) of the Trademark Act claiming that the mark was merely descriptive of "educational services, namely, providing special summer learning programs for gifted and talented children in grades 4 to 8." *Id.* at 854-55. It was conceded that the terms "college" and "academy" each had a commonly understood meaning in the field of education; indeed, the COLLEGE ACADEMY programs were held at Holy Cross *College* and Stonehill *College*. *Id.* at 855.

The Board found, however, that the composite term "college academy" was "not a term in general use to describe educational services (or anything else, for that matter)," had no dictionary meaning, and was "rather nebulous," and considered it significant that no evidence had been produced showing use of the composite term in the academic field. *Id.* at 855-56. The Board

therefore held COLLEGE ACADEMY was not merely descriptive of the applicant's services, and accordingly reversed the refusal. *Id.* at 856. In its analysis, the Board instructed "[t]here is nothing necessarily debilitating about a mark's consisting of a combination of generic or descriptive terms provided that the combination is not also generic or descriptive." *Id.* at 855.

Turning to the present case, the term VASCULAR RECONDITIONING has no dictionary meaning, is not generally used to describe the types of goods identified in the application, and is not used in the medical industry. In fact, the only evidence containing use of the composite term VASCULAR RECONDITIONING is Applicant's own website (VSI-1 to VSI-2, October 23, 2006 Office Action) and an article referencing Applicant's wholly owned subsidiary (angiogenes-1 to angiogenes-2, June 21, 2006 Office Action). The record simply does not provide any evidence of third-party use of VASCULAR RECONDITIONING in a descriptive manner and therefore fails to establish that VASCULAR RECONDITIONING is merely descriptive of Applicant's goods.

3. A Review of the Evidence Does Not Support the Contention that VASCULAR RECONDITIONING Is Merely Descriptive

Apart from the definitions of "vascular" and "reconditioning," the evidence of record falls into the following categories: (a) evidence showing use of "reconditioning" as an independent term; (b) evidence establishing that vascular catheters are a species of catheters; and (c) evidence of Applicant's use of VASCULAR RECONDITIONING as a brand.

a) Use of "Reconditioning" as an Independent Term

The bulk of the Examining Attorney's evidence is directed at the use of "reconditioning" as an independent term and provides little evidence beyond that embodied in the definition. In the medical field, the sole term "reconditioning" may be used in a *general* sense, consistent with its definition, to describe repairing the condition of various body parts. For example, the Examining Attorney provided a reference regarding a presentation on Tinnitus stating, "This supposition reflects the fact that habituation is basically a *reconditioning* of connections within subcortical centers, and this process cannot occur if the stimulus (tinnitus) is absent."

(Subcortica-8, October 23, 2006 Office Action). Such use of “reconditioning,” however, would not be threatened by registration of the mark VASCULAR RECONDITIONING as registration would extend to the composite mark and not to the individual words “vascular” and “reconditioning.” *See Airco, Inc. v. Air Products and Chemicals, Inc.*, 196 U.S.P.Q. 832, 835 (T.T.A.B. 1977) (noting that applicant’s registration of AIR-CARE would not extend to the words “air” and “care,” per se, and thus would not interfere with a competitor’s right to use either term individually to describe its goods). Applicant is not seeking registration of “reconditioning” apart from the mark as shown, but is seeking registration of the composite mark VASCULAR RECONDITIONING for which there is no evidence of use in the medical field. Applicant submits that general use of the term “reconditioning” is insufficient to show that VASCULAR RECONDITIOING is merely descriptive of its goods.

b) Vascular Catheters are a Species of Catheters

In a June 21, 2006 Office Action, the Examining Attorney provided evidence to support the contention that vascular catheters are a species of catheters (*see* meditheses-1 to meditheses-16; briantree-1 to briantree-2; criver-1 to criver-2; and medscape-1 to medscape-3). Applicant does not dispute this contention and readily admits that its catheters are used in a highly specialized surgical procedure involving the vascular system. The fact that Applicant’s catheters are associated with a specialized procedure involving the vascular system, however, does little to close the gap between the vague information conveyed by the term VASCULAR RECONDITIONING and the actual characteristics of Applicant’s catheters (e.g. a light emitting diode array) or the purpose of the catheters (i.e. to activate a energy-activated compound in an effort to prevent restenosis following intervention in the superficial femoral artery and to stabilize the formation of vulnerable plaque). As such, this evidence does not support the contention that VASCULAR RECONDITIONING is merely descriptive of Applicant’s goods.

c) Applicant's Use of VASCULAR RECONDITIONING as a Trademark

In an October 23, 2006 Office Action, the Examining Attorney provided an excerpt from Applicant's website showing use of VASCULAR RECONDITIONING as a trademark (VRI-1 to VRI-2). In the excerpt, Applicant claims that it has "defined the term Vascular Reconditioning™ to represent the combined anti-restenotic and anti-atherosclerotic activity that Light Infusion Technology™ may provide in these important disease areas." Capitalization of the leading letters "V" and "R" and the inclusion of the trademark symbol indicate the trademark nature of Applicant's use. In addition, the website excerpt begins with a highly stylized version of Applicant's mark and concludes with Applicant explicitly identifying VASCULAR RECONDITIONING as "a proprietary mark of Vascular Reconditioning, Inc."

The Examining Attorney appears to rely exclusively on one single inadvertent use of VASCULAR RECONDITIONING without leading capitalization and the trademark symbol as evidence of mere descriptiveness. With respect to this inadvertent use, Applicant has been advised to alter the phrase to clarify that VASCULAR RECONDITIONING is a coined term serving as Applicant's trademark. In addition, such use has been removed from Applicant's website. Applicant submits that one inadvertent use of VASCULAR RECONDITIONING in an arguably descriptive manner is insufficient to establish that VASCULAR RECONDITIONING is merely descriptive of Applicant's goods. This is especially true given the complete lack of evidence regarding third-party use of VASCULAR RECONDITIONING to describe any process or procedure for the purpose of "bringing blood vessels into a good condition."

In sum, the Examining Attorney has failed to meet its burden of establishing that the composite term VASCULAR RECONDITIONING is merely descriptive. The composite term VASCULAR RECONDITIONING is not a recognized term in the medical industry, is not defined in the dictionary, and is too nebulous to define Applicant's goods with any "degree of particularity." Accordingly, VASCULAR RECONDITIONING is not merely descriptive of

Applicant's goods, and thus is registrable on the Principal Register without a showing of acquired distinctiveness.

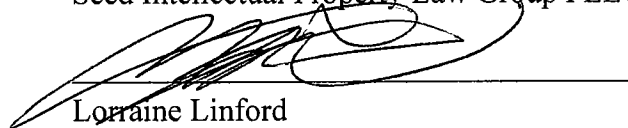
4. Doubts Must Be Resolved in Applicant's Favor

Lastly, to the extent there is doubt about whether VASCULAR RECONDITIONING is merely descriptive of Applicant's goods, such doubt must be resolved in Applicant's favor. *In re Grand Forest Holdings Inc.*, 78 U.S.P.Q. 2d 1152, 1156 (T.T.A.B. 2006) (citing *In re Grand Metro. Foodservice Inc.*, 30 U.S.P.Q. 2d 1974, 1976 (T.T.A.B. 1994)).

IV. CONCLUSION

Applicant therefore respectfully requests that the Board reverse the Examining Attorney's findings and approve Applicant's mark for publication.

Respectfully submitted,
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ABERCROMBIE & FITCH COMPANY,
Plaintiff-Appellant,

v.

HUNTING WORLD, INCORPORATED,
Defendant-Appellee.

No. 21, Docket 74-2540.

United States Court of Appeals,
 Second Circuit.

Argued Sept. 18, 1975.

Decided Jan. 16, 1976.

Opinion on Limited Rehearing
 Feb. 26, 1976.

Store owner brought suit against competitor alleging infringement of registered trademarks using the word "Safari" on garments and other articles. The United States District Court for the Southern District of New York, Sylvester J. Ryan, J., dismissed the complaint and cancelled all plaintiff's trademark registrations for "Safari," and plaintiff appealed. The Court of Appeals, Friendly, Circuit Judge, held that as applied to specific types of clothing, "Safari" has become a generic term and "Minisafari" may be used for a smaller brim hat; that "Safari" has not become a generic term for boots, or shoes—it is either "suggestive" or "merely descriptive" and is a valid trademark even if "merely descriptive" since it has become incontestable under the Lanham Act; that in light of the lower court's justified finding that "Camel Safari," "Hippo Safari" and "Safari Chukka" are devoted by defendant to a purely descriptive use on its boots, defendant has a defense against a charge of infringement with respect to those terms on the basis of "fair use"; but that cancellation should have been directed only with respect to trademark No. 358,751 and portions of No. 703,279 and the New York registration.

Affirmed in part, reversed in part and remanded.

1. Trade Regulation ⇌ 13, 23, 24, 25

Arrayed in an ascending order roughly reflecting their eligibility to trademark sta-

tus and the degree of protection accorded, the categories of terms are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful, but the lines of demarcation are not always bright.

2. Trade Regulation ⇌ 12

The difficulties in labeling a trademark term as generic, descriptive, suggestive or arbitrary or fanciful are compounded because a term that is in one category for a particular product may be in quite a different one for another, because the term may shift from one category to another in light of differences in usage through time, because a term may have one meaning to one group of users and a different one to others, and because the same term may be put to different uses with respect to a single product.

3. Trade Regulation ⇌ 23

A generic term, one that is not entitled to trademark protection, is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species.

4. Trade Regulation ⇌ 13, 23, 164, 167

At common law, neither those terms which were generic nor those which were merely descriptive could become valid trademarks; and the same was true under the Trademark Act of 1905, except for marks which had been the subject of exclusive use of ten years prior to its enactment.

5. Trade Regulation ⇌ 168

While the Lanham Act makes an important exception with respect to those merely descriptive terms which have acquired secondary meaning, it has offered no such exception for generic marks. Lanham Trade-Mark Act, § 2(f), 15 U.S.C.A. § 1052(f).

6. Trade Regulation ⇌ 282

Under the Lanham Act, cancellation is provided for a registered mark if at any time it becomes the common descriptive name of an article or substance. Lanham

Trade-Mark Act, § 14(c), 15 U.S.C.A. § 1064(c).

7. Trade Regulation ⇌168

Even proof of secondary meaning, by virtue of which some "merely descriptive" marks may be registered, cannot transform a generic term into a subject for trademark. Lanham Trade-Mark Act, § 14(c), 15 U.S.C.A. § 1064(c).

8. Trade Regulation ⇌167

No matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name; that is, it is impossible to achieve trademark protection for a generic term.

9. Trade Regulation ⇌10, 23

When a suggestive or fanciful term has become generic as a result of a manufacturer's advertising efforts, trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue; thus, a term may be generic in one market and descriptive or suggestive or fanciful in another.

10. Trade Regulation ⇌25

The category of "suggestive" marks was spawned by the felt need to accord protection to trademarks that were neither exactly descriptive on the one hand nor truly fanciful on the other.

11. Trade Regulation ⇌25

Reason for restricting the trademark protection accorded descriptive terms, namely, the undesirability of preventing an entrant from using a descriptive term for his product, is much less forceful when the trademark is a suggestive word.

12. Trade Regulation ⇌25

If a term is suggestive, it is entitled to trademark registration without proof of secondary meaning.

13. Trade Regulation ⇌254

Decision of the patent office to register a mark without requiring proof of secondary meaning affords a rebuttable presumption that the mark is suggestive or arbitrary or fanciful, rather than merely descriptive.

14. Trade Regulation ⇌24

The term "fanciful," as a classifying concept in trademark law, is usually applied to words invented solely for their use as trademarks; when the same legal consequence is attached to a common word, i. e., when it is applied in an unfamiliar way, the use is called "arbitrary."

15. Trade Regulation ⇌23

Applied to specific types of clothing, "Safari" has become a generic term and "Minisafari" may be used for a smaller brim hat.

16. Trade Regulation ⇌167

The term "Safari" has not become a generic term for boots or shoes—it is either "suggestive" or "merely descriptive" and is a valid trademark even if "merely descriptive" since it has become incontestable under the Lanham Act. Lanham Trade-Mark Act, § 15, 15 U.S.C.A. § 1065.

17. Trade Regulation ⇌375

In light of the lower court's justified finding that "Camel Safari," "Hippo Safari" and "Safari Chukka" were devoted by defendant to a purely descriptive use on its boots, defendant had a defense against a charge of infringement with respect to those terms on the basis of "fair use." Lanham Trade-Mark Act, § 33(b)(4), 15 U.S.C.A. § 1115(b)(4).

18. Trade Regulation ⇌23

A word for which trademark protection is sought may have more than one generic use.

19. Trade Regulation ⇌23

Describing publication as a "Safariland Newsletter," containing bulletins as to safari activity in Africa, was clearly a generic use which is nonenjoinable.

20. Trade Regulation ⇨361

Storeowner, which brought suit alleging infringement by defendant competitor of some of plaintiff's registered trademarks using the term "Safari," was not entitled to an injunction against defendant's use of the word in advertising goods of the kind included in a safari outfit; and if defendant could advertise a hat of the kind worn on safaris as a safari hat, it could also advertise a similar hat with a smaller brim as a minisafari; further, the principle against giving trademark protection to a generic term also sustained the denial of an injunction against defendant's use of "Safariland" as the name of a portion of its store devoted at least in part to the sale of clothing as to which the term "Safari" has become generic.

21. Trade Regulation ⇨251

Since plaintiff's registration of "Safari" for use on its shoes had become incontestable, it was immaterial, save for defendant's rejected contention of fraud, whether plaintiff's use of "Safari" for boots was "suggestive" or "merely descriptive." Lanham Trade-Mark Act, § 15, 15 U.S.C.A. § 1065.

22. Trade Regulation ⇨375

Under the Lanham Act, the "fair use" defense is offered even as against marks that have become incontestable when the use of the term charged to be an infringement is not a trademark use and it is used fairly and in good faith only to describe to users the goods and services of such party, or their geographic origin. Lanham Trade-Mark Act, § 33(b)(5), 15 U.S.C.A. § 1115(b)(4).

23. Trade Regulation ⇨584

Since parent company of store charged with infringing plaintiff's registered "Safari" trademarks had been primarily engaged in arranging safaris to Africa since 1959, since the president of both companies had authored a book on safaris published in 1959, and since he had, from 1961, booked persons on safaris as well as purchased safari clothing in Africa for resale in America, those facts sufficed to establish, absent a contrary showing, that defendant's use of

"Safari" with respect to boots was made in the context of hunting and traveling expeditions and not as an attempt to garner plaintiff's good will.

24. Trade Regulation ⇨348

When a plaintiff has chosen a mark with some descriptive qualities, he cannot altogether exclude some kinds of competing uses even when the mark is properly on the register.

25. Trade Regulation ⇨282

When a term becomes the generic name of the product to which it is applied, grounds for cancellation exist. Lanham Trade-Mark Act, §§ 14(c), 15(3, 4), 37, 15 U.S.C.A. §§ 1064(c), 1065(3, 4), 1119.

26. Trade Regulation ⇨264

Scheme of the Lanham Act forbids a denial of incontestability to a "merely descriptive" mark which would otherwise have become incontestable under the Act on the basis of a mere allegation of fraud in obtaining registration, without supporting proof. Lanham Trade-Mark Act, §§ 14, 15, 15 U.S.C.A. §§ 1064, 1065.

27. Trade Regulation ⇨282

Neither the trademark "Safari," as applied to ice chests, axes, tents and smoking tobacco, nor the mark "Safari Mills," as applied to cotton piece goods, should have been cancelled, as said marks were arbitrary, not descriptive.

28. Trade Regulation ⇨254, 282

Cancellation of plaintiff's "Safari" trademark should have been directed, on the ground that the mark had become the common descriptive name of the article, only with respect to trademark No. 358,751 and portions of No. 703,279 and the New York registration; with respect to the remaining registrations, plaintiff was entitled to the Lanham Act benefits that registration shall be prima facie evidence of the validity of the registration and of the registrant's exclusive right to use the mark in commerce; and in the case of registrations that had become incontestable, plaintiff was entitled to the further benefits accorded by the Act. Lanham Trade-Mark Act, §§ 7(b), 33(a, b), 15 U.S.C.A. §§ 1057(b), 1115(a, b).

Richard H. Wels, New York City (Moss, Wels & Marcus, New York City, of counsel), for defendant-appellee.

Roy C. Hopgood, New York City (Paul H. Blaustein, and Hopgood, Calimafde, Kalil, Blaustein & Lieberman, New York City, of counsel), for plaintiff-appellant.

Before FRIENDLY, TIMBERS and GURFEIN, Circuit Judges.

FRIENDLY, Circuit Judge:

This action in the District Court for the Southern District of New York by Abercrombie & Fitch Company (A&F), owner of well-known stores at Madison Avenue and 45th Street in New York City and seven places in other states,¹ against Hunting World, Incorporated (HW), operator of a competing store on East 53rd Street, is for infringement of some of A&F's registered

| Trademark | Number | Issued | Goods |
|---------------------------|---------|---------|----------------------------------------------------|
| Safari | 358,781 | 7/26/38 | Men's and Women's outer garments, including hats. |
| Safari Mills ² | 125,531 | 5/20/19 | Cotton Piece goods. |
| Safari | 652,098 | 9/24/57 | Men's and Women's outer garments, including shoes. |
| Safari | 703,279 | 8/23/60 | Woven cloth, sporting goods, apparel, etc. |

A&F has spent large sums of money in advertising and promoting products identified with its mark 'Safari' and in policing its right in the mark, including the successful conduct of trademark infringement suits. HW, the complaint continued, has engaged in the retail marketing of sporting apparel including hats and shoes, some identified by use of 'Safari' alone or by expressions such as 'Minisafari' and 'Safariland'. Continuation of HW's acts would confuse and deceive the public and impair "the distinct and unique quality of the plaintiff's trademark." A&F sought an injunction against infringement and an accounting for damages and profits.

HW filed an answer and counterclaim. This alleged, *inter alia*, that "the word 'sa-

faris' is an ordinary, common, descriptive, geographic, and generic word" which "is commonly used and understood by the public to mean and refer to a journey or expedition, especially for hunting or exploring in East Africa, and to the hunters, guides, men, animals, and equipment forming such an expedition" and is not subject to exclusive appropriation as a trademark. HW sought cancellation of all of A&F's registrations using the word 'Safari' on the ground that A&F had fraudulently failed to disclose the true nature of the term to the Patent Office.

I.

The complaint, filed in January, 1970, after describing the general nature of A&F's business, reflecting its motto "The Greatest Sporting Goods Store in the World," alleged as follows: For many years A&F has used the mark 'Safari' on articles "exclusively offered and sold by it." Since 1936 it has used the mark on a variety of men's and women's outer garments. Its United States trademark registrations include:

fari' is an ordinary, common, descriptive, geographic, and generic word" which "is commonly used and understood by the public to mean and refer to a journey or expedition, especially for hunting or exploring in East Africa, and to the hunters, guides, men, animals, and equipment forming such an expedition" and is not subject to exclusive appropriation as a trademark. HW sought cancellation of all of A&F's registrations using the word 'Safari' on the ground that A&F had fraudulently failed to disclose the true nature of the term to the Patent Office.

HW having moved for summary judgment, Judge Lasker granted this only in part, 327 F.Supp. 657 (S.D.N.Y.1971). He held, 327 F.Supp. at 662, that:

1. A&F also conducts a substantial mail order business.

2. The mark 'Safari Mills' was acquired by assignment from the original registrant, Robert Suffern.

Although "safari" is a generic word, a genuine issue of fact exists as to whether the plaintiff has created a secondary meaning in its use of the word "identifying the source" and showing that "purchasers are moved to buy it because of its source."

On the other hand, he concluded that A&F had no right to prevent HW from using the word 'Safari' to describe its business as distinguished from use in the sale of a particular product³—a conclusion we do not understand to be disputed; that HW had not infringed A&F's registered mark using the word 'Safari' under its brand name on a "classical safari hat" or in advertising this as "The Hat for Safari" since such use was purely descriptive, 327 F.Supp. at 664; that HW had also not infringed by using the term 'Minisafari' as a name for its narrower brimmed safari hats, and that HW was entitled to use the word 'Safariland' as the description of an area within its shop and as the name of a corporation engaged in the wholesale distribution of products imported from East Africa by an affiliate, Lee Expeditions, Ltd., and in the "Safariland News," a newsletter issued by HW and Lee Expeditions, 327 F.Supp. at 664-65. With respect to shoes he concluded that both parties had used the word 'Safari' in a fanciful rather than a descriptive sense and hence that plaintiff might have a valid infringement claim if it could establish a secondary meaning, 327 F.Supp. at 665.

On A&F's appeal this court reversed and remanded for trial, 461 F.2d 1040 (2 Cir. 1972). Most of Judge Thomsen's opinion

for the court concerned the issue of appealability, as did most of Judge Timbers' concurring opinion and all of Judge Feinberg's dissent. Intimating no opinion on the ultimate merits, this court concluded "that genuine issues of fact exist which made it improper to enter a summary judgment finally denying even in part the injunctive relief sought by plaintiff." *Id.* at 1042.

Judge Ryan, before whom the action was tried on remand, ruled broadly in HW's favor. He found there was frequent use of the word 'Safari' in connection with wearing apparel, that A&F's policing efforts thus had evidently been unsuccessful, and that A&F had itself used the term in a descriptive sense not covered by its registration, e. g., in urging customers to make a "Christmas Gift Safari" to the A&F store. After referring to statements by Judge Lasker that 'Safari' was a "weak" mark, 327 F.Supp. at 663, the judge found the mark to be invalid. 'Safari,' the court held, "is merely descriptive and does not serve to distinguish plaintiff's goods as listed on the registration from anybody else's"; while such terms are afforded protection by the Lanham Act if they come to identify the company merchandising the product, rather than the product itself, A&F had failed to establish that this had become the situation with respect to 'Safari'.⁴ The opinion did not discuss A&F's assertion that some of its marks had become incontestable under § 15 of the Lanham Act, 15 U.S.C. § 1065. The court entered a judgment which dismissed the complaint and canceled not only the four registered trademarks in suit but all A&F's other registered 'Safari' trademarks.⁵ A&F has appealed.

3. He noted that HW had grown "from the operation of a company which actually organizes safaris and has common officers with that company," 327 F.Supp. at 663.

4. This finding—that A&F did not establish "secondary meaning" for its marks—is not here disputed.

5. There were, in addition to Nos. 358,781, 125,531, 652,098, and 703,279, *supra*, also plaintiff's

New York Registration No. R-8008 (for 'Safari' applied to sporting goods apparel) and the following United States Registrations for 'Safari' not relied on by A&F in its complaint: 768,332 (luggage); 770,336 (portable grills); 777,180 (insulated ice chests); 779,394 (camping tents); 803,036 (axes); 856,889 (smoking tobacco).

The judgment also enjoined HW from using the letters 'T.M.' and 'R.' after the terms 'Minisafari Hat' and 'Safariland'—a ruling from which HW has not appealed.

II.

It will be useful at the outset to restate some basic principles of trademark law, which, although they should be familiar, tend to become lost in a welter of adjectives.

[1,2] The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. The lines of demarcation, however, are not always bright. Moreover, the difficulties are compounded because a term that is in one category for a particular product may be in quite a different one for another,⁶ because a term may shift from one category to another in light of differences in usage through time,⁷ because a term may have one meaning to one group of users and a different one to others,⁸ and because the same term may be put to different uses with respect to a single product.⁹ In various ways, all of these complications are involved in the instant case.

[3-9] A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species. At common law neither those terms which were generic nor those which were merely descriptive could become valid trademarks, see *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323, 20 L.Ed. 581 (1872) ("Nor can a generic name, or a name merely descriptive of an article or its qualities, ingredients, or characteristics, be employed as a

trademark and the exclusive use of it be entitled to legal protection"). The same was true under the Trademark Act of 1905, *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446, 31 S.Ct. 456, 55 L.Ed. 536 (1911), except for marks which had been the subject of exclusive use for ten years prior to its enactment. 33 Stat. 726.¹⁰ While, as we shall see, p. 10 *infra*, the Lanham Act makes an important exception with respect to those merely descriptive terms which have acquired secondary meaning, see § 2(f), 15 U.S.C. § 1052(f), it offers no such exception for generic marks. The Act provides for the cancellation of a registered mark if at any time it "becomes the common descriptive name of an article or substance," § 14(c). This means that even proof of secondary meaning, by virtue of which some "merely descriptive" marks may be registered, cannot transform a generic term into a subject for trademark. As explained in *J. Kohnstam, Ltd. v. Louis Marx and Company*, 280 F.2d 437, 440, 47 CCPA 1080 (1960), no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name. See, accord, *Application of Preformed Line Products Co.*, 323 F.2d 1007, 51 CCPA 775 (1963); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 48 CCPA 1004 (1961); *Application of Searle & Co.*, 360 F.2d 650, 53 CCPA 1192 (1966). We have recently had occasion to apply this doctrine of the impossibility of achieving trademark protection for a generic term, *CES Publishing Corp. v. St. Regis*

6. To take a familiar example "Ivory" would be generic when used to describe a product made from the tusks of elephants but arbitrary as applied to soap.

7. See, e. g., *Haughton Elevator Co. v. Seeger*, 85 U.S.P.Q. 80 (1950), in which the coined word 'Escalator', originally fanciful, or at the very least suggestive, was held to have become generic.

8. See, e. g., *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y.1921).

9. See 15 U.S.C. § 1115(b)(4).

10. Some protection to descriptive marks which had acquired a secondary meaning was given by the law of unfair competition. The Trademark Act of 1920 permitted registration of certain descriptive marks which had acquired secondary meaning, see *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 59 S.Ct. 191, 83 L.Ed. 195 (1938).

Publications, Inc., 531 F.2d 11 (1975). The pervasiveness of the principle is illustrated by a series of well known cases holding that when a suggestive or fanciful term has become generic as a result of a manufacturer's own advertising efforts, trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue. *Bayer Co. v. United Drug Co.*, 272 F. 505 (2 Cir. 1921) (L. Hand, D. J.); *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2 Cir.) (A. N. Hand, C. J.), cert. denied, 299 U.S. 601, 57 S.Ct. 194, 81 L.Ed. 443 (1936); *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577 (2 Cir. 1963). A term may thus be generic in one market and descriptive or suggestive or fanciful in another.

The term which is descriptive but not generic¹¹ stands on a better basis. Although § 2(e) of the Lanham Act, 15 U.S.C. § 1052, forbids the registration of a mark which, when applied to the goods of the applicant, is "merely descriptive," § 2(f) removes a considerable part of the sting by providing that "except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce" and that the Commissioner may accept, as prima facie evidence that the mark has become distinctive, proof of substantially exclusive and continuous use of the mark applied to the applicant's goods for five years preceding the application. As indicated in the cases cited in the discussion of the unregistrability of generic terms, "common descriptive name," as used in §§ 14(c) and 15(4), refers to generic terms applied to products and not to terms that are "merely descriptive."

11. See, e. g., *W. E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656 (2 Cir. 1970). A commentator has illuminated the distinction with an example of the "Deep Bowl Spoon":

"Deep Bowl" identifies a significant characteristic of the article. It is "merely descriptive" of the goods, because it informs one that they are deep in the bowl portion . . . It is not, however, "the common

In the former case any claim to an exclusive right must be denied since this in effect would confer a monopoly not only of the mark but of the product by rendering a competitor unable effectively to name what it was endeavoring to sell. In the latter case the law strikes the balance, with respect to registration, between the hardships to a competitor in hampering the use of an appropriate word and those to the owner who, having invested money and energy to endow a word with the good will adhering to his enterprise, would be deprived of the fruits of his efforts.

[10-13] The category of "suggestive" marks was spawned by the felt need to accord protection to marks that were neither exactly descriptive on the one hand nor truly fanciful on the other—a need that was particularly acute because of the bar in the Trademark Act of 1905, 33 Stat. 724, 726, (with an exceedingly limited exception noted above) on the registration of merely descriptive marks regardless of proof of secondary meaning. See *Orange Crush Co. v. California Crushed Fruit Co.*, 54 U.S.App. D.C. 313, 297 F. 892 (1924). Having created the category the courts have had great difficulty in defining it. Judge Learned Hand made the not very helpful statement:

It is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends where suggestion ends and description begins.

Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc., 297 F. 247, 248 (2 Cir. 1923), aff'd per curiam, 4 F.2d 1018 (2 Cir. 1925)—a statement amply confirmed by comparing the list of terms held suggestive with those held merely descriptive in 3 Callmann, Unfair Competition, Trademarks and

descriptive name" of the article [since] the implement is not a deep bowl, it is a spoon . . . "Spoon" is not merely descriptive of the article—it identifies the article—[and therefore] the term is generic.

Fletcher, Actual Confusion as to Incontestability of Descriptive Marks, 64 Trademark Rep. 252, 260 (1974). On the other hand, "Deep Bowl" would be generic as to a deep bowl.

Monopolies § 71.2 (3d ed.). Another court has observed, somewhat more usefully, that:

A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.

Stix Products, Inc. v. United Merchants & Manufacturers Inc., 295 F.Supp. 479, 488 (S.D.N.Y.1968)—a formulation deriving from *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4 Cir. 1940). Also useful is the approach taken by this court in *Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp.*, 259 F.2d 314 (2 Cir. 1958), that the reason for restricting the protection accorded descriptive terms, namely the undesirability of preventing an entrant from using a descriptive term for his product, is much less forceful when the trademark is a suggestive word since, as Judge Lumbard wrote, 259 F.2d at 317:

The English language has a wealth of synonyms and related words with which to describe the qualities which manufacturers may wish to claim for their products and the ingenuity of the public relations profession supplies new words and slogans as they are needed.

If a term is suggestive, it is entitled to registration without proof of secondary meaning. Moreover, as held in the *Season-All* case, the decision of the Patent Office to register a mark without requiring proof of secondary meaning affords a rebuttable presumption that the mark is suggestive or arbitrary or fanciful rather than merely descriptive.

[14] It need hardly be added that fanciful or arbitrary terms¹² enjoy all the rights accorded to suggestive terms as marks—without the need of debating whether the

12. As terms of art, the distinctions between suggestive terms and fanciful or arbitrary terms may seem needlessly artificial. Of course, a common word may be used in a fanciful sense; indeed one might say that only a common word can be so used, since a coined word cannot first be put to a bizarre use.

term is “merely descriptive” and with ease of establishing infringement.

In the light of these principles we must proceed to a decision of this case.

III.

[15–17] We turn first to an analysis of A&F's trademarks to determine the scope of protection to which they are entitled. We have reached the following conclusions: (1) applied to specific types of clothing ‘safari’ has become a generic term and ‘mini-safari’ may be used for a smaller brim hat; (2) ‘safari’ has not, however, become a generic term for boots or shoes; it is either “suggestive” or “merely descriptive” and is a valid trademark even if “merely descriptive” since it has become incontestable under the Lanham Act; but (3) in light of the justified finding below that ‘Camel Safari,’ ‘Hippo Safari’ and ‘Safari Chukka’ were devoted by HW to a purely descriptive use on its boots, HW has a defense against a charge of infringement with respect to these on the basis of “fair use.” We now discuss how we have reached these conclusions.

[18] It is common ground that A&F could not apply ‘Safari’ as a trademark for an expedition into the African wilderness. This would be a clear example of the use of ‘Safari’ as a generic term. What is perhaps less obvious is that a word may have more than one generic use. The word ‘Safari’ has become part of a family of generic terms which, although deriving no doubt from the original use of the word and reminiscent of its milieu, have come to be understood not as having to do with hunting in Africa, but as terms within the language referring to contemporary American fashion apparel. These terms name the components of the safari outfit well-known to the clothing industry and its customers: the ‘Safari hat’, a broad flat-brimmed hat with

Nevertheless, the term “fanciful”, as a classifying concept, is usually applied to words invented solely for their use as trademarks. When the same legal consequences attach to a common word, i. e., when it is applied in an unfamiliar way, the use is called “arbitrary.”

a single, large band; the 'Safari jacket', a belted bush jacket with patch pockets and a buttoned shoulder loop; when the jacket is accompanied by pants, the combination is called the 'Safari suit'. Typically these items are khaki-colored.

This outfit, and its components, were doubtless what Judge Ryan had in mind when he found that "the word 'safari' in connection with wearing apparel is widely used by the general public and people in the trade." The record abundantly supports the conclusion that many stores have advertised these items despite A&F's attempts to police its mark. In contrast, a search of the voluminous exhibits fails to disclose a single example of the use of 'Safari', by anyone other than A&F and HW, on merchandise for which A&F has registered 'Safari' except for the safari outfit and its components as described above.

[19,20] What has been thus far established suffices to support the dismissal of the complaint with respect to many of the uses of 'Safari' by HW. Describing a publication as a "Safariland Newsletter", containing bulletins as to safari activity in Africa, was clearly a generic use which is nonenjoinable, see *CES Publishing Co. v. St. Regis Publications, Inc.*, *supra*. A&F also was not entitled to an injunction against HW's use of the word in advertising goods of the kind included in the safari outfit as described above. And if HW may advertise a hat of the kind worn on safaris as a safari hat, it may also advertise a similar hat with a smaller brim as a minisafari. Although the issue may be somewhat closer, the principle against giving trademark protection to a generic term also sustains the denial of an injunction against HW's use of 'Safariland' as a name of a portion of its store devoted at least in part to the sale of clothing as to which the term 'Safari' has become generic.

[21] A&F stands on stronger ground with respect to HW's use of 'Camel Safari', 'Hippo Safari' and Chukka 'Safari' as names for boots imported from Africa. As already indicated, there is no evidence that 'Safari' has become a generic term for boots. Since, as will appear, A&F's regis-

tration of 'Safari' for use on its shoes has become incontestable, it is immaterial (save for HW's contention of fraud which is later rejected) whether A&F's use of 'Safari' for boots was suggestive or "merely descriptive."

[22] HW contends, however, that even if 'Safari' is a valid trademark for boots, it is entitled to the defense of "fair use" within § 33(b)(4) of the Lanham Act, 15 U.S.C. § 1115(b)(4). That section offers such a defense even as against marks that have become incontestable when the term charged to be an infringement is not used as a trademark "and is used fairly and in good faith only to describe to users the goods and services of such party, or their geographic origin."

[23, 24] Here, Lee Expeditions, Ltd., the parent company of HW, has been primarily engaged in arranging safaris to Africa since 1959; Robert Lee, the president of both companies, is the author of a book published in 1959 entitled "Safari Today—The Modern Safari Handbook" and has, since 1961, booked persons on safaris as well as purchased safari clothing in Africa for resale in America. These facts suffice to establish, absent a contrary showing, that defendant's use of 'Safari' with respect to boots was made in the context of hunting and traveling expeditions and not as an attempt to garner A&F's good will. The district court here found the HW's use of 'Camel Safari', 'Hippo Safari', and 'Safari Chukka' as names for various boots imported from Africa constituted "a purely descriptive use to apprise the public of the type of product by referring to its origin and use." The court properly followed the course sanctioned by this court in *Venetianaire Corp. of America v. A&P Import Co.*, 429 F.2d 1079, 1081-82 (1970), by focusing on the "use of words, not on their nature or meaning in the abstract" (emphasis in original). When a plaintiff has chosen a mark with some descriptive qualities, he cannot altogether exclude some kinds of competing uses even when the mark is properly on the register,

Cite as 537 F.2d 4 (1976)

see 3 Callmann, *supra*, § 85.1; *Kiki Undies Corp. v. Alexander's Dep't Stores, Inc.*, 390 F.2d 604 (2 Cir. 1968); contrast *Kiki Undies Corp. v. Promenade Hosiery Mills, Inc.*, 411 F.2d 1097 (2 Cir. 1969), *cert. dismissed*, 396 U.S. 1054, 90 S.Ct. 707, 24 L.Ed.2d 698 (1970). We do not have here a situation similar to those in *Venetianaire, supra*, and *Feathercombs, Inc. v. Solo Products Corp.*, 306 F.2d 251 (2 Cir. 1962), in both of which we rejected "fair use" defenses, wherein an assertedly descriptive use was found to have been in a trademark sense. It is significant that HW did not use 'Safari' alone on its shoes, as it would doubtless have done if confusion had been intended.

We thus hold that the district court was correct in dismissing the complaint.

IV.

[25] We find much greater difficulty in the court's broad invalidation of A&F's trademark registrations. Section 37 of the Lanham Act, 15 U.S.C. § 1119, provides authority for the court to cancel those registrations of any party to an action involving a registered mark.¹³ The cases cited above, p. 13, establish that when a term becomes the generic name of the product to which it is applied, grounds for cancellation exist. The relevant registrations of that sort are Nos. 358,781 and 703,279. Although No. 358,751 dates back to July 20, 1938, and No. 703,279 was registered on August 23, 1960, and an affidavit under § 15(3), 15 U.S.C. § 1065(3), was filed on October 13, 1965, cancellation may be decreed at any time if the registered mark has become "the common descriptive name of

an article or substance," § 14(c), see also § 15(4), 15 U.S.C. §§ 1064(c) and 1065(4). The whole of Registration No. 358,781 thus was properly canceled. With respect to Registration No. 703,279 only a part has become generic¹⁴ and cancellation on that ground should be correspondingly limited.¹⁵ Such partial cancellation, specifically recognized by § 37, accords with the rationale by which a court is authorized to cancel a registration, viz, to "rectify" the register by conforming it to court judgments which often must be framed in something less than an all-or-nothing way.

[26] There remain eight other registrations and those terms not pared from No. 703,279. Three of these registrations, Nos. 652,098, 768,332 and 770,336, and the non-generic portions of No. 703,279 appear to have become incontestable by virtue of the filing of affidavits under § 15(3), of five years continuous use.¹⁶ There is nothing to suggest that the uses included in these registrations, except the uses described above with respect to 703,279 are the common descriptive names of either current fashion styles or African expeditions. The generic term for A&F's 'safari cloth Bermuda shorts', for example, is 'Bermuda shorts', not 'safari'; indeed one would suppose this garment to be almost ideally unsuited for the forest or the jungle and there is no evidence that it has entered into the family for which 'Safari' has become a generic adjective. The same analysis holds for luggage, portable grills, and the rest of the suburban paraphernalia, from swimtrunks and raincoats to belts and scarves, included in these registrations. HW alleged that these registrations were procured by fraud,

13. In contrast to the rule under the Trademark Act of 1905, see *Drittel v. Friedman*, 154 F.2d 653, 654 (2 Cir. 1946), § 37 of the Lanham Act permits cancellation on a counterclaim by a defendant who does not own a registered mark. See *Best & Co. v. Miller*, 167 F.2d 374, 376-77 (2 Cir. 1948).

14. To wit, pants, shirts, jackets, coats and hats.

15. Similar partial cancellation is the proper remedy with respect to the New York registration.

16. In limiting ourselves to these four registrations we are proceeding solely on the basis of the certified copies of trademark registrations filed as exhibits. Since HW's answer challenged incontestability only on the ground of fraud, A&F may not have been alerted to the desirability of informing the court of the filing of § 15(3) affidavits. In view of our holding that the other five registrations should not have been canceled, this is immaterial.

a claim which, if successful, would deny incontestability to A&F's marks, see § 14(c), 15 U.S.C. § 1064(c). But these allegations seem to have meant no more than that HW believed the terms to be merely descriptive and hence unregistrable, and that the Patent Office must have been duped into registering them in the first place without proof of secondary meaning. However, we regard these terms as suggestive rather than "merely descriptive." Moreover, even if they were the latter, assuming that the person filing the applications made the required allegation that "no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as might be calculated to deceive," see § 1(a)(1), 15 U.S.C. § 1051(a)(1), there is nothing to show that such statements were knowingly false when made. Cf. *Bart Schwartz Int'l Textiles, Ltd. v. F.T.C.*, 289 F.2d 665, 48 CCPA 933 (1961); *National Trailways Bus System v. Trailway Van Lines, Inc.*, 269 F.Supp. 352 (E.D.N.Y.1965). The scheme of the Lanham Act forbids a denial of incontestability to a "merely descriptive" mark which would otherwise have become incontestable under § 14 on the basis of a mere allegation of fraud in obtaining registration, without supporting proof.

[27] We hold also that the registrations which have not become incontestable should not have been canceled. 'Safari' as applied to ice chests, axes, tents and smoking tobacco does not describe such items. Rather it is a way of conveying to affluent patrons of A&F a romantic notion of high style, coupled with an attractive foreign allusion. As such, these uses fit what was said many years ago in upholding 'Ideal' as a mark for hair brushes:

The word "Ideal" has no application to hair brushes, except as we arbitrarily apply it, and the word is in no sense indicative or descriptive of the qualities or characteristics or merits of the brush except that it meets the very highest ideal,

mental conception, of what a hair brush should be.

Hughes v. Alfred H. Smith Co., 205 F. 302, 309 (S.D.N.Y.), aff'd. *per curiam*, 209 F. 37 (2 Cir. 1913). It is even wider of the mark to say that 'Safari Mills' "describes" cotton piece goods. Such uses fit into the category of suggestive marks. We need not now decide how valuable they may prove to be; it suffices here that they should not have been canceled.

[28] In sum, we conclude that cancellation should have been directed only with respect to No. 358,781 and portions of No. 703,279 and the New York registration. With respect to the remaining registrations A&F will have the benefits accorded by § 7(b) that registration shall be "prima facie evidence of the validity of the registration . . . and of [the] registrant's exclusive right to use the mark in commerce," 15 U.S.C. § 1057(b). This means "not only that the burden of going forward is upon the contestant of the registration but that there is a strong presumption of validity so that the party claiming invalidity has the burden of proof [and] must put something more into the scales than the registrant." *Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp.*, 259 F.2d 314, 316 (2 Cir. 1958). In the case of registrations that have become incontestable A&F will have the further benefit accorded by § 33(a), 15 U.S.C. § 1115(a), subject to the limitations contained therein and in § 33(b), 15 U.S.C. § 1115(b). Whether all this will suffice for a victory will depend on the facts in each case.

So much of the judgment as dismissed the complaint is affirmed; so much of the judgment as directed cancellation of the registrations is affirmed in part and reversed in part, and the cause is remanded for the entry of a new judgment consistent with this opinion. No costs.

PER CURIAM:

On Petition of Appellant for Rehearing

By petition for rehearing plaintiff-appellant, Abercrombie & Fitch Company (A&F),

requested us to alter our opinion filed January 16, 1976, in two respects: one was that footnote 14, p. 13, describing the scope of cancellation of Trademark Registration No. 703,279, be modified by omitting the word "shirts". The other was that we should not uphold the "fair use" defense, pp. 13-14, as to Hippo Safari and Camel Safari shoes. We called upon defendant-appellee Hunting World, Inc. (HW) to answer.

We agree with A&F that footnote 14 was in error in indicating that Safari had become generic with respect to shirts. Since the mark has become incontestable, it is of no moment, on the issue of cancellation, that, as HW urges, the mark may now be "merely descriptive," pp. 12-13. HW's answer adduces nothing to show that Safari has become the "common descriptive name" for this type of shirt; indeed, HW admits never having advertised its own shirts as such. While HW asserts that "the record is clear that the upper garment of the safari suit is referred to interchangeably as a safari bush jacket and as a safari shirt," the cited pages do not bear this out.

On the other hand we see no force in A&F's criticisms of the portion of our opinion relating to the fair use defense with respect to Hippo Safari and Camel Safari shoes sufficient to lead us to change the views previously expressed or, indeed, to require further discussion.

The petition for rehearing is granted to the extent of striking the word "shirts" from fn. 14 on p. 13 and is otherwise denied.



UNITED STATES of America, Appellee,

v.

Thomas DUVALL and Henry Jones,
Defendants-Appellants.

Nos. 507, 508, Dockets 75-1225, 75-1335.

United States Court of Appeals,
Second Circuit.

Argued Dec. 1, 1975.

Decided Feb. 26, 1976.

Certiorari Denied July 21, 1976.

See 96 S.Ct. 3173.

Defendants were convicted in the United States District Court for the Southern District of New York, Charles E. Stewart, Jr., J., on substantive and conspiratorial counts of possessing stolen mail and of uttering United States Treasury checks bearing forged endorsements, and they appealed. The Court of Appeals, Friendly, Circuit Judge, determined that there was a serious question presented in respect to exculpatory statements made by one defendant and, in respect to that question, held that filing of complaint did not give rise to right to counsel immediately upon arrest pursuant to warrant, that interrogation without presence of counsel did not violate defendant's Sixth Amendment rights, that defendants will was not overborne so as to require suppression of statements made to agents by reason of arrest at gunpoint or by reason of lapse of time between waiver of rights and questioning, and that statements made to prosecutor prior to presentment to magistrate should have been suppressed in absence of observance by prosecutor of cautions of Miranda that defendant not be "threatened, tricked, or cajoled into a waiver," but that error in failing to suppress statements was harmless beyond a reasonable doubt where it was not likely to have affected result in that a formidable case was presented against defendant.

Affirmed.

[2] The difficulty in determining the suggestiveness or descriptiveness of a mark is vividly demonstrated in this case. The term "RECOVERY", when considered in light of applicant's services appears, at first blush, to possess a descriptive significance. But, to articulate the manner in which the term "RECOVERY" describes those services, one cannot come up with an immediate response, but rather must engage in a mental process involving imagination, speculation, and possibly stretching the meaning of the word to fit the situation. It is unlikely that the average person would engage in this exercise at the point of contact with this term in the advertising or rendering of applicant's services. Considering that the term "RECOVERY" is prominently displayed on applicant's literature in such a manner that the viewer's attention is directly and immediately drawn to the word, that the word is used therein as a mark to identify the source of the services described therein, that "RECOVERY" does not in any real or specific sense describe the particular services rendered by applicant; and that the registration sought by applicant would not preclude others from using "RECOVERY" in a descriptive sense to convey its descriptive meaning, it is concluded that the scales of thought in this case tip in the direction of suggestiveness rather than descriptiveness. As such, "RECOVERY" as applied to applicant's services is not merely descriptive within the meaning of Section 2(e)(1) of the Statute.

Decision

The refusal of registration is reversed.

Patent and Trademark Office Trademark Trial and Appeal Board

Airco, Inc.

v. Air Products and Chemicals, Inc.

Decided Sept. 23, 1977

TRADEMARKS

1. Opposition — Failure to take testimony (§67.579)

Earliest use of mark on which applicant can rely is filing date of application, in absence of evidence of prior use.

2. Opposition — Damage to opposer (§67.675)

Opposition — Mark and use of opposer — In general (§67.5831)

Opposer is beneficiary, under Trademark Act Section 5, of its division's use of mark; opposer that is record owner of registered mark for goods and services sold by its division has standing in its own right to be heard on question of likelihood of confusion.

3. Identity and similarity — Words — Not Similar (§67.411)

Opposition — Consideration of marks of third parties (§67.537)

Third-party registrations, although devoid of competency as to whether specific marks as whole are confusingly similar, are probative to extent they serve to suggest that parties as well as third-party registrants have adopted portion of marks to convey dictionary meaning or its suggestion that inclusion in two marks of same prefix is alone insufficient basis upon which to predicate holding of likelihood of confusion, and that portions of marks other than identical prefixes trigger impact and commercial impressions of marks in their entirety. "Air-Care" does not so resemble "Airco" that confusion is likely.

4. Marks and names subject to ownership — Names — Corporations or partnerships (§67.5213)

Section 2(a) of Trademark Act, which prohibits registration of mark that falsely suggests connection with "person" may be applied to corporation.

5. Marks and names subject to ownership — Descriptive — Misdescriptive or not descriptive — Particular marks (§67.5078)

Registration — Effect (§67.747)

"Air-Care" is not merely descriptive of program of scheduled maintenance of hospital and medical anesthesia and inhalation therapy equipment and hospital piping systems for medical gases; applicant's registration of mark and presumptions afforded registration could not interfere with opposer's right to use terms comprising mark, separately and apart from each other, in descriptive sense to describe its goods or services, as "fair use."

Trademark opposition No. 56,408, by Airco, Inc., against Air Products and Chemicals, Inc., application, Serial No.

461,285, filed June 25, 1973. Opposition dismissed.

Morton, Sutherland & Roberts, Washington, D.C., for Airco, Inc.

James C. Simmons, Allentown, Pa., for Air Products and Chemicals, Inc.

Before Lefkowitz, Rice, and Fowler, Members.

Lefkowitz, Member.

An application has been filed by Air Products and Chemicals, Inc. to register the notation "AIR-CARE" as a service mark for a program of scheduled maintenance of hospital and medical anesthesia and inhalation therapy equipment and hospital piping systems for medical gases. Use of the mark since January 28, 1971 has been claimed.

Registration has been opposed by Airco, Inc., which alleges prior and continuous use of "AIRCO" as a trade name and as a trademark or service mark in connection with the sale of medical gases, the sale of hospital and medical anesthesia and inhalation therapy equipment and hospital piping systems for medical gases, the service of maintaining and repairing of medical apparatus, and preventive maintenance services for hospital and medical anesthesia and inhalation therapy equipment and hospital piping systems for medical gases; and ownership of a number of registrations covering the mark "AIRCO" for the aforementioned goods and services.

As grounds for opposition, opposer has averred that:

(A) Applicant's mark falsely suggests a connection with a person within the meaning of Sections 2(a) and 45 of the Statute in that "AIR-CARE" would tend to cause confusion, or to cause mistake or to deceive the public as to whether there is a connection with opposer who has for

many years prior to 1971 been known by its trade name "AIRCO."

(B) Applicant's mark "AIR-CARE" so resembles opposer's trade name and trademark "AIRCO" as to be likely, when applied to applicant's services, to cause confusion or mistake or to deceive within the meaning of Section 2(d) of the Statute.

(C) Applicant's mark "AIR-CARE" when applied to its services, is merely descriptive of them within the meaning of Section 2(e)(1) of the Statute ("in that each person offering the service of scheduled maintenance of hospital and medical anesthesia and inhalation therapy equipment, including opposer, has the right to describe and advertise his services as the CARE of said equipment.")

(D) Applicant's mark should be further refused registration on the ground that it is used in a manner so as to represent or suggest falsely that applicant makes or sells the goods in connection with which such service is performed within the meaning of Section 3 of the Act in that "AIR-CARE" services of applicant are offered to be performed on goods made and sold by opposer under the trademark AIRCO and all of which goods as used prominently display the trademark AIRCO.

Applicant, in its answer, has denied and/or left opposer with establishing the allegations upon which its claims of damage are predicated.

The record consists of the pleadings, applicant's application file, copies of opposer's pleaded registrations made of record in accordance with Rule 2.122(b), trial testimony in behalf of opposer, stipulated testimony for applicant, and copies of official records noticed by applicant under Rule 2.122(c). Both parties have filed briefs and presented their respective viewpoints at an oral hearing conducted on this matter.

[1] According to the record, opposer and applicant, in their own right and/or through operating divisions, are competitors in the manufacture and sale of anesthesia machines and equipment, respiratory therapy and resuscitation equipment, hospital gas and vacuum pipeline systems, equipment, medical gases, modular wall systems, pressure regulators, flow meters, and similar equipment and supplies intended for hospitals, clinics, nursing homes, members of the medical and dental professions, as well as for home patient care. Both applicant and opposer have advertised their respective products and equipment in some of the same publications including

Reg. No. 119,238, issued Nov. 13, 1917, and twice renewed; Reg. No. 146,156, issued Sept. 6, 1921, and twice renewed; Reg. No. 595,241, issued Sept. 14, 1954, renewed; Sec. 8 affidavit accepted; and Sec. 15 affidavit received; Reg. No. 596,166, issued Oct. 5, 1954, renewed; Sec. 8 affidavit accepted; and Sec. 15 affidavit received; Reg. No. 608,793, issued June 7, 1960, Sec. 8 affidavit accepted; and Sec. 15 affidavit received; Reg. No. 874,583, issued Aug. 12, 1969, Sec. 8 affidavit accepted; and Sec. 15 affidavit received; Reg. No. 875,034, issued Aug. 19, 1969, Sec. 8 affidavit accepted; and Sec. 15 affidavit received; Reg. No. 888,756, issued Mar. 31, 1970, Sec. 8 affidavit accepted; and Sec. 15 affidavit received; Reg. No. 890,165, issued Apr. 28, 1970, Sec. 8 affidavit accepted; and Sec. 15 affidavit received; and Reg. No. 947,396, issued Nov. 14, 1972.

"The Journal of the American Society of Anesthesiologists" and "Anesthesia and Analgesia"; both parties promote repair services to purchasers of their equipment; and both parties offer their customers contracts for scheduled preventive maintenance and inspection of their equipment and machines. It is for this program of scheduled maintenance and inspection of the anesthesia therapy equipment and the like that applicant has used and is seeking to register the mark "AIR-CARE". There is no evidence as to when applicant first used the mark "AIR-CARE" in connection with this service so that the earliest use thereof on which applicant can rely herein is the filing date of the subject application, namely, June 25, 1973. See: J. C. Hall Company, Inc. v. Hallmark Cards, Incorporated, 144 USPQ 435 (CCPA, 1965). The record does reveal, however, that applicant's "AIR-CARE" services are rendered throughout the Continental United States and that, as of January 17, 1975, applicant's "AIR-CARE" preventive service and inspection service contracts were worth more than one hundred thousand dollars. The mark "AIR-CARE" appears on the contracts and on descriptive brochures.

Opposer, through its Ohio Medical Products Division, has, since long prior to 1973, continuously engaged in the manufacture, sale, and service of the aforementioned anesthesia equipment, resuscitators, respirators, and the like as well as in providing its customers with a preventive maintenance and inspection program. The mark "AIRCO", in one particular logo or another, has appeared on nameplates affixed to this equipment over the years. In addition, as a part of opposer's corporate identification program, the Ohio Medical Products Division has continuously used the "AIRCO" mark on its stationery, advertising material, trucks, catalogs, packaging material whenever and where possible, sales literature, repair manuals, service men's identification cards, and on the agreements and similar material utilized in the rendering of the preventive maintenance services. The sales of this increased over the years from over thirty million dollars in 1970 to an estimated forty-three million dollars in 1972 and sixty-eight and a half million dollars in 1974. Insofar as the preventive maintenance services are concerned, opposer's Ohio Medical Products Division averaged between seventeen hundred and two thousand contracts a month in 1969 which resulted in an income for that year of over two hundred and fifty thousand dollars.

[2] Turning first to the question of likelihood of confusion under Section 2(d),

there is no question on the record presented that opposer's Ohio Medical Products Division has utilized the mark "AIRCO" in connection with its various operations including its preventive maintenance services; that its customers and prospective customers have been and are familiar with the association of this company with "AIRCO"; and that opposer, under Section 5 of the Statute, is the beneficiary of such use. See: Minnesota Mining and Manufacturing Company v. 3M Credit Plan, Inc., 172 USPQ 626 (TT&A Bd., 1972), affirmed in unpublished decision. In any event, since opposer is the record owner of the registered mark "AIRCO" for goods sold by its Ohio Medical Products Division and for the service and repair of such equipment, it possesses standing in its own right to be heard on this question. See: King Candy Company v. Eunice King's Kitchen, Inc., 182 USPQ 108 (CCPA, 1974). Under these circumstances and since the marks "AIR-CARE" and "AIRCO" are used on and in connection with the same type of service, the question of likelihood of confusion obviously turns on whether "AIR-CARE" is confusingly similar to "AIRCO".

Opposer has urged that the marks are identical in their initial visual portion "AIRC" and differ only in their terminal vowel sounds "O" and "ARE" which are phonetically indistinct.

Applicant, on the other hand, has argued that the composite mark "AIR-CARE" does not resemble the mark "AIRCO" except for the common use of the word "AIR" as a prefix, that this common word "AIR" is a "pedestrian" term in the field because it has been so often adopted and registered as a prefix of trademarks associated with the medical/surgical or health care fields that it cannot be considered unique to or indicative of a particular manufacturer or even a broad product line, let alone a particular brand of services; and that considering the obvious meaning of the word "CARE" and that the suffix portion "CO" of opposer's mark is a well-known abbreviation of the word "Company", the differences between these terms "color the entireties of the composite marks" and bestow upon them individual and dissimilar meanings, sounds, and appearances.

In an effort to support its position relative to the term "AIR", applicant has made of record under the applicable rule copies of fourteen third-party registrations for medical and/or surgical appliances, for inhalation therapy equipment including the servicing of such equipment, and for goods and services intended for improving the quality of the environment. These marks in-

cluded the designations "AIRWAY OXYGEN", "AIRTONE", "AIRKEM", "AIRTRON", "AIRTECH", "AIRE-CAST", "AIR-PAK", "AIR-SURGERY", "AIR-SHIELDS", "AIR-CENTRIC", "AIRCORD", "AIR-LITE", "AIROX", and "AIRFLEX". Opposer, however, has denigrated the significance of the third-party registrations on the ground that they are irrelevant on the question of the confusing similarity of the marks here in issue.

[3] The third-party registrations, although devoid of competency as to whether the specific marks "AIRCO" and "AIR-CARE" as a whole are confusingly similar (See: AMF Incorporated v. American Leisure Products, Inc., 177 USPQ 268 (CCPA, 1973), and cases cited therein), are probative to the extent that they serve to suggest that the parties as well as the third-party registrants have adopted the "AIR" portion of the marks to convey the dictionary meaning or suggestion thereof, namely, that their products and/or services are associated with dispensing of medical gases such as oxygen derived from air; that the inclusion in two marks of this prefix portion is alone an insufficient basis upon which to predicate a holding of a likelihood of confusion; and that it is the other portions of the marks that trigger the impact and commercial impressions of the marks in their entireties. See: Conde Nast Publications, Inc. v. Miss Quality, Inc., 184 USPQ 422 (CCPA, 1975), and Tektronix v. Daktronics, Inc., 189 USPQ 693 (CCPA, 1976). Thus the impact and effect of the adoption of the term "CO" and "CARE", respectively, to the word "AIR" must be considered in evaluating the possible conflict between the marks. The term "CO", as indicated by applicant, is an abbreviation for the term "Company"; it was adopted and has been used for this purpose by opposer, and it will undoubtedly be recognized and equated as such by purchasers in the field. Prospective purchasers in the field "CARE" on the other hand, is a visible distinct portion of applicant's mark, it is a common word in the English language with a meaning known to all, and it will be so recognized by the average purchaser of applicant's services. It is therefore our opinion that when these two terms are combined with "AIR", the result is two marks that are readily distinguishable in both sound and appearance and create such distinctly different commercial impressions that there is no reasonable likelihood of confusion or mistake as to the source of the goods or services offered thereunder. See: In re General Electric Company, 134 USPQ 190 (CCPA, 1962); and Dan River Mills,

Incorporated v. The York Shirt Corporation, 156 USPQ 401 (CCPA, 1968).

[4] As to opposer's claim of damage under Section 2(a) which prohibits the registration of a mark which falsely suggests a connection with a person, while opposer's corporation may be considered to be a "person" within the meaning thereof in this section, nevertheless in view of the holding that applicant's attempt to register "AIR-CARE" is not precluded by Section 2(d), opposer likewise cannot prevail under this additional theory of relief. As stated by the Court in *Morehouse Manufacturing Corporation v. J. Strickland and Company*, 160 USPQ 715 (CCPA, 1969) at pages 720-721:

"We agree with appellant that the board should not have attempted to overrule our '21' Club decision, and should have held that a corporation is a 'person' under section 2(a). But this avails appellant nothing on this point because we do not agree with the further argument that 'Blue Magic' does 'falsely suggest a connection with' appellant. To do this there would have to exist, at the very least, some likelihood of confusion with appellant's 'MAGIC' marks, under section 2(d), which appellant contends for under its final point. (underlining added)."

[5] The mark "AIR-CARE" is, moreover, not merely descriptive as applied to applicant's services. The literal meaning of the mark, namely, "care of the air", may, through an exercise of mental gymnastics and extrapolation suggest or hint at the nature of applicant's services, but it does not, in any clear or precise way, serve merely to describe applicant's preventive maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy equipment and the like. Furthermore, applicant's registration of "AIR-CARE" and the presumptions afforded the registration under Section 7(b), if and when issued, would extend to the unitary term "AIR-CARE" and not to the words "AIR" and "CARE", per se, so that it cannot interfere with opposer's right to use these terms, separately and apart from each other, in a descriptive sense to describe its goods and/or services in what has been described as a "fair use" of these terms. See: *Pacific Industries, Inc. v. Minnesota Mining and Manufacturing Co.*, 165 USPQ 631 (CCPA, 1970); and *Exxon Corporation v. Fil-R-Up Systems, Inc.*, 182 USPQ 443 (TT&A Bd., 1974).

Finally as to ground (D) set forth in the opposition, Section 3 provides that "Subject to the provisions relating to the registration

of trademarks, so far as they are applicable, service marks used in commerce shall be registrable in the same manner and with the same effect as are trademarks except when used so as to represent falsely that the owner thereof makes or sells the goods on which said mark is used.¹¹ It is apparent from the evidence of record including the specimens filed with the application that while applicant sells the equipment that it normally services under its preventive maintenance contract, the mark "AIR-CARE" has been used exclusively as an indication of origin for the service and is nowhere employed as a trademark for such goods. And for the reasons enumerated in the discussion under opposer's Section 2(d) and Section 2(a) claims, it is not seen how the use of the mark "AIR-CARE" by applicant would be likely to falsely suggest that the services are rendered exclusively on or in connection with opposer's "AIRCO" products.

In conclusion, it is our opinion that opposer has fired a number of missiles at applicant in an effort to defeat its attempt to register the mark "AIR-CARE" but they all missed their target by wide margins.

Decision

The opposition is dismissed.

Patent and Trademark Office Trademark Trial and Appeal Board

Polaroid Corporation

v. Oculens, Ltd.

Decided Sept. 26, 1977

TRADEMARKS

1. Identity and similarity — How determined — Dissecting marks (§67.4063)

Marks must be considered in their entirety in considering confusing similarities.

2. Identity and similarity — How determined — Dominant feature (§67.4065)

One feature of mark can be considered more significant in determining likelihood of confusion.

3. Identity and similarity — How determined — Descriptive or disclaimed matter (§67.406)

Marks and names subject to ownership — Descriptive — In general (§67.5071)

Descriptive portion of mark, "oid," can be given little weight in consideration of marks as whole.

4. Opposition — Consideration of marks of third parties (§67.573)

Third-party registrations, although incompetent to show that no conflict exists between marks at issue when considered in their entirety, do serve to indicate that suffix does not per se serve as indication of origin of any one particular party's products, that persons encountering sunglasses, under marks containing "oid" as suffix, in marketing environment generally surrounding their sale would attribute to term its normal and well known meaning, and look to other portions of mark as origin indicating feature of marks as whole, so that inclusion of term "oid" in each mark is insufficient basis upon which to hold marks in their entirety to be confusingly similar.

5. Identity and similarity — Words — Not similar (§67.4111)

"Filteroid" does not so resemble "Polaroid" that confusion is likely.

Trademark opposition No. 53,957 by Polaroid Corporation, against Oculens, Ltd., application, Serial No. 389,165, filed Apr. 14, 1971. Opposition dismissed.

Brown & Mikulka, Cambridge, Mass., and Thomas V. Smurzynski, and William W. Rymer, both of Boston, Mass., for Polaroid Corporation.

William R. Liberman, New York, N.Y., for Oculens, Ltd.

Before Lefkowitz, Rice, and Fowler, Members.

Fowler, Member.

An application by Opto Specs, Ltd., and subsequently assigned to Oculens, Ltd., has been filed to register the mark "FILTEROID" for sunglasses, use since November 16, 1970 being alleged.

Registration has been opposed by Polaroid Corporation on the grounds that on or about November 19, 1935 opposer's predecessor, Sheet Polarizer Company, Inc., adopted and used the term "POLAROID" as its trademark for sheet polarizing materials, that since said date, said

Sec. No. 389,165, filed April 14, 1971.

predecessor and opposer, as its successor, have continuously used said trademark upon said goods and used all other goods of opposer and its predecessor including the goods hereinafter described; that opposer has used "POLAROID" as its trade name in connection with its goods and services continuously since the day of its incorporation, namely September 13, 1937, which is long prior to applicant's claimed date of first use; that opposer is the owner of registrations for the trademark "POLAROID" for composite material comprising suspensions of crystalline particles in a light-transmitting medium adapted to be used in connection with optical devices such as microscope eyepieces, glare eliminators, variable density diaphragms, gem testers, and the like; for small cases adapted to contain filters, eyeglasses, and similar articles; for glass sheets and laminations of glass sheets; for stereoscopic viewers and the like; for transparent organic plastic material in the form of sheets or blocks; for viewing devices—namely filters, lenses, eyeglasses and goggles; for photographic cameras, photographic exposure meters, sensitized photographic film, photographic papers, spoils, sensitized photographic papers, television screen filters, and light-polarizing organic plastic in sheet form for further manufacture; and for photographic apparatus, products, accessories and supplies, and more specifically, apparatus for providing a light pulse (wink-lights), batteries, bulbs, film holders, lens caps, slide mounts, and view finders, and automotive viewing visors, and for greeting cards; that since long prior to applicant's claimed date of first use, opposer and its licensees have applied the trademark "POLAROID" to sunglasses sold to the public and have used opposer's said trade name in connection with the sale of said sunglasses; that the term "FILTEROID"

which applicant seeks to register, when applied to applicant's goods, namely sunglasses, so resembles opposer's trade name and trademark "POLAROID" as used on the same goods as to be likely to cause confusion or mistake or to deceive purchasers into the belief that applicant's goods originate with or are sponsored by opposer; and that the adoption and use by applicant of the term "FILTEROID" constitutes an appropriation of opposer's entire corporate and trade name, and is likely to cause confusion, mistake or deception in that persons intending to deal with opposer may be confused or deceived into dealing with applicant in the belief that they are dealing with opposer.

Applicant, in its answer to the notice of opposition, has in effect denied all of the salient allegations contained therein, including those pertaining to likelihood of confusion, and as an affirmative defense alleges that "OID" as a suffix ending for trademarks in the field of optics is not and has not been distinctive of the goods of any one entity; that the trademark "FILTEROID" as applied to sunglasses has been in use by applicant and by another entity for a considerable number of years; that the trademark "FILTEROID" was registered in the United States Patent and Trademark Office in respect of sunglasses under Registration No. 608,293¹⁰ issued July 5, 1955, on an application filed May 28, 1954 based on a claim of first use of May 1, 1954, and that said registration had affidavits under Sections 8 and 15 of the Act filed in respect thereof on July 8, 1960; and that on information and belief, at no time between May 1, 1954 and November 6, 1972, was there ever any instance of confusion, deception or mistake between any trademark of opposer and the aforementioned "FILTEROID" trademark.

The record consists of the pleadings, applicant's application file, copies of opposer's pleaded registrations and two additional registrations for the mark "POLAROID" for three-dimensional projection accessories—namely, projection filters, focusing filters, brightness matching filters, synchronization controls¹¹ and for a long list of goods including photographic equipment,¹² which registrations have been made of record by filing a notice of reliance thereon during opposer's testimony period

¹⁰ Reg. No. 337,404, issued August 4, 1936, renewed but now expired.
¹¹ Reg. No. 388,047 issued June 10, 1941, renewed.
¹² Reg. No. 388,251 issued June 17, 1941, renewed.
¹³ Reg. No. 388,721 issued July 8, 1941, renewed.
¹⁴ Reg. No. 394,030, issued March 17, 1942, renewed.
¹⁵ Reg. No. 399,329, issued Dec. 29, 1942, renewed.

¹⁶ Reg. No. 540,179, issued March 27, 1951, renewed. Sec. 8 affidavit accepted; Sec. 15 affidavit received.

¹⁷ Reg. No. 730,072, issued April 17, 1962; Sec. 8 affidavit accepted; Sec. 15 affidavit received.

¹⁸ Reg. No. 608,293 was subsequently cancelled which will hereafter be explained.

¹⁹ Reg. No. 605,134, issued April 26, 1955; Sec. 8 affidavit accepted; Sec. 15 affidavit received.

²⁰ Reg. No. 607,263, issued June 14, 1955; renewed, Sec. 8 affidavit accepted.

by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

[1] Application of 35 U.S.C. §26 is discretionary with the Commissioner. *Schenley Industries, Inc. v. E. Marinnoni Co.*, 161 USPQ 279 (C.C.P.A. 1969). The Commissioner has exercised discretion under 35 U.S.C. §26 to accept defectively executed documents in several trademark cases. *Carl Zeiss Stiftung v. JENAer Glaswerk Schott & Gen.*, 184 USPQ 355 (Comm. Pats. 1974) [*notary before whom verification of a Notice of Opposition under Section 13 of the Trademark Act was made was a notary of the German Democratic Republic and not an appropriate official to administer oaths in a foreign country, under the provisions of Section 11 of the Trademark Act*]; *Ex parte Louisville & Nashville R.R.*, 171 USPQ 49 (Comm. Pats. 1971) [*failure by notary to fill in the appropriate blanks in a jurat statement accompanying an affidavit under Section 8 of the Trademark Act*]; *Luten Piccard Watch Corp. v. Couness da Vinci*, 167 USPQ 239 (Comm. Pats. 1970) [*failure of opposer to sign at the end of the verification of a Notice of Opposition under Section 13 of the Trademark Act, although the Notice of Opposition itself was signed and the notary took opposer's oath to the fact that allegations in the Notice of Opposition were true*]; *Ex parte The Buehler Corp.*, 159 USPQ 192 (Comm. Pats. 1968) [*failure to include all the necessary averments in a Notice of Opposition under Section 13 of the Trademark Act, although the notarial verification "subscribed and sworn to before me" was included*].

Exercise of discretion in the cited cases was in keeping with the intent of Congress in enacting 35 U.S.C. §26. The Commissioner, on the Judiciary of the House of Representatives, in recommending enactment of 35 U.S.C. §§25, 26, said:

The proposed amendment is intended to facilitate the procedures of the Patent Office in those instances where technicalities required for the proper execution, and authentication of oaths on documents, have added to the workload and expense of the Patent Office. Further, in many instances, the problems involved in correcting defects in such oaths have caused inconvenience and in some cases, actual prejudice to persons seeking to comply with the present law. See U.S. Code

Congressional and Administrative News, p.2122 (1964).

In other trademark cases, however, acceptance of documents under 35 U.S.C. §26 was deemed inappropriate. *In re Laboratories Goupil, S.A.*, 197 USPQ 689 (Comm. Pats. 1977) [*failure to notarize or to include a Rule 2.20 declaration with a paper filed under Section 8 of the Trademark Act*]; *Texas Instruments, Inc. v. Conklin Instrument Corp.*, 161 USPQ 740 (T.T. & A. Bd. 1969) [*failure to include any verification with a petition to cancel under Section 14 of the Trademark Act*]; *Schenley Industries, Inc. v. E. Marinnoni Co.*, supra [*failure to provide any verification of a Notice of Opposition within the period prescribed by the Trademark Rules*].

[2] The decision to accept or to refuse to accept a document under 35 U.S.C. §26 is made on a case-by-case basis. The Commissioner first determines whether the defect in a document can be properly characterized as a defective execution within the meaning of 35 U.S.C. §26. Not all defects that appear in documents are defects of execution. If the defect is one of execution, the Commissioner then determines whether the document ought to be provisionally accepted. In every such case, the Commissioner attempts to balance the need for enforcement of statutory requirements and orderly and efficient administration of the law against the policy of allowing correction of technical defects of execution in papers filed in the Patent and Trademark Office. Principal factors considered in determining whether to accept a paper with a defective execution are (1) the seriousness of the defect and (2) the steps taken by the party to effect a proper execution. If a defect is minor and if the surrounding circumstances establish that a party exercised reasonable care to effect a proper execution, acceptance of the document under 35 U.S.C. §26 is appropriate. On the other hand, to allow acceptance of all defective papers under 35 U.S.C. §26 would be to read out of the relevant statutes those requirements of execution intended by Congress and to ignore the discretionary nature of 35 U.S.C. §26.

[3, 4] In the present case, the declaration under Section 8 and Section 15 included a proper verification. There was no failure on the part of a notary nor absence of either a date of execution or necessary words of verification. However, the declaration filed within the statutory period named Body Persuasion as owner of the registration, although Ben Weider was the owner. Section 8 of the Trademark Act requires the fil-

ing of a timely affidavit by the registrant. No such affidavit or declaration by the registrant was filed within the period prescribed by Section 8. The defect in this case was, thus, not a defective execution within the meaning of 35 U.S.C. §26.

Even if the defect in this case were determined to be a defective execution within the meaning of 35 U.S.C. §26, registrant would not be entitled to relief. Registrant has not shown that it exercised reasonable care to effect proper execution. Indeed, the record gives no indication of how the defect occurred.

For the reasons indicated, the Commissioner will not exercise discretion under 35 U.S.C. §26 to accept provisionally registrant's timely-filed, but defective declaration under Sections 8 and 15. The petition is denied.

Patent and Trademark Office Trademark Trial and Appeal Board

Holiday Inns, Inc.
v. Monolith Enterprises
Decided Nov. 25, 1981

TRADEMARKS

1. Pleading and practice in Patent Office — In general (§67.671)

Trademark Rule 120(b) states that no admission or answer to interrogatory shall be considered as part of record in case unless party propounding request for admission or interrogatory files, before close of his testimony period, copy of admission and request and/or copy of interrogatory and its answer, and also files notice of reliance on them. In those instances where answers relied upon by propounding party may be clarified, rebutted, or explained by other answers that have not been introduced, answering party may, in interest of equity, be permitted to introduce any of those remaining answers that tend to complete one or ones relied upon by propounding party; specific answer or answers sought to be introduced by answering party must be pinpointed and its relationship to interrogatory and answer introduced by propounding party must be shown; it is not sufficient to simply notice reliance on all of answers to all of interrogatories propounded.

2. Pleading and practice in Patent Office — In general (§67.671)

It is not purpose of practice whereby answering party may introduce remaining answers that tend to complete those relied upon by propounding party, to introduce answers that contain information, such as advertising expenses, that party may have wished to put into evidence, and may not be used thus.

3. Pleading and practice in Patent Office — In general (§67.671)

Fed. R. Civ. P. 15(a) provides, in part, that pleading may be amended by leave of court and leave shall be freely given when justice so requires; amendments to pleadings are allowed with great liberality at any stage of proceeding, when entry of amendment would serve to further ends of justice, unless it is shown that amendment would violate settled law or be prejudicial to rights of opposing party; nowhere is it required that party prove validity of allegation in order to be permitted to plead it.

4. Marks and names subject to ownership — Descriptive — In general (§67.5071)

Word "generic" in sense of trademark law does not refer to genus in scientific sense, but means any word to which public is entitled to unstrained use because it is common noun for product or service.

5. Marks and names subject to ownership — Descriptive — How determined (§67.5073)

Question of whether or not particular term is merely descriptive must be determined not in abstract, but in relation to goods or services for which registration is sought, context in which term is being used on or in connection with those goods or services, and possible significance that it would have to average purchaser of goods or services because of such manner of use; term is considered descriptive within meaning of Lanham Act Section 2(e)(1) if it forthwith conveys immediate idea of ingredient, quality, characteristic, function, or feature of product in connection with which it is used.

6. Marks and names subject to ownership — Suggestive (§67.508)

Term is suggestive if it requires imagination, thought, and perception as to nature of goods or services.

7. Marks and names subject to ownership — Descriptive — Misdescriptive or not descriptive — Particular marks (§67.5078)

"The American Cafe" falls short of being merely descriptive of restaurant services.

8. Identity and similarity — How determined — Appearance, meaning or sound (§67.4035)

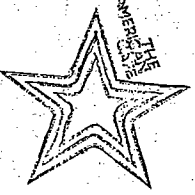
Finding of likelihood of confusion cannot be predicated upon presence in each mark of weak or suggestive term, when remaining portions of those marks differ in appearance, sound, and/or meaning.

Trademark opposition No. 61452 by Holiday Inns, Inc. against Monolith Enterprises, application, Serial No. 122,709, filed Apr. 14, 1977. Opposition dismissed.

James L. Kurtz, P.C., Washington, D.C., for Holiday Inns, Inc.
Robert H. Epstein, Arlington, Va., and Ronald P. Kananen, Washington, D.C., for Monolith Enterprises.

Before Kera*, Allen, and Fruge*, Members.
Fruge, Member.

An application was filed by Monolith Enterprises, Inc. to register the mark shown below ("CAFE" disclaimed) for restaurant services. Use since February 24, 1977 was alleged.



Registration was opposed by Holiday Inns, Inc. on the ground that applicant's mark so resembles the mark "RICK'S CAFE AMERICAN" ("CAFE" disclaimed) previously used and registered by opposer for restaurant services as to be likely, when used in connection with the ser-

vices of the applicant, to cause confusion, mistake or deception. Opposer further alleged that applicant's mark is merely descriptive or generic as applied to its services.

Applicant denied opposer's allegations of confusing similarity and of descriptiveness and, as an affirmative defense, pleaded that the marks differ substantially except for the inclusion of the word "CAFE" and that opposer cannot preclude adoption and use of that term by others for restaurant services.

During the interlocutory phase of this proceeding, opposer filed a motion to strike items 1, 2, 9, 10, 11, and 12 from applicant's notice of reliance on the ground that these items relate to applicant's responses to opposer's discovery requests and that only opposer may rely thereon. Applicant asserted, in response, that since opposer introduced parts of applicant's response to discovery, applicant is entitled to rely on any other parts which would tend to clarify, rebut or explain those items relied upon by opposer. Neither party takes issue with this basic proposition of the use of discovery. However, each has apparently interpreted it to its own advantage.

[1] Rule 2.120(b) states that no admission or answer to an interrogatory shall be considered as part of the record in the case unless the party propounding the request for admission or interrogatory files, before the close of his testimony period, a copy of the admission and the request therefor and/or a copy of the interrogatory and its answer and also files a notice of reliance thereon. It has long been accepted, as a corollary thereto, that in those instances where the answers relied upon by the propounding party may be clarified, rebutted or explained by other answers which have not been introduced, the answering party may, in the interest of equity, be permitted to introduce any of those remaining answers which tend to complete the one or ones relied on by the propounding party. There is, however, a caveat which must be remembered in seeking to take advantage of this practice. That is, the specific answer or answers sought to be introduced by the answering party must be pinpointed and the relationship thereof to the interrogatory and answer introduced by the proponent must be shown. It is not sufficient to simply notice reliance on all of the answers to all of the interrogatories propounded, as applicant here has done, and expect the members of the tribunal to determine which, if any, of the answers originally relied on require explanation or clarification, which, if any, of the remaining responses are intended to answer that need

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The record consists of the pleadings, applicant's application file, certain of applicant's answers to opposer's interrogatories and requests to admit introduced pursuant to Rule 2.120(b), copies of pages of certain publications and of opposer's registration introduced under Rule 2.122(c), opposer's request for admission No. 9 and applicant's response thereto, opposer's responses to applicant's request for admissions and applicant's interrogatories introduced under Rule 2.120(b) and copies of pages of certain enumerated publications under Rule 2.122(c). Neither party took testimony but both filed briefs and were represented at the oral hearing held in this matter.

The record establishes that opposer, a Tennessee corporation, uses the mark "RICK'S CAFE AMERICAN" to identify a restaurant-cocktail lounge ostensibly patterned after the nightclub of the same name in the movie "CASABLANCA". (Applicant's notice of reliance, Exhibit D.) The sole restaurant of this name is located in the Holiday Inn, Lake Shore in Chicago, Illinois.

Applicant is the owner of two restaurants in the Washington, D.C. area called "THE AMERICAN CAFE". The first use of the mark by applicant was February 24, 1977.

[3] Since priority is not an issue in this proceeding by virtue of opposer's ownership of a registration of its mark, we proceed to

the issues which are before us, that is, likelihood of confusion and descriptiveness.

[4] Opposer's first contention, that the mark is generic, we dismiss out of hand. We refer to the definition cited by opposer: "(1) the word 'generic' in the sense of trademark law, does not refer to a genus in the scientific sense but means any word to which the public is entitled to unrestricted use because it is the common noun for a product or service." We fail to see any part of applicant's mark which could be designated a common noun except for the word "CAFE" which is acknowledged to be non-distinctive by a disclaimer thereof.

[5] As to the descriptiveness issue, we note initially that the question of whether or not a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term is being used on or in connection with those goods or services, and the possible significance that it would have, because of such manner of use to the average purchaser of the goods or services. See *On-Tips, Inc. v. Johnson & Johnson*, 95 USPO 264 (DCNJ 1956); *Roselux Chemical Co., Inc. v. Parsons Ammonia Company, Inc.*, 132 USPO 627 (CCPA 1962). A term

The descriptiveness issue was added to the pleadings by amendment over applicant's objection. In answering the amended pleading, applicant, as an affirmative defense, claimed that the Board's decision to allow the amendment constituted error because opposer failed to provide the documents upon which it relied to support the theory of relief pleaded. This charge was repeated in applicant's brief on the case, and is here addressed to lay it to rest. Rule 15(a) FRCP provides, in part, that a pleading may be amended by leave of court and leave shall be freely given when justice so requires. In keeping with that rule, amendments to pleadings are allowed with great liberality at any stage of a proceeding where the entry of the amendment would serve to further the ends of justice, unless it is shown that the amendment would violate settled law or be prejudicial to the rights of the opposing party. See *American Optical Corporation v. American Optical Company, Inc.*, 168 USPO 471 (TTAB 1971) and *Anheuser-Busch, Incorporated* taken at the time opposer's motion was filed so that there was no apparent prejudice to applicant from the amendment. Moreover, applicant's argument that opposer failed to supply the documents supporting the amendment is specious. Nowhere is it required that a party prove the validity of an allegation in order to be permitted to plead it. Applicant is confusing pleading with proof. *Primal Feeling Center of New England, Inc. v. Janov*, 201 USPO 44 (TTAB 1978).

is considered descriptive within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, function or feature of the product in connection with which it is used. See: *Stix Products, Inc. v. United Merchants & Manufacturers*, 160 USPQ 777 (DC S.D.N.Y. 1968); and cases cited therein.

Opposer takes the position that, when considering the significance applicant's mark would have to the general public, the only logical conclusion to be drawn is that it signifies a restaurant serving "American" food. We find at least two flaws in opposer's argument. One, what is American food? Is it native Indian? Is it Pennsylvania Dutch? Is it grits, corn bread and country ham; or baked beans, lobster and clam chowder; or rice, gumbo and crawfish? Is it a combination of these? We don't know and opposer has not enlightened us. Yet, opposer maintains that "applicant's mark tells the diner what his dinner will be" and concludes on that basis that the mark is merely descriptive. We disagree with opposer's premise that applicant's use of the term "American" immediately tells a diner what to expect his or her dinner to be. Having said that, we reach the second flaw in opposer's position which is that, as used by applicant, "American" modifies the noun "cafe" so that we cannot limit our consideration solely to the type of food served, but must include in our deliberations the service itself, the decor and the ambience of the place. Thus, in order to be termed descriptive, the name must immediately tell a potential customer what to expect in the sum total of these concepts, that is, a typical "American" Cafe. Given the wide variety of ethnic groups that have contributed to our national heritage, and whose dishes, decor, attitudes, customs and costumes have been blended and refined into what is considered typically American, it appears that use of that term in connection with a restaurant is nebulous, at best.

* We note that opposer has introduced the pertinent yellow pages of Washington and Northern Virginia telephone directories showing applicant's services listed under the heading "American" in the restaurant section. However, that entry is inconclusive since we do not know on what criteria it is based. It is also noted that under the same category are included restaurants which specify that they serve certain ethnic dishes, such as, *Mama Ayesta Restaurant* which, it is stated, serves Arabic food and the *Cheshire Cheese Restaurant* which serves "continental cuisine" (whatever that may be).

[6, 7] In areas which lack clear definition, such as this one, we fall back on the term, suggestive. The line separating descriptive and suggestive marks is a narrow one and it is difficult at times to decide where one ends and the other begins. In the *Stix Products* case, quoted earlier, the court states that "a term is suggestive if it requires imagination, thought and perception as to the nature of the goods" (or services). Under this test, we believe that, while it may be highly suggestive, "THE AMERICAN CAFE" falls short of being merely descriptive.

Turning to the second issue, that of likelihood of confusion, we have here two marks which are similar in their use of the highly suggestive term "AMERICAN CAFE". Beyond that, each mark has a distinguishing feature, a star design (applicant) and a proper name (opposer).

[8] It is well established that a finding of likelihood of confusion cannot be predicated upon the presence in each mark of a weak or suggestive term when the remaining portions of those marks differ in appearance, sound and/or meaning. See: *Season-All Industries, Inc. v. Spring Hill Fuel Co.* 152 USPQ 515 (TTAB 1966), *Tektronix, Inc. v. Daktronics Inc.*, 189 USPQ 693 (CCPA 1976) and *Instapak-Foam Products, Inc. v. Instapak Corporation*, 189 USPQ 793 (TTAB 1976) *Altid.* (CCPA 1977).

The mark presented for registration contains a distinctive design feature which in no way has any resemblance to opposer's prefix "RICKS" and these are, in our opinion, sufficient to distinguish one from the other.

Decision

The opposition is dismissed.

* "American Cafe" translates loosely into the French, "Cafe American".

Patent and Trademark Office Trademark Trial and Appeal Board

Con-Stan Industries, Inc.
v. Nutri-System Weight Loss Medical Centers of America Inc.

Decided Dec. 1, 1981

TRADEMARKS

1. Pleading and practice in Patent Office — In general (§67.671)

Trade materials that are in evidence by means of stipulation of parties and that were accompanied by notice that merely designated items of trade literature in evidence in accordance with Trademark Rule 122(c), but are not subject of any testimony as to truth of their contents or nature of their use, are considered only for what they show on their face.

2. Class of goods — In applications to register (§67.205)

While leave to amend will not normally be granted after trial, it may be granted and amendment entered when opposer does not object and proposed amendment clearly narrows scope of identification of goods.

3. Identity and similarity — How determined — Considering other marks (§67.4059)

Mere existence on register in Patent and Trademark Office of registrations of marks comprising common elements is not evidence of circumstances that exist in market-place, or even that purchasers are familiar with marks.

4. Marks and names subject to ownership — Descriptive — Particular marks (§67.5081)

"Nutri" is weak as feature of marks in field of food and dietary supplements, and does not serve as means of distinguishing source or origin in trademark sense.

5. Acquisition of marks — Use of plurality of marks (§67.087)

Critical element of "family" doctrine is that purchasers recognize common feature as characteristic only of one party's marks.

Trademark opposition No. 62,747 by Con-Stan Industries, Inc., against Nutri-System Weight Loss Medical Centers of America Inc., by change of name of Weight Loss Medical Centers of America, Inc.,

application, Serial No. 163,453, filed Mar. 24, 1978. Opposition dismissed.

George F. Smyth and Larry F. Giffin, both of Los Angeles, Calif., for Con-Stan Industries, Inc.

Paul & Paul, Philadelphia, Pa., for Nutri-System Weight Loss Medical Centers of America Inc.

Before Rice, Allen, and Simms, Members.

Allen, Member.

Weight Loss Medical Centers of America, Inc. (hereinafter WLMC) has filed an application for registration of the mark reproduced below for specially formulated, prepared and packaged nutritional low-calorie foods used in weight reduction program:

NUTRI/SYSTEM
2000 FOODS OF THE FUTURE

In its application, WLMC claims use of the above depicted mark since January 15, 1978.

Con-Stan Industries, Inc. (hereinafter, Con-Stan) has opposed registration, alleging long prior use and registration of NUTRI-SCIENCE, for vitamin food supplements, NUTRI-CAL for low-calorie vitamin, mineral and protein food, used as a weight reducing diet, NUTRI-METICS for cosmetics, skin conditioners, tooth powder, hair shampoo, shaving cream and bath soap, NUTRI-CLEAN for all purpose household and laundry cleaner, and NUTRI-DENT for tooth powder, that the goods for which WLMC seeks to register its mark are of the same descriptive properties and category of goods as those to which Con-Stan applies its NUTRI-SCIENCE and NUTRI-CAL marks and such products are sold to the same customers; that

Reg. No. 637,956, issued Dec. 4, 1956; renewed, aff. \$8 accepted, aff. \$15 received.

Reg. No. 836,366, issued Oct. 3, 1967; aff. \$8 accepted, aff. \$15 received.

Reg. No. 914,311, issued June 8, 1971; aff. \$8 accepted, aff. \$15 received.

Reg. No. 783,361, issued Jan. 12, 1965; aff. \$8 accepted, aff. \$15 received.

Reg. No. 922,017, issued Oct. 12, 1971; aff. \$8 accepted, aff. \$15 received.

**Application of ABCOR DEVELOPMENT
CORPORATION, Assignee of
Abcor, Inc.**

Appeal No. 78-562.

United States Court of Customs
and Patent Appeals.

Dec. 14, 1978.

Appeal was taken from decision of the Patent and Trademark Office Trademark Trial and Appeal Board, Serial No. 69,925, affirming examiner's refusal to register trademark GASBADGE on principal register. The Court of Customs and Patent Appeals, Miller, J., held that trademark GASBADGE was "merely descriptive" within meaning of trademark statute and thus not entitled to protection.

Affirmed.

Rich, J., filed specially concurring opinion in which Markey, C. J., joined.

Baldwin, J., filed concurring opinion.

1. Trade Regulation § 14

Tests used by courts in determining whether a trademark is "merely descriptive" include whether mark describes ingredients, qualities or characteristics of goods, whether mark conveys information regarding a function, purpose or use of goods, whether mark describes a feature or part of goods and whether it conveys information about any properties of goods. Lanham Trade-Mark Act, § 2(e)(1), 15 U.S.C.A. § 1052(e)(1).

2. Trade Regulation § 11

Although a trademark may be generally descriptive, if it also functions as an indication of origin, it is not "merely descriptive." Lanham Trade-Mark Act, § 2(e)(1), 15 U.S.C.A. § 1052(e)(1).

3. Trade Regulation § 14

Implicit in test to determine whether a trademark is "merely descriptive" is requirement that descriptiveness of a mark,

when applied to goods or services involved, is to be determined from standpoint of average prospective purchaser; perception of mark to nonprospective purchasers would be irrelevant, because a mark primarily functions to indicate a single quality control source of goods or services involved, and this is meaningful only to prospective purchasers or patrons. Lanham Trade-Mark Act, § 2(e)(1), 15 U.S.C.A. § 1052(e)(1).

4. Trade Regulation § 223

Evidence of context in which a trademark is used on labels, packages or in advertising material directed to goods is probative of reaction of prospective purchasers to mark. Lanham Trade-Mark Act, § 2(e)(1), 15 U.S.C.A. § 1052(e)(1).

5. Trade Regulation § 14

Proposed abstract test for determining whether a trademark is "merely descriptive" was deficient, not only in denying consideration of evidence of advertising materials directed to goods, but in failing to require consideration of mark "when applied to the goods" as required by trademark statute. Lanham Trade-Mark Act, § 2(e)(1), 15 U.S.C.A. § 1052(e)(1).

6. Trade Regulation § 15

Trademark GASBADGE for device to determine and monitor personal exposure to gaseous pollutants was "merely descriptive" within meaning of trademark statute. Lanham Trade-Mark Act, § 2(e)(1), 15 U.S.C.A. § 1052(e)(1).

Richard P. Crowley, Boston, Mass., attorney of record, for appellant.

Joseph F. Nakamura, Washington, D. C., for the Commissioner of Patents; Harry I. Moatz, Asst. Sol., U. S. Patent and Trademark Office, Washington, D. C., of counsel.

Before MARKEY, Chief Judge, RICH, BALDWIN, and MILLER, Associate Judges, and FORD,* Judge.

*The Honorable Morgan Ford of the United States Customs Court, sitting by designation.

MILLER, Judge.

This is an appeal from the decision of the Patent and Trademark Office Trademark Trial and Appeal Board ("board"),¹ affirming the examiner's refusal to register appellant's trademark GASBADGE on the principal register as "merely descriptive" within the meaning of section 2(e)(1) of the Lanham Act.² We affirm.

BACKGROUND

Appellant's application³ states that the goods for which the mark has been adopted are "Device to determine and monitor personal exposure to gaseous pollutants."

In its opinion, the board, citing *Ex parte International Spike, Inc.*, 190 USPQ 505, 506 (TTAB 1976), said that—

whether or not a term is merely descriptive in a trademark sense must necessarily be considered in relation to the specific goods for which registration is sought, the context in which it is used on labels, packages, or advertising material directed to these goods, the possible significance of the term in relation to the goods, and the likely reaction thereto of the average purchaser as he encounters the goods in the marketplace.

The board considered appellant's advertising literature, describing the "Walden Gas Monitoring Badge Service" and the badge,⁴ and the specimen labels ("Gas Badge" appears within a parallelogram preceded by "Walden") filed with the application. It found that "[t]he purchasers and prospective purchasers of these goods are obviously aware of the function and characteristics of applicant's badges." After considering the

nature of the goods and the context in which the mark was used (particularly the advertising literature), it concluded that GASBADGE "leaves nothing for speculation or conjecture" and that "[t]he term immediately and unequivocally describes the purpose and function of applicant's goods." It, therefore, held that GASBADGE is "merely descriptive" and not registrable.

Citing *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 295 F.Supp. 479, 487, 160 USPQ 777, 784 (S.D.N.Y.1968), appellant argues that the proper test for determining mere descriptiveness is whether the mark conveys forthwith an immediate idea of the ingredients, qualities, or characteristics of the goods "to the ultimate consumer, who has never seen the product and does not know what it is." It contends that GASBADGE does not satisfy this test, because: (1) the mark "does not convey any idea of the ingredients, qualities, or characteristics of the goods," i. e., the mark is not descriptive; and (2) the mark does not convey such an idea forthwith and immediately, and examination and study of appellant's literature is required to reach a conclusion regarding the nature of appellant's goods. Alternatively, appellant contends that, assuming the mark describes the goods, the mark is not "merely descriptive," since considerable thought (over a period of time) is required to arrive at a conclusion regarding the nature of the goods. Appellant also argues that certain third-party registrations⁵ were not given full consideration.

1. Reported at 197 USPQ 547 (1978).

2. 15 U.S.C. § 1052(e)(1).

3. Serial No. 69,925, filed November 24, 1975.

4. One item describes the badge as follows:

The Walden Gas Monitoring Badge provides a means of determining personal exposure to certain gaseous pollutants. A specially-treated element in the badge collects the gas in proportion to the product concentration and time of exposure. By standardizing and recording exposure time, gaseous pollutant determinants can be related to the

eight hour time weighted average (T.W.A.) concentration encountered during exposure as required by OSHA.

5. The only one found by the board to be material was the service mark NUCLIBADGE for "determining the radiation dosages accumulated by persons exposed to X-rays and nuclear radiations and particles." The service mark GASBADGE for "analysis and reporting of the concentration of vapors and gases to which individuals are exposed" has not been made of record.

Cite as 588 F.2d 811 (1978)

The solicitor agrees with the test used by the board and contends that determination of whether a mark is "merely descriptive" requires consideration of the mark as it is applied to the goods, and not in the abstract as proposed by appellant.

OPINION

Marks which are "merely descriptive" of the goods or services have long been denied protection. The Supreme Court, in *Beckwith v. Commissioner*, 252 U.S. 538, 543, 40 S.Ct. 414, 416, 64 L.Ed. 705 (1920), said that—

the law would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients or characteristics of an article of trade; this for the reason that the function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this.

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products. *Armour & Co. v. Organon Inc.*,

6. *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, 164 F.2d 603, 35 CCPA 802, 76 USPQ 97 (1947), cert. denied, 333 U.S. 875, 68 S.Ct. 904, 92 L.Ed. 1151 (1948).

7. This court has indicated that "merely" means "only." *In re Colonial Stores*, 394 F.2d 549, 552, 55 CCPA 1049, 1053, 157 USPQ 382, 385 (1968).

8. For example, *Warner & Co. v. Lilly & Co.*, 265 U.S. 526, 528, 44 S.Ct. 615, 68 L.Ed. 1161 (1924); *Beckwith v. Commissioner*, supra.

9. *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, supra.

10. *In re Reynolds Metals Co.*, 480 F.2d 902, 178 USPQ 296 (CCPA 1973); *In re Realistic Co.*, 440 F.2d 1393, 58 CCPA 1204, 169 USPQ 610

245 F.2d 495, 498 and 500, 44 Cust.Pat.App. 1010, 1014 and 1016, 114 USPQ 334, 337 and 338 (1957).

The Lanham Act incorporates the common law proscription against "merely descriptive" marks in section 2(e)(1)⁶ as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them

[1,2] Various tests have been used in determining whether a mark is "merely descriptive."⁷ In early cases the Supreme Court⁸ considered whether the mark describes the ingredients, qualities, or characteristics of the goods. This court has applied the same test.⁹ It has also looked to whether the mark conveys information regarding a function, or purpose, or use of the goods.¹⁰ Other considerations include whether the mark describes a feature or part of the goods¹¹ and whether it conveys information about any properties of the goods.¹² Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not "merely descriptive."¹³

(1971); *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504, 43 CCPA 970, 110 USPQ 293 (1956); *In re W. A. Sheaffer Pen Co.*, 158 F.2d 390, 34 CCPA 771, 72 USPQ 129 (1946).

11. *Sylvania Elec. Prods., Inc. v. Dura Elec. Lamp Co.*, 247 F.2d 730, 114 USPQ 434 (CA 3 1957).

12. See J. Gilson, *Trademark Protection and Practice* § 2.03 at 2-31 (1977); E. Vandenburg, *Trademark Law and Procedure* § 4.30 (2d ed. 1968).

13. E. Vandenburg, *Trademark Law and Procedure*, supra at 91-92.

We note that the Seventh Circuit, in *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379, 188 USPQ 623, 635, cert. denied, 429 U.S. 830, 97 S.Ct. 91, 50 L.Ed.2d 94, 191 USPQ 416 (1976), quoted A. Seidel, S. Dalroff & E. Gonda, *Trademark Law and Practice* § 406, at 77 (1963), for what it regarded as the best statement of the distinction between a descriptive and suggestive mark:

"Generally speaking, if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive."

This is similar to appellant's alternate proposed test. It is also similar to the test approved by the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11, 189 USPQ 759, 765 (CA 2 1976), namely:

A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.¹⁴

In *In re American Society of Clinical Pathologists*, 442 F.2d 1404, 1407, 58 CCPA 1240, 1243, 169 USPQ 800, 801 (1971), this court impliedly approved this test by stating that the service mark involved was "merely descriptive," since it "would immediately convey to one seeing or hearing it the thought of appellant's services."

[3,4] However, implicit in this test is the requirement that descriptiveness of a mark, when applied to the goods or services involved, is to be determined from the standpoint of the average prospective pur-

chaser.¹⁵ In *re Andes Candies, Inc.*, 478 F.2d 1264, 178 USPQ 156 (CCPA 1973); *In re Automatic Radio Manufacturing*, 404 F.2d 1391, 56 CCPA 817, 160 USPQ 233 (1969); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699, 131 USPQ 55, 60 (CA 2 1961). See E. Vandenburg, *Trademark Law and Procedure*, supra note 12, at 92-93. Evidence of the context in which a mark is used on labels, packages, or in advertising material directed to the goods is probative of the reaction of prospective purchasers to the mark. In *re American Society of Clinical Pathologists*, supra. See *In re Thunderbird Products Corp.*, 406 F.2d 1389, 56 CCPA 969, 160 USPQ 730 (1969). To hold otherwise would be to separate the concept of the average prospective purchaser from the world of reality.

[5] Appellant's proposed abstract test is deficient—not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark "when applied to the goods" as required by the statute.

[6] Considering appellant's trademark GASBADGE when applied to appellant's goods and considering further the record evidence of appellant's advertising materials to which the average prospective purchaser is presumed to have been exposed, which clearly identify the gaseous pollutants collection function of appellant's device and its use in determining personal exposure to such pollutants, leaving nothing for the exercise of imagination when viewing the mark,¹⁶ we agree with the board that the term GASBADGE immediately

14. Although citing *Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, supra, 295 F.Supp. at 487, 160 USPQ at 785, it is significant that the Second Circuit did not include the phrase "to one who has never seen it [the product] and does not know what it is," which appears on the preceding page of the *Stix* opinion and is the essence of appellant's abstract test.

15. The perception of the mark to nonprospective purchasers would be irrelevant, because a

mark primarily functions to indicate a single quality control source of the goods or services involved, and this is meaningful only to prospective purchasers or patrons.

16. Conceivably, a "gas badge" could be designed to detect the danger of a gaseous explosion in an area unoccupied by personnel, but such a device is clearly excluded by appellant's advertising.

and unequivocally describes the purpose and function of appellant's goods.¹⁷

Accordingly, we hold that GASBADGE is "merely descriptive" for purposes of section 2(e)(1) of the Lanham Act.

The decision of the board is *affirmed*.
AFFIRMED.

RICH, Judge, concurring, with whom MARKEY, Chief Judge, joins.

For all the majority's extensive review and discussion of various "tests," propounded from time to time in various places, for determining § 2(e)(1) descriptiveness, the opinion fails to state why I believe GASBADGE is "merely descriptive" under the statute.

My reasoning is very simple and requires no application of an elusive test. The ultimate in descriptiveness is the *name* of a thing. *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 48 CCPA 1004, 129 USPQ 411 (1961); *In re Cooper*, 254 F.2d 611, 45 CCPA 923, 177 USPQ 396 (1958). The description of the goods for which GASBADGE is sought to be registered, set forth as the single item of goods named in the application, is "chemically treated badge to determine and to monitor the amount of personal exposure of an individual to gaseous pollutants." This, of course, is a wordy explanation which does not qualify as a *name* in the usual sense of the word. So, what is the name of this article? Appellant's own descriptive literature of record in the PTO provides the answer. The name is "Gas Monitoring Badge." This may be regarded as the *full* name. However, the users of language have a universal habit of shortening full names—from haste or laziness or just economy of words. Examples are: automobile to auto, telephone to phone, necktie to tie, gasoline service station to gas station. I regard it as *inevitable* that a gas monitoring badge will be called a gas badge as the

name of the goods to the same extent as gas monitoring badge is the name and for that reason, and without application of some textwriter's "test," deduced from some case having dissimilar facts, I find it "merely descriptive."

Appellant's brief, I note, never comes to grips with this realistic analysis and seems pointedly to avoid discussion of the name of the object to which the mark is applied. The argument is devoted mostly to discussion of other cases which, we have repeatedly said, are of very little value in solving trademark registration problems.

Furthermore, nearly a half century of dealing with trademark problems persuades me that "descriptiveness," "mere" or otherwise, is a many-faceted question which must be decided on a case-by-case basis. I do not believe it is possible to devise any universally applicable test for determining the multifarious problems which arise under § 2(e) and (f). I note particularly that there is a big difference between a case involving the name of a thing and a case involving a mark which describes or suggests some function, ingredient, quality, or characteristic of the thing. We have here a name problem and I see no point in discussing cases of other types, which are without value as precedents, or other unhelpful generalities. It is not the function of an opinion to write a treatise but to explain why an issue is decided as it is.

The majority does not appear to read the board opinion as I do. (See footnote 17). While the board did not use the word "name" in its opinion, it used its equivalent—"appellation." It noted that the specimen labels "display the notation 'WALDEN' and the notation 'GASBADGE'" and then it immediately pointed out that the labels contain "no generic appellation for the goods * * *." To me that is equivalent to saying that GASBADGE is the *only* "appellation" appearing on the labels, espe-

17. We note that the board did not rest its decision on the ground that GASBADGE is the shortened form of the name GAS MONITORING BADGE. If the board believed that the term was the name for the goods, it would have

so held. Also, it is not for this court to indulge in speculation that at some future time the public will inevitably so regard the term. See 15 U.S.C. § 1064(c).

cially when taken with the balance of the opinion which points out that the article is a *badge* and that it monitors *gas*. I think it is not speculating to say that the present name of the article is "GASBADGE" and I think I am not departing from the board's ground of refusal just because the board chose to say the mark is "merely descriptive." All names of articles are just that and always within the proscription of § 2(e)(1).

The board also said in its conclusion, "'GASBADGE' leaves nothing for speculation or conjecture. The term immediately and unequivocally describes the purpose and function of appellant's goods." That is what *names* do. They tell you what the thing *is*. I am sure the board believed GASBADGE to be a name—in fact, a "ge-

neric" name in the sense in which trademark lawyers use that term.

BALDWIN, Judge, concurring.

I agree with both the analysis and result reached in the majority opinion and accordingly join therewith.

It appears to me that the mark for which registration is sought not only describes the purpose and function of appellant's goods, but *is* also the name of the goods.



being originals of exhibits 3, 4, 6 and 7 and as not having a proper foundation. As a result of this objection, counsel for Feakins requested that a search for the originals be made by employees of Shell Development Company, a company which, according to counsel, is not under the authority or "control" of Shell International Research Maatschappij, B.V. (Shell International), the assignee of the party Feakins. As a result of the search, some originals and additional documents were discovered and were obtained by Feakins counsel on January 27, 1986. Feakins now requests permission to rely upon those originals and the additional documents and to take the testimony of an unidentified witness to show that the other originals which could not be found were either lost or destroyed.

ADDITIONAL DOCUMENTS

The motion papers before us are not considered to contain a showing of "sufficient cause" within the meaning of 37 CFR 1.287(d)(1). It appears that the party Feakins knew of the involvement of Shell Development Company concerning the subject matter of this interference at least as early as November 21, 1984, the date of the filing of Feakins' amended preliminary statement together with the declaration of Mr. Tujin. However, the motion papers contain no satisfactory explanation why counsel for Feakins, as ordinary prudence would have dictated, did not seasonably request, or could not have requested, that Shell Development Company make a search of its records for such documents.

Feakins argues that these additional documents were not under the "control" of the assignee of the party Feakins, e.g., Shell International, but were under the control of the Shell Development Company. For this reason, Feakins is apparently of the view that he was under no duty to request earlier that Shell Development Company search its records and produce documents relevant to this interference. We do not consider that Feakins' argument is well taken.

As the party who wants the additional documents in evidence, and as the one in the best position to know, the burden falls upon Feakins to establish (with properly established facts, not legal conclusions) that the documents were not in the possession, custody or control of (the party) Feakins. In other words, a party presenting a document into evidence is presumed to have been in control within the meaning of § 1.287(a)(1) unless the record shows otherwise.¹ Indeed, the evidence ap-

pears to be to the contrary. Mathewson points to pages 5 and 6 of the testimony of Feakins which according to Mathewson shows that "these Shell companies work together... with a common purpose."

In this case, we note that Feakins testified concerning his numerous contacts with Cunningham and Sters, employees of Shell Development Company, that pursuant to 37 CFR 1.287(a)(1)(iii) Feakins listed these persons as witnesses and that pursuant to 37 CFR 1.287(a)(1)(i) Feakins listed copies of documents originating from Shell Development Company. Under these circumstances, we find that Feakins was in a position to influence the Shell Development Company to make available the additional documents. Consequently, we conclude that these additional documents were under the "control" of the party Feakins. For the foregoing reasons, the motion is denied.

THE ORIGINALS

As noted above, Mathewson objected to certain exhibits as not being originals. In his motion, Feakins requests permission to rely upon some of the originals found by him and to take testimony to show that the other originals have been lost or destroyed. In his opposition to the motion, Mathewson states:

An interference testimony period is in essence the trial. Prior to trial, it should have been envisaged that the best evidence rule will play a part in the proceedings, particularly where copies of documents rather than originals are to be offered into evidence.

What the party Feakins wishes to do at this time is something that would normally have been done at trial.

In setting the documents, he will be deemed to control them. See Wright, *Discovery*, 35 FRD 39 at 80 (1963). "The basic test of the rule is control." See also *Biffert v. States Marine Corp. of Delaware*, 11 FRD 44 (SDNY 1951) and the case cited by Kane, *Societe Internationale v. Rogers*, 357 US 197 (1958). Cf. *Beck v. Teague*, 534 F.2d 300, 188 USPQ 625 (CCPA, 1976), where Teague relied solely on oral testimony to establish an actual reduction to practice of a machine and did not attempt to place into evidence the machine, which was owned by a third party. Beck moved for sanctions because of Teague's failure to introduce the machine into evidence. The Court noted the Board's holding that the machine was not the best evidence and held that Beck as the moving party seeking sanctions under 37 CFR 1.287(d)(1) had the burden to show that the machine was under the control of Teague, a burden not sustained by Beck.

See *Auborn v. Blongren*, 207 USPQ 119 (Bd. Int., 1979). We must rely on the representations of the parties as to the facts as we do not consider the testimony piecemeal.

It appears that not until trial began did it occur to Feakins that a search should be made for original documents.

Unless there is some good reason other than an objection by counsel for Mathewson to the use of copies which could certainly have been anticipated, there is insufficient cause why such testimony should be allowed at this time.

Neither party has stated the nature of the documents about which the testimony is requested. Thus we cannot ascertain whether testimony is necessary. We note that it is often the practice for parties involved in an interference to stipulate to the use of copies instead of originals not only for the benefit of the parties but also for the benefit of the PTO. After the termination of an interference, the PTO will retain the exhibits introduced into evidence for the inspection by the public as provided for by 37 CFR 1.114(a). Because the PTO has limited storage capability, it would be unduly burdensome for the PTO to store the entire laboratory notebook where only a few pages thereof are being relied upon by a party in its testimony.

[2] We do not consider that Mathewson has raised a proper objection under Federal Rules of Evidence (Fed. R. Evid.) which apply to interference proceedings, where appropriate. See 37 CFR 1.286. Rule 1003 of the Fed. R. Evid. reads as follows:

A duplicate is admissible to the same extent as an original unless (1) a genuine question is raised as to the authenticity of the original or (2) in the circumstances it would be unfair to admit the duplicate in lieu of the original. In the opposition before us, Mathewson does not allege that he has raised a genuine question as to the authenticity of any original. Nor does he allege that under the circumstances it would be unfair to admit the duplicate in lieu of the original. To the extent that there might be a conflict between the best evidence rule and Rule 1003, we note that Rule 1004, Fed. R. Evid., provides for the use of duplicates where the original is lost or destroyed. Rule 1004 reads, in part, as follows:

The original is not required, and other evidence of the contents of a writing, recording, or photograph is admissible if—

(1) Originals lost or destroyed. All originals are lost or have been destroyed, unless the proponent lost or destroyed them in bad faith....

A "technical" objection having been raised, we are of the view that Feakins should have the opportunity to overcome the deficiency inasmuch as he has offered to do so. We perceive of no substantial injury to Mathewson within the meaning of 37 CFR 1.285 by permitting

Feakins to do so, nor has Mathewson alleged any.

For the foregoing reasons, the motion is granted to the extent that Feakins will be permitted to rely upon the originals and to take special testimony to show that the other originals have been lost or destroyed.

SETTING OF TIMES

Special testimony of Feakins to close April 11, 1986.

The other times remain as set in Paper No. 43.

Patent and Trademark Office Trademark Trial and Appeal Board

In re Diet Tabs, Inc.

Decided January 30, 1986

TRADEMARKS

1. Marks and names subject to ownership — Descriptive — Misdescriptive or not descriptive — Particular marks (\$67,5078)

"Diet Tabs" is not merely descriptive of vitamin supplement tablets.

Appeal from Trademark Examining Attorney.

Application for registration of trademark of Diet Tabs, Inc., Serial No. 397,901, filed September 30, 1982. From decision refusing registration, applicant appeals. Reversed. Donald A. Kaul and Pamela Rask, both of Boston, Mass., for applicant.

David Shalant, Trademark Examining Attorney, Law Office 7 (Lynne Beresford, Managing Attorney), for the Patent and Trademark Office.

Before Simms, Sams, and Krugman, Members.
Simms, Member.

Diet Tabs, Inc., a Massachusetts corporation, has appealed from the final refusal of the Examining Attorney to register the mark DIET-TABS for vitamin supplement tablets.¹ The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC § 1052(e)(1), arguing that applicant's mark not only merely describes a characteristic of applicant's goods but also could function as an apt name thereof.

We reverse.

¹ Serial No. 397,901, filed September 30, 1982, claiming use since August 25, 1982.

In support of his refusal, the first Examining Attorney to handle this case relied upon the following dictionary definition from *The Random House College Dictionary* (Revised Edition) (no date available):

tab. 1. (in prescriptions) tablet. . . . 2. table; tables.

The Examining Attorney's argument runs as follows:

Applicant's goods are chewable vitamin supplement tablets which are intended to be used as part of a well-balanced dietary program. As such, argues the Examining Attorney, the word DIET is descriptive of applicant's vitamin supplements. Since "tabs" is an abbreviation in the pharmaceutical trade for "tablets," the term DIET-TABS is simply another expression for the term "diet tablet."

We agree with applicant that the term DIET-TABS does not convey to the average purchaser a readily understood meaning of a characteristic or feature of its goods.

Part of the difficulty in analysis of this case probably stems from the several meanings of the term "diet." As the Examining Attorney pointed out in response to our remand order, a "diet" may refer, on the one hand, to a controlled or restricted weight-loss regimen, or, on the other, to one's ordinary or usual food intake, the meaning, for example, in the sentence "I need something to supplement my daily diet." If applicant's mark DIET-TABS is perceived as a shortened version of the phrase "diet tablets," then the mark may be deceptive since applicant's goods are not diet pills or tablets which suppress one's appetite, but rather are vitamin tablets. However, as noted in footnote 2, the issue of deceptiveness or deceptive misdescriptiveness is not before us. If, on the other hand, applicant's mark is perceived by purchasers or users as another

expression for "dietary tablet" (a term which would be descriptive of applicant's vitamin tablets), then the refusal would be well-taken.

On this record, however, we cannot say that the average purchaser is likely to perceive the term DIET in applicant's mark as a shorthand reference to "dietary" — there is simply no evidence on this point — or that the mark as a whole would be perceived as a shortened expression for "dietary tablet." The evidence is simply insufficient to support a refusal that the mark is merely descriptive.

[1] Since there is no evidence that DIET-TABS is merely descriptive of applicant's vitamin supplement tablets, we must reverse.

Decision:

The refusal of registration is reversed.

Patent and Trademark Office Trademark Trial and Appeal Board

In re Clutter Control Inc.
Decided March 30, 1986

TRADEMARKS

1. Marks and names subject to ownership — Descriptive — In general (§67.5071)

"Construct-a-Closet" is merely descriptive for components used to construct personal storage systems, namely, panels, shelves, rods, rod cups, shelf clips, and angle brackets as term describes use of applicant's various components.

2. Disclaimer — To procure registration (§67.277)

Evidence demonstrating that design format in which merely descriptive word mark "Construct-a-Closet" is presented makes striking commercial impression, which is separate and apart from word portion of mark, supports allowance of registration upon disclaimer of words.

We have excluded from consideration a computer printout showing use of the term TAB or TABS in trademarks in International Class 5. In his view, is neither deceptive nor deceptively misdescriptive when applied to applicant's vitamin supplement tablets. Action on the appeal was then resumed.

Appeal from Trademark Examining Attorney.

Application for registration of trademark of Clutter Control, Inc., application, Serial No. 410,207, filed January 20, 1983. From decision refusing registration, applicant appeals. Affirmed.

Allen M. Krass, Thomas N. Young, G. Gregory Schivley, and Thomas K. Ziegler, all of Detroit, Mich., for applicant.

Craig D. Taylor, Trademark Examining Attorney, Law Office 6 (Ronald E. Wolfington, Managing Attorney) for the Patent and Trademark Office.

Before Rice, Sams, and Krugman, Members.

Sams, Member.

Clutter Control, Inc. has appealed from the Trademark Examining Attorney's final refusal to register its mark "CONSTRUCT-A-CLOSET", in the form shown below, for "components"

CONSTRUCT-A-CLOSET

used to construct personal storage systems — namely, panels, shelves, rods, rod cups, shelf clips, and angle brackets." The Examining Attorney refused registration, under Section 2(e)(1) of the Trademark Act, on the ground that applicant's mark "CONSTRUCT-A-CLOSET" is merely descriptive of the goods to which it is applied.

The arguments of the Examining Attorney and applicant are easily summarized. The Examining Attorney contends that, when the mark "CONSTRUCT-A-CLOSET" is applied to the various components sold by applicant, the mark does nothing more than inform purchasers that those components are to be used in the construction of closets. Applicant, relying on dictionary definitions of the word "closet", argues that the word "closet" connotes a room or recess built into the walls of a home or office and that the products it sells under its mark are not the structural components of such rooms or recesses but, rather, are components of shelves and storage units that are inserted into existing closets. Applicant contends, therefore, that its mark "CONSTRUCT-A-CLOSET" is no more than sug-

gestive of the goods in connection with which it is used.

[1] The descriptiveness of a term, is, of course, determined from the viewpoint of the relevant purchasing public. In re Abcor Development Corporation, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978). The only pieces of evidence of record concerning the likely reaction of purchasers to the words "CONSTRUCT-A-CLOSET" are (i) the dictionary definitions of "closet" made of record by applicant and (ii) advertising literature submitted by applicant in connection with the application to register. As far as the dictionary definitions of "closet" are concerned, we believe applicant has too narrowly read those definitions. We believe that the panels, shelves, rods, and the like to which applicant's mark is applied would, when inserted into a room or recess in a house or office, be considered by the relevant purchasing public just as much structural components of a "closet" as the recessed room itself. The advertising literature submitted by applicant corroborates our opinion on this point. Specifically, in its advertising, applicant states that, with its "closet designs you can easily double or triple your existing space" and that, with its "CONSTRUCT-A-CLOSET" components, "you can create your own custom closet. . . . We find, then, that the words "CONSTRUCT-A-CLOSET" describe the use of applicant's various components and, therefore, are merely descriptive within the meaning of section 2(e)(1) of the Trademark Act.

There remains, however, an additional issue for determination. Applicant argues that the design format in which its word mark "CONSTRUCT-A-CLOSET" is presented is sufficiently distinctive that the registration should be allowed. The Examining Attorney argues that the design, in and of itself, is not sufficiently unique or striking to function as a trademark for applicant's goods.

[2] When words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed, under Section 6 of the Trademark Act. See In re Venturi, Inc., 197 USPQ 714 (TTAB 1977). In re Jackson Hole Ski Corp., 190 USPQ 175 (TTAB 1976); U.S. Steel Corp. v. Vaso Metals Corp., 394 F.2d 1009, 157 USPQ 627 (CCPA 1968). In re First National Bank of Canton, 152 USPQ 293 (TTAB 1967). In our opinion, the tubelike rendition of the letter "C" in the words "construct" and "closet" make a striking commercial impression, separate and apart from

dence to establish with particularity its points of novelty. On remand, in addition to the evidence on record, Amint "must introduce . . . at a minimum . . . [the] prosecution history [for the '218 patent], and the relevant prior art references cited in the prosecution history; and must present, in some form, its contentions as to 'points of novelty.'" *Id.* at 1384. Moreover, Amint may find it advantageous "to present additional evidence, such as expert testimony, to assist the fact finder in understanding its contentions pertaining to the points of novelty." *Id.*

Conclusion

Because the trial court mistakenly applied both the extrinsic and intrinsic tests for substantial similarity in copyright infringement, and an element-by-element test for design patent infringement, this court reverses the grants of summary judgment of non-infringement and remands for further proceedings as appropriate.

COSTS

Each party shall bear its own costs.

REVERSE and REMAND

In re Grand Forest Holdings Inc.

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board

Serial No. 78220033

Decided January 31, 2006

TRADEMARKS AND UNFAIR TRADE PRACTICES

[1] Registration and its effects — Non-registrable subject matter — Descriptive; deceptively misdescriptive (§ 315.0407)

Types of marks — Descriptive — Particular marks (§ 327.0303)

Term "Freedom Fries" is not merely descriptive of applicant's frozen french fried potatoes, since there is no indication in record that term "freedom" has any meaning in relation to french fries, or that there is subcategory of fried potatoes known as "freedom

fries," since there is evidence of movement during 2003 to refer to french fries as "freedom fries," but little evidence that effort has met with much success, since such evidence is insufficient to support refusal to register "Freedom Fries" as merely descriptive, and registration cannot be refused on ground that term might become descriptive in future, and since any doubt with respect to issue of descriptiveness must be resolved in applicant's favor.

Appeal from refusal of application for trademark registration (David C. Rehner, examining attorney; Craig D. Taylor, managing attorney).

Application of Grand Forest Holdings Inc.¹ for registration of "Freedom Fries" as trademark for frozen french fried potatoes. Applicant appeals from final refusal of registration. Reversed.

Patricia A. Wilczynski Brozek, Huntington, N.Y., for applicant.

Before Quinn, Hohnen, and Drost, administrative trademark judges.

Drost, J.

On February 28, 2003, Grand Forest Holdings Incorporated (applicant), a Canadian corporation, applied to register the mark FREEDOM FRIES, in standard character form, on the Principal Register for goods identified as "frozen French² fried potatoes" in Class 29. The application (Serial No. 78220033) is based on applicant's allegation of a bona fide intention to use the mark in commerce. Applicant has disclaimed the term "Fries."

The examining attorney refused to register applicant's mark on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), of applicant's goods. The examining attorney's position (Brief at 2-3) is set out below:

¹ The application was originally filed in the name of Irving Pulp & Paper, Limited. A document recording a change of name to the current applicant was subsequently recorded at Reel/Frame No. 3117/0056.

² The capitalization of the word "French" from the quoted sources was inconsistent. We have chosen for consistency sake to spell the word as "French" regardless of the original spelling.

After the United States military invasion in 2003 of Iraq, which was met with diplomatic opposition by the government of France, restaurants around the United States as well as restaurants and snack bars of the United States House of Representatives at the order of several members of the House, substituted the designation "freedom fries" for French fries as a symbolic gesture of displeasure with the government of France. "Freedom fries" was dubbed the new name for the goods. News about the new name for French fries and the events surrounding the adoption of the new name for the goods spread throughout the United States. Evidence showing the publication of stories about the events and the trend of renaming French fries as "freedom fries" was presented to applicant in each Office Action in which registration was refused.

The publicity about the renaming of French fries has been considerable. Correspondingly, the purchasing public would recognize the designation FREEDOM FRIES as an alternate, albeit new, descriptive name for French fried potatoes.

Applicant responds to the examining attorney's refusal by arguing (Reply Br. at 3-4) (footnote omitted) that:

There is no dispute that the term FREEDOM does not convey any direct information about the character of the goods in this case — "frozen French-fried potatoes."

Furthermore, the Examining attorney's conclusion that based on the evidence, *the consuming public* considers the mark FREEDOM FRIES a secondary or non-trademark designation for "frozen French fried potatoes," is incorrect. Careful review of the pertinent evidence of record points in the exact opposite direction — that the consuming public does not consider the term to be an "alternative" designation for French fries. There is NO TREND toward renaming French fries as suggested by the Examining attorney. The pertinent articles of record were all written during a two month time span, two years ago, at the start of the war and even these articles evidence the unwillingness of the consuming public to adopt the terminology. The evidence of record demonstrates that prepared and ready to consume French fries have not been renamed on menus and other packaging

and there is absolutely no evidence at all pertaining to the descriptive use of the term FREEDOM FRIES for frozen vegetables — the goods at issue being "frozen French-fried potatoes."

After the examining attorney made the refusal final, applicant appealed to this board. An oral hearing was held October 20, 2005.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a significant function, purpose, or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"). *In re Neit Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. *Abcor*, 200 USPQ at 218.

The examining attorney has included numerous references to support his position that the term FREEDOM FRIES is merely descriptive when it is used on frozen French fried potatoes. Perhaps the most illuminating one is an entry in Wikipedia, an online encyclopedia. Highlights from the article are set out below:

Freedom Fries, more commonly known as French fries, are potatoes that have been cut and deep-fried. On March 11, 2003, Representatives Robert W. Ney and Walter Jones declared that all references to "French fries" and "French toast" on the menus of the restaurants and snack bars run by the House of Representatives would be re-moved. House cafeterias were ordered to re-name French fries as "freedom fries." This action was carried out without a congressional vote, under the authority of Congressman Ney's position as Chairman of the Committee on House Administration, which oversees restaurant operations in the house.

Throughout the international debate prior to the 2003 invasion of Iraq, France expressed opposition to the US insistence on military action. According to a statement released

by Ney, this move was a symbolic effort to express displeasure with France's "continued refusal to stand with their U.S. allies" (see Iraq disarmament crisis). The statement further read: "This action today is a small, but symbolic, effort to show the strong displeasure many on Capitol Hill have with our so-called ally, France."

Congressmen Ney and Jones, however, were not the first to re-name French fries as freedom fries. A number of private restaurants across the country started the renaming movement. Neal Rowland, owner of the privately owned fast-food restaurant Cubbie's in Beaufort, North Carolina, decided to sell his fried potato strips under the name "freedom fries." Rowland claimed that his intent was not to slight the French people, but to be patriotic and support President George W. Bush. Many of Rowland's customers were among the local military troops.

The word play is reminiscent of anti-German sentiment during the First World War in which sauerkraut was renamed liberty cabbage, and hamburgers were transformed into *liberty steaks*. (Even the German measles got a new name: *liberty measles*.) This similarity is intentional: Rowland described a "conversation" about these renamed foods during World War I as the inspiration for "freedom fries."³

The earliest story is a www.cnn.com article dated February 19, 2003. The article is entitled "Fried politics: Restaurant serves 'freedom fries'" and it goes on to explain: "You can get fries with your burger at a restaurant here, but just don't ask for French fries. Neal Rowland, the owner of Cubbie's now only sells his fried potato strips as 'freedom fries'—a decision that comes as Americans watch French officials back away from support for possible war in Iraq."

Other entries include a page from www.fox.com dated May 6, 2003 that asks: "Do you think we should be calling French fries 'Freedom Fries', and do you think this name will continue to be used?" An article in the *Austin Business Journal* dated March 14, 2003, contains the following sentence: "Joining a sym-

bolic effort to support the U.S. military and protest France's stance on a potential war against Iraq, Fuddrucker's President Bryce King says 'Freedom Fries' will replace 'French fries' on menus in the 200-plus Fuddrucker's restaurants around the country."

An article from the *Pittsburgh Post-Gazette* dated March 12, 2003, refers to "resentment over the French government's opposition to the push toward war has triggered changes to menus across the country." "Everybody loves it," Davis said. "They tell him the change is very patriotic. He says sales of freedom fries and freedom toast have picked up since he put the signs in the window." The *Winchester Star* dated March 29, 2003, reports that the Amherst Diner "serves consistently have corrected customers ordering French toast or French fries about the new name. 'I correct them I say, You mean freedom fries.'" A www.cnn.com article dated March 11, 2003, has the headline "No 'freedom fries' in the French Quarter" that begins: "Don't expect to find 'freedom fries' here." A website called American-freedom-fries.com solicits "support to make a PERMANENT name change to Freedom Fries."

More recent articles include:

The French were excoriated by every radio jock in the nation. French wine was poured down gutters. French fries came out of fryers as 'freedom fries.'
Providence Journal, February 25, 2004.

American citizens show their disdain for all things French by boycotting French wines, calling French fries "freedom fries."
Akron Beacon Journal, January 1, 2004.

To chide France for not backing the Iraq invasion, some restaurants changed the name of French fries to Freedom Fries.
Hartford Courant, December 31, 2003.

Call them freedom fries or French fries, but the fast-food staples aren't making it to the place like they used to as Americans struggle to lose weight.
USA Today, September 29, 2003.

French fries became freedom fries and France, Germany and Belgium became "chocolate factory countries."
Press Journal (Vero Beach, FL), September 14, 2003.

Applicant responds by including menus from several restaurants such as McDonald's, Burger King, and Wendy's that show that these restaurants have not changed the name of French fries on their menus and that many of the articles refer to restaurants that did not change their menus to reflect the name "Freedom Fries."

[1] When we look at the evidence of record, we cannot conclude that the term FREEDOM FRIES is merely descriptive when applied to frozen French fried potatoes. First, there is no indication that the term "Freedom" has any meaning in relation to French fries. The examining attorney relies on the case of *In re Lamb-Weston Inc.*, 54 USPQ2d 1190 (TTAB 2000). However, in that case, there was evidence that the term "Natural Cut Fries" was used to describe a type of "fries with skins on." *Id.* at 1191. Here, there is no evidence that there is a subcategory of fries known as "Freedom Fries."

Second, the examining attorney argues that "Freedom Fries" is a known secondary name for French fried potatoes. It was coined as a new name for French fried potatoes (the goods themselves). Although it has not become the primary or generic name of the goods, "freedom fries" identifies French fries and as such is merely descriptive of the goods because it names the goods in a secondary manner." Brief at 5. At this point, we part company from the examining attorney's analysis. We must consider the question of descriptiveness in light of the evidence of record. We cannot agree with the examining attorney that the evidence of "renaming of French fries" has been considerable "or that there is a 'current trend of renaming French fries as 'freedom fries.'" Brief at 3. The evidence seems to indicate that there was a movement during the first half of 2003 to refer to "French fries" as "Freedom fries." It appears to have begun in a restaurant in North Carolina named Cubbie's. Shortly afterwards the U.S. House of Representatives changed its cafeteria menu to reflect the change. The evidence then shows that the restaurant chain Fuddrucker's announced that it was changing the name of French fries to Freedom Fries and a few other restaurants likewise announced or made similar changes. Beyond that point, the references to "Freedom Fries" appear to be scattered, with little evidence of actual accep-

tance of the term as the name of the goods or as a term merely descriptive of the goods. Several articles indicate a disagreement with the proposed change, such as a www.fox.com article dated August 6, 2004, while others are satirical, such as the *Milwaukee Urban Star* article. We have no quarrel with the proposition that the same food item may have several names. For example, a large overstuffed sandwich may be referred to as a "grinder," "hoagie" or "hokey," "submarine," or "hero sandwich."

Certainly, when a product changes, new generic names often result.

Moreover, these are ordinary words [SPACE SHUTTLE] which would be and are perceived by the public in their primary significance as a space vehicle which transports crew and equipment from the ground to Earth orbit and returns, and not as an indication of origin. That is, it is a shuttle which goes into space. The term is an apt and common description of NASA's space vehicle or system. Although opposer was and remains the only space agency to make a reusable space shuttle, the record fully supports the conclusion that this term is used and understood by the public as referring to the genus or classification of reusable spacecraft.

National Aeronautics and Space Administration v. Bully Hill Vineyards Inc., 3 USPQ2d 1671, 1676 (TTAB 1987). See also *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 43 USPQ2d 1734, 1743 (2d Cir. 1997) ("Because the addition of the word 'hokey' is necessary to indicate a brown ale that is brewed with honey, Stroh has the right to call its beer a 'Honey Brown Ale'").

Unlike the referenced descriptive uses of the terms "Space Shuttle" and "Honey Brown Ale," the involved use of the word "freedom" does not describe French fries in any way. While undoubtedly, there was a

³ *In re Mario's*, 182 USPQ 512 (TTAB 1974).

⁴ A large sandwich, usually consisting of a small loaf of bread or long roll cut in half lengthwise, and containing a variety of ingredients, as meat, cheese, lettuce, and tomatoes. *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987) (Revised). We take judicial notice of this definition, "hoagie." *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁵ Subsequently, applicant submitted an update of the Wikipedia website that now identifies "Freedom fries" as a "short-lived name used in the United States for French fries."

movement underway at one point to change the name of French fries, we have little evidence that would let us conclude that the effort has met with much success. A few press releases, news stories, and a handful of examples of restaurant menu changes are simply not sufficient evidence to support a refusal to register the term as merely descriptive. For example, one article entitled "Land of the Freedom Fries" claims that a "few restaurants on the east coast have stopped selling French fries." www.collegeclub.com. The number of restaurants besides the Fuddruggers chain that are actually identified as having changed the name of their menu items from French fries to Freedom Fries is not very significant. We are mindful that manufacturers, standard-setting organizations, protesters, and others have an interest in establishing generic names for goods and services. See, e.g., *McCarthy's on Trademarks and Unfair Competition*, § 12.26 (4th ed. 2005).

When a new and unfamiliar product hits the market, precautions must be immediately taken to protect the trademark significance of a mark to prevent its becoming generic. The seller has some options. It may devise a generic name for the product and use as a trademark a mark which has been previously used on other goods. For example, if Jackson Industries, Inc. proposes to market a new and revolutionary type of miniaturized two-way radio telephone of wrist-watch size, it could market it as the JACKSON brand "Radon."

Obviously, this need would be frustrated if the announcement of this new generic or descriptive term was accompanied by a rush to the U.S. Patent and Trademark Office by others to register the name. At the same time, we cannot refuse registration on the ground that a term might become generic or merely descriptive in the future. See, e.g., 15 U.S.C. § 1052(e) ("Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive") (emphasis added). Furthermore, in these cases, "any doubt with respect to the issue of descriptiveness should be resolved in applicant's behalf." *In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994).

What we lack in this case is significant evidence that, when prospective purchasers en-

counter the term FREEDOM FRIES used on frozen French fried potatoes, they will immediately understand that it identifies a feature, quality, or characteristic of applicant's goods or that it is a secondary name of applicant's goods. Therefore, we resolve our doubts in applicant's favor.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is reversed.

Coach Inc. v. Peters

U.S. District Court
Southern District of New York

No. 03 Civ. 8176 (JES)

Decided September 6, 2005

COPYRIGHTS

[1] Notice, deposit, and registration —
Registration — Procedure (§ 207.0705)
Non-copyrightable matter — In general
(§ 211.01)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Judicial review — In general (§ 410.4601)

Manufacturers of leather handbags are not entitled to summary judgment directing defendant Register of Copyrights to register copyright for plaintiffs' "Signature CC Fabric Design," consisting of pattern of four C's, since register's decision to deny application is reviewed under Administrative Procedure Act, 5 U.S.C. §§ 701-706, which affords agency decision substantial deference, and requires plaintiff to show that agency acted in arbitrary and capricious manner, since federal district court does not have authority, on review under APA, to order defendant to register works, since it was not arbitrary and capricious for defendant to interpret "elements" of plaintiffs' design as letter "C," and to determine that work was "comprised of an arrangement" of that letter, since letters and familiar symbols cannot be copyrighted, and simple arrangements of letters are, similarly, uncopyrightable, and since plaintiff's contention that

defendant failed to consider commercial and critical success of work is without merit, in that defendant considered those factors, and properly determined that they are irrelevant to question of whether work embodies required quantum of creativity.

Action by Coach Inc. and Coach Services Inc. against Marybeth Peters, Register of Copyrights, seeking order directing defendant to register copyright for fabric design. On parties' motions for summary judgment, plaintiffs' motion denied; defendant's motion granted.

Norman H. Zivn and Jason S. Martin, of Cooper & Dunham, New York, N.Y., for plaintiffs.

David N. Kelley, U.S. attorney, and Sarah E. Light, assistant U.S. attorney, New York, for defendant.

Sprizzo, J. Plaintiffs, Coach, Inc. and Coach Services, Inc. (collectively "Coach"), bring this action, pursuant to 5 U.S.C. § 702, seeking an Order of this Court directing defendant, Marybeth Peters, Register of Copyrights of the United States Copyright Office ("defendant" or "Register"), to register its "Signature CC Fabric Design" ("Coach 1") and "Signature CC Fabric Design (Black)" ("Coach 2") (collectively "works"), in their names. Both parties bring motions, pursuant to Rule 56 of the Federal Rules of Civil Procedure, for summary judgment. For the reasons set forth below, the Court denies plaintiffs' motion and grants defendant's motion.

BACKGROUND

Coach, a well-known company that designs handbags and other consumer products, see *Pls.' Statement of Uncontroverted Facts* ("Pls.' St."), ¶¶ 4, 7-9; *Am. Compl.* ("Compl.") ¶ 4, designed the now ubiquitous works at issue in this action, see *Pls.' St.* ¶¶ 5-9; *Administrative R.* of Coach 1 ("A.R. 1"), Ex. 3; *Letter of Norman H. Zivn*, dated Aug. 15, 2002 ("Aug. Zivn Letter"), Ex. A ("Articles"), see also *Decl.* of Daniel J. Ross, dated Feb. 12, 2004, Exs. N, O. Plaintiffs describe the works as "consist[ing] of a distinctive pattern comprising two linked elements

facing each other in a mirrored relationship and two unlinked elements in a mirrored relationship and positioned perpendicular to the linked elements." *Pls.' St.* ¶ 10. Plaintiffs filed applications with the United States Copyright Office to register Coach 1 and Coach 2 on August 15, 2001 and August 20, 2002, respectively. *Id.* ¶¶ 15, 21.

The application to register Coach 1 was initially denied by letter dated December 18, 2001. A.R. 1, Ex. 6. Following a request for reconsideration, that decision was upheld in a letter dated July 17, 2002. A.R. 1, Ex. 4. Plaintiffs sought a second reconsideration on August 15, 2002, Aug. Zivn Letter, which was denied by the Copyright Office Board of Appeals by letter dated September 17, 2003, A.R. 1, Ex. 1. That decision constituted "final agency action." A.R. 1, Ex. 1 at 8.

In an eight-page decision, the Board of Appeals determined that Coach 1 "could not be copyrighted 'because it does not contain the required amount of original artistic, that is, pictorial or graphic authorship.'" *Id.* at 1. Describing Coach 1 as a "pattern consist[ing] of two linked 'C's' facing each other alternating with two unlinked 'C's' facing in the same direction," *id.* at 4, the Board of Appeals concluded that relevant case law, regulations, and the Compendium of Copyright Office Practices precluded a finding of copyrightability because "letters of the alphabet cannot be copyrighted and because Coach 1's variations and arrangements of the letter 'C' were simply not sufficient to establish the necessary amount of creativity required for copyright protection," *id.* at 3-8. In addition, the Board of Appeals rejected plaintiffs' argument that the work's commercial and critical success supported its copyright. *Id.* at 6-7.

The application of Coach 2 met a similar fate. *Pls.' St.* ¶¶ 21-26. Following two requests for reconsideration, the Board of Appeals, in a letter dated December 4, 2003, refused to copyright Coach 2. *Administrative R.* of Coach 2 ("A.R. 2"), Ex. 1. The Board determined that, with the exception of its color, Coach 2 was identical to Coach 1, and there-

¹ Coach 2 is identical to Coach 1, except Coach 2 "also comprises a black on black tonal pattern." *Pls.' St.* ¶ 11.

In support of its motion, the plaintiff has provided copies of the federal copyright registrations for its ballot forms. (See Plaintiff's Verified Complaint, Exhs. 3-4). The defendants dispute that Uniscore owns valid copyrights with respect to the ballots. As the defendants correctly recognize, the author of copyrightable material is the person who actually creates the work, i.e., the person who translates one of more ideas into a fixed, tangible medium of expression. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (10 USPQ2d 1985) (1989). The defendants contend that, as early as 1989, it and not the plaintiff, had authored the ballots which formed the basis for the 1994 ballot. Assuming this to be true, the plaintiff's copyright registrations could be declared invalid and unenforceable. *GB Marketing USA, Inc. v. Gerolsteiner Brunnen*, 782 F.Supp. 763 (21 USPQ2d 1982) (W.D.N.Y. 1991). Accordingly, on the current state of the record, and at this early stage of the litigation, the plaintiff has not met its burden of demonstrating a likelihood of success on the merits.

C. Irreparable Injury

To prevail on its motion for injunctive relief, the plaintiff must also demonstrate that it would be irreparably injured absent such relief. Although the plaintiff claims its reputation would be injured absent injunctive relief, it has failed to present sufficient evidence that the defendants' election form is deficient. Further, it has failed to demonstrate how the public would associate the ballot with Uniscore. Any harm to Uniscore could be fully compensated through monetary damages. Accordingly, injunctive relief is inappropriate. *Instant Air Freight v. C.F. Air Freight, Inc.*, 882 F.2d 797, 801 (3d Cir. 1989).

D. Public Interest

The public interest militates strongly against granting temporary injunctive relief. The plaintiff asks this Court to enjoin a statewide election of delegates to the NJEA's representative body. There are over 140,000 members of the NJEA. To require the NJEA to send new ballots to its 140,000 members would result in costs wildly disproportionate to any harm potentially suffered by Uniscore. Further, because the NJEA's

The Court's holding that Uniscore has not demonstrated a reasonable probability of success on its claim that it owned valid copyrights, the Court need not proceed to the question of whether the ballots are substantially similar.

members are teachers, and because the school year is nearly over, members of the NJEA might well be denied their right to participate in the election if a new election were required to be held. Accordingly, the public interest weighs heavily against granting preliminary injunctive relief.

An appropriate Order follows.

ORDER

AND NOW, this 4th day of May, 1994, upon consideration of the Plaintiff Uniscore, Inc.'s ("Uniscore") Motion for a Temporary Restraining Order, its Motion for a Preliminary Injunction and, the Defendants' response, and after conducting a hearing on said Motions, IT IS HEREBY ORDERED that the Plaintiff's Motions are DENIED.

U.S. Patent and Trademark Office Trademark Trial and Appeal Board

In re Grand Metropolitan Foodservice Inc.

Serial No. 74/073,517

Decided April 4, 1994

Released May 23, 1994

TRADEMARKS AND UNFAIR TRADE PRACTICES

1. Registration and its effects — Federal registration — Procedure, form, and content — Disclaimer (§315.0303.10)

Registration and its effects — Non-registrable subject matter — Descriptive, deceptively misdescriptive (§315.0407)

Refusal to register "Muffins," in stylized script, for mini-muffins is reversed, since mark, which suggests both muffins and "fun" aspect of applicant's food product, will be perceived as more than simple misspelling of generic term "muffins," and is therefore not merely descriptive, since any doubt as to applicant's favor, and since applicant's disclaimer makes clear that registration will not preclude third parties from using generic term "muffins."

Funs," in stylized script, for baked mini-muffins, sold frozen or fresh (serial no. 74/073,517, filed June 28, 1990). From final refusal of registration, applicant appeals. Reversed.

Before Simms, Seeherman, and Quinn, administrative trademark judges.

Simms, administrative trademark judge.

Grand Metropolitan Foodservice, Inc. (applicant), by change of name from McGlynn Bakeries, Inc., has appealed from the final refusal of the Examining Attorney to register the mark shown below

Muffins

for baked mini-muffins sold frozen or fresh. The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC 1052(e)(1), arguing that the term sought to be registered is the phonetic equivalent or corrupt spelling of the generic term "muffins." As such, the term is unregistrable, according to the Examining Attorney. Alternatively, the Examining Attorney has held that, if the mark is not considered generic, registration is nevertheless improper because applicant has not established acquired distinctiveness under Section 2(f) of the Act, 15 USC 1052(f).

It is applicant's position that the stylized mark presented for registration is "an inventive double entendre" which incorporates the suffix "Funs," such that applicant's mark is suggestive of "fun," as well as being suggestive of its muffins. Applicant argues that the incongruous suffix used in its mark, with a capital "F," is pronounced differently from the suffix "funs" appearing at the end of the generic term "muffins." Applicant's mark has a different appearance from the generic term, therefore, as well as a different connotation or commercial impression, applicant

Application Serial No. 74/073,517, filed June 28, 1990, under Section 1(b) of the Act, 15 USC 1051(b), based upon applicant's bona fide intention to use the mark in commerce. During the course of prosecution of this case, applicant filed an amendment to allege use reciting use of the mark since January 28, 1991. With that amendment to allege use, applicant filed an amendment to the mark to show it in the form shown above. Originally applicant sought registration of the mark in typed letters.

maintains. Applicant argues that its mark, therefore, is distinctive, has a double entendre and would not be perceived by consumers as simply the generic term or the exact phonetic equivalent of the generic term "muffins." Moreover, applicant emphasizes in its promotion of its goods the "fun" or festive nature of its muffins. Finally, applicant argues that even if the Board does not consider applicant's mark to be inherently distinctive, applicant's evidence of acquired distinctiveness should lead to registration. This evidence consists of a declaration of applicant's president setting forth the dollar volume of sales of the goods (over \$650,000), the amount of money spent in advertising and promoting its products (approximately \$46,000), and a statement of applicant that its mark has become distinctive of its goods by reason of this evidence. The declaration also states:

Further, the mark MUFFUNS is distinctive by reason of the portion of the mark FUN, which is emphasized in Applicant's promotional materials in relation to the "fun" or cute nature of Applicant's products.

Finally, applicant contends that a disclaimer offered in this case will ensure that third parties will not be precluded from use of the generic term "muffins."

[1] After careful consideration of the arguments of the attorneys, we believe that this case involves more than simply a misspelling of a descriptive or generic word. That is to say, the mark presented for registration, will be perceived, we believe, as not just a misspelled word. As applicant has pointed out, its mark does project a dual meaning or suggestiveness — that of muffins and of the "fun" aspect of applicant's food product. This aspect of applicant's product is emphasized in its promotion ("What's MuffFun than one?"). We have a situation, therefore, where applicant's mark has a different com-

The disclaimer offered by applicant, which apparently has not been formally entered into the application, states:

No claim is made to the exclusive right to use the word "muffins," which is somewhat phonetically similar to Applicant's mark, apart from the mark as shown.

Inasmuch as the Examining Attorney has not objected to the entry of this disclaimer, we believe that it should be entered. However, disclaimer for marks published for opposition are printed in a standardized form regardless of the text submitted. See TMER Section 1213.09(a)(1) and notice at 1022 TMOG 44 (September 28, 1982). The use of the standardized form is solely for purposes of printing and is not a limitation of registrant's rights.

Appeal from final refusal to register trademark (Darlene D. Bullock, trademark examining attorney; R. Ellsworth Williams, managing attorney).

Application of Grand Metropolitan Foodservice Inc. to register trademark "Muff-

mercial impression or connotation from that conveyed by a misspelled generic or descriptive term. We also recognize, of course, that there is often a thin line of demarcation between a suggestive term and a merely descriptive term, and that the determination of the category into which a particular word falls is frequently a difficult determination, involving some subjective judgment. Also, any doubt with respect to the issue of descriptiveness should be resolved in applicant's behalf. *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972). Moreover, applicant's disclaimer makes clear that third parties will not be precluded by this registration from using the generic term "muffins."

In view of the nature of applicant's inventive and somewhat stylized mark, being an obvious play on the word "muffin" and the word "fun," we believe that the meaning or commercial impression of applicant's mark will be more than that simply of the word "muffins." Therefore, applicant's mark is not *merely* descriptive. See, for example, *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA, 1968) (SUGAR & SPICE held not merely descriptive for various bakery products). In view of this decision, we need not consider the evidence of acquired distinctiveness.

Decision: The refusal of registration is reversed.

their services. Accordingly, one who was acquainted with "HOME CENTERS" retail home-furnishing stores might easily erroneously assume that appellants "HOME CENTER INSTITUTE" was sponsored by or in some way connected with the home furnishing organization.

[5] That appellant had owned a previous registration of the identical mark for the same service, since cancelled due to its failure to have filed a declaration (or affidavit) pursuant to Section 8, 15 U.S.C. §1058 (1976), is irrelevant as to both grounds. In re Cooper, 254 F.2d 611, 117 USPQ 396, 401 (CCPA 1958); Duffy Mott Co. v. Borden, Inc., 201 USPQ 846, 850 (TTAB 1978). In re Thomas Collators, Inc., 158 USPQ 297, 298 (TTAB 1968). As in Cooper, we do not here have sufficient facts before us on which to evaluate whether the previous action of the Examiner which resulted in issuance of the previous registration was or was not erroneous.⁷ Nevertheless, as Cooper held, it is sufficient that the facts now before us in application to them of sound law persuade us that the mark does not meet the requirements for registration set forth in Sections 2(d) and 2(e)(1) of the statute.

Decision

The refusal of registration is affirmed on both grounds.

Patent and Trademark Office Trademark Trial and Appeal Board

In re Harrington

Decided July 27, 1983

As amended Aug. 17, 1983

TRADEMARKS

1. Pleading and practice in Patent Office — In general (§§67.671)

TTAB does not condemn practice of considering Latham Act, Section 2(e)(1) and 2(f) issues, alternatively, in appeal, provided that evidence supporting Section 2(f) claim is in record and that alternative grounds have been considered and finally decided by examining attorney; practice is now encouraged in interest of judicial economy, although previously it was discouraged.

2. Marks and names subject to ownership — Descriptive — How determined (§§67.5073)

There is nothing necessarily debilitating about mark consisting of combination of generic or descriptive terms provided combination is not also generic or descriptive.

3. Marks and names subject to ownership — Descriptive — How determined (§§67.5073)

Issue of descriptiveness must be considered in context in which designation is being used.

4. Marks and names subject to ownership — Descriptive — Misdescriptive or not descriptive — Particular marks (§§67.5078)

"College Academy" is at most suggestive of special summer learning programs for gifted and talented children in grades 4 to 8.

Appeal from Trademark Examining Attorney

Application for registration of trademark of Joseph Harrington, doing business as College Academy, Serial No. 225,957. From decision refusing registration, applicant appeals. Reversed.

Richard P. Crowley, Osterville, Mass., for applicant.
Before Rice, Allen, and Simms, Members.
Allen, Member.

[1] Before us is an appeal from the Trademark Examining Attorney's refusal of registration of "COLLEGE ACADEMY" as a service mark for "education services, namely,

providing special summer learning programs for gifted and talented children in grades 4 to 8" under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) (1976). The only issue involved in the appeal is whether the Examining Attorney's holding that the term sought to be registered is merely descriptive of the services was in error.¹ We reverse.

As the materials in the record show, the "COLLEGE ACADEMY" is a summer study program, geared toward gifted and academically talented children in grades four through eight. School enrollment is limited to IQ of 125, or can otherwise prove superior intelligence. The students' whose average age is eleven, can choose four courses from a curriculum of more than forty subjects, such as Computer Programming, Rocketry, Film Making, Architecture, Small Engine Repair, Song Writing, Shorthand, Sculpture and Mathematical Probability. Although its first location was on the campus of Framingham State College, where its founder, Dr. Joseph Harrington, is Chairman of the History Department, the summer school now also operates sessions at Holy Cross College in Worcester and Stonehill College in North Easton, Massachusetts.

As appellant concedes, the term sought to be registered consists of a combination of two terms, "college" and "academy," each of which has a commonly understood meaning in the field of education. Thus, "college" is generally understood as identifying an institu-

¹ It should be noted that applicant elected not to have the registrability of its mark determined under Section 2(f) of the Act. Concurrently with its notice of appeal, applicant had submitted photocopies of articles and press clippings concerning the mark sought to be registered and a paper stating that these materials were "submitted as evidence of recognized, secondary meaning of the mark in the educational field." (Paper No. 10, filed May 24, 1982.) However, when the Examining Attorney treated this submission as tantamount to a request for consideration of registrability pursuant to Section 2(f), applicant recanted. This position was accepted by the Board (paper No. 16, mailed March 31, 1983) subject, however, to the caveat that where the appeal decided adversely to applicant, he would not thereafter be permitted to amend the rejected application to claim distinctiveness under Section 2(f). The caveat was the result of applicant's election not to claim 2(f). Thus, we do not condemn the practice of considering both issues, alternatively, in an appeal, provided, of course, that the evidence supporting the 2(f) claim is in the record and that the alternative grounds have been considered and finally decided by the Examining Attorney. In fact, in the interest to judicial economy, the practice is now encouraged, although previously it has been discouraged by the Board.

tion of higher learning, sometimes a constituent unit of a university but not necessarily so. An "academy" is usually considered to be a secondary or high school, especially a private one.

[2] Academies may be associated with colleges and the term "academy" is not always precisely limited to below college level curricula. However — and this is appellant's principal argument — the composite of the two words is not a term in general use to describe educational services (or anything else, for that matter) and has no dictionary meaning. There is nothing necessarily debilitating about a mark consisting of a combination of generic or descriptive terms provided that the combination is not also generic or descriptive. 1, McCARTHY, TRADEMARKS AND UNFAIR COMPETITION, 428 at fn. 18, supp. at 97-98 (1973 & Supp. 1981). In this regard, it is significant, we think, that no evidence has been produced showing use of the composite term "COLLEGE ACADEMY" in the academic field. Conceding this deficiency in his position, the Examining Attorney nevertheless urges that such evidence is unnecessary where a term intrinsically has a recognized meaning, citing In re Orleans Wines, Ltd., 196 USPQ 516, 517 (TTAB 1977) ["Breadspread" descriptive of a spread for bread.] However, "Breadspread" had only one conceivable meaning. In contrast, it seems to us that "COLLEGE ACADEMY" has a variety of possible meanings and consequently the case is not in the same ball-park as Orleans Wines. "COLLEGE ACADEMY" could mean a secondary school with college level courses. Or a secondary school located at a college. Or a school with specialized instruction operated as a division of a college. None of these meanings is apposite to appellant's services because of the age level of the students to which the "COLLEGE ACADEMY" program is directed.²

² In that sense, the mark might well be characterized as misdescriptive although certainly not deeply so. See Roux Laboratories v. Chiral Inc., 427 F.2d 823, 166 USPQ 34, 37 fn. 7 (CCPA 1970) ["HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE"] considered implicitly suggestive of natural appearing hair rather than literally descriptive of the result which the slogan specifies. Here, no parent would in his or her wildest dreams assume from the "COLLEGE ACADEMY" that the gifted child was being enrolled in a college or academy level institution although the name might suggest a college or academy-like environment, curriculum, etc. From the materials submitted, this is precisely the image which appellant wishes to convey for its program.

Accordingly, the term is rather nebulous and, in our opinion, more like the mark involved in *In re The Gracious Lady Service, Inc.*, 194 USPQ 340 (TTAB 1972) ["COLLEGE CREDIT CARD" held not merely descriptive as applied to the service of surveying and canvassing college and college affiliated personnel on behalf of commercial establishments for credit information.] Compare in *re Fidelity Life and Income Mutual Insurance Company*, 144 USPQ 608 (TTAB 1965) ["COLLEGE COMPLETION FUND" held merely descriptive of a renewable decreasing term life insurance policy, designed to pay monthly college education benefits in the event of death of the insured.]

[3.4] Thus, while we fully agree with the Examining Attorney that the issue of descriptiveness must be considered in the context in which the designation is being used, we conclude that in that context "COLLEGE ACADEMY" is at most suggestive of special summer learning programs for gifted and talented children in grades 4 to 8. Consequently, the mark should be approved for publication under Section 12(a) of the Trademark Act.

² During prosecution of this application, the Examining Attorney made inquiry as to the rela-

Decision

The refusal of registration is reversed.

tionship of Framingham State College to the services offered under the mark subject of the application. In response thereto, applicant submitted a letter signed by Dr. Joseph Paladino, Dean, Graduate and Continuing Education, Framingham State College, on the letterhead of that institution, stating that "COLLEGE ACADEMY" and Framingham State College were distinct entities and other facts which we presume satisfied the Examining Attorney as to that question.

We note, however, that in the same letter it is stated that "COLLEGE ACADEMY" is a subdivision of Learning Incorporated, a private corporation under the direction of Dr. and Mrs. Joseph Harrington. It seems to us that this sentence raises a question whether ownership of the mark has been transferred to the indicated corporation. If this is so, the change in title should be recorded before publication so that registration will issue in the name of the present owner of the mark. If it is not so, appellant may wish to file a statement to this effect in order that the record will be clarified as to the mark's owner. See Trademark Manual of Examining Procedure §501.09(a)(1974, rev. 5, December 1982).

Court of Appeals, Federal Circuit

Kansas Jack, Inc. v. Kuhn et al.

Nos. 83-638/83-643

Decided Oct. 12, 1983

PATENTS

1. Patentability — Anticipation — Combining references (§51.205)

Introduction into evidence of drawings, created by selecting elements found in various prior art references, of draftsman who was guided by patentee's own disclosure is improper employment of hindsight.

2. Patentability — Anticipation — In general (§51.201)

Fact that teachings relied upon were repeated in number of references strengthens obviousness conclusion.

3. Patentability — Aggregation or combination — New or better result (§51.157)

No requirement for "an effect greater" or for "unusual or surprising results" is present in Title 35. "Effect greater" language is but longer statement of non-existent requirement for "synergism"; "results" language would erect as patentability requirement, fact determinable only after time invention was made, whereas focus must be on that time as required by statute.

4. Patentability — Evidence of — In general (§51.451)

Facts determinable at later time may serve to evidence nonobviousness as of time invention was made; invention that achieved "an effect greater" or that produced "unusual or surprising results" can be held to have been nonobvious in light of those facts; evidence of such achievements, like evidence of meeting long-felt need, commercial success, overcoming disbelief, etc., may when present, support conclusion of nonobviousness; but absence of such evidence does not dictate conclusion of obviousness.

5. Patentability — Aggregation or combination — New or better result (§51.157)

Court's finding that counsel's assertion that invention produced "an effect greater" or "unusual or surprising results" does not apply to invention before it, cannot be faulted as application of improper "standard" or "requirement" for patentability.

6. Patentability — Invention — In general (§51.501)

All evidence touching obvious-nonobvious issue must be fully considered before conclusion is reached on that issue.

7. Patentability — Evidence of — Commercial success — In general (§51.4551)

Approach saying that commercial success without invention will not make patentability is flawed.

8. Patentability — Evidence of — Commercial success — In general (§51.4551)

Under circumstances in which evidence of commercial success consisted solely of number of units sold, and there was no evidence of market share, growth in market share, or replacing earlier units sold by others or of dollar amounts, and no evidence of nexus between sales and invention's merits, evidence relating to commercial success does not require holding that invention would have been nonobvious at time it was made to one skilled in art.

9. Defenses — Fraud (§30.05)

Fraud must be proved by clear and convincing evidence and party asserting it carries heavy burden; however, intent element of fraud may be proven by showing of acts, natural consequences of which are presumably intended by actor; statement made with gross negligence as to their truth may establish such intent; it would deal deathblow to duty of candor owed PTO, which is unpromising, if direct proof of wrongful intent were required; at same time, that something thought to be true when stated, or piece of prior art thought unimportant to PTO's decision, that was later determined to have been untrue or important, will not automatically and alone establish that fraud or inequitable conduct occurred; fact finder must evaluate all of facts and circumstances in each case.

10. Defenses — Fraud (§30.05)

Pleading and practice in Patent Office — In general (§54.1)

Where one who knew, or should have known, that piece of prior art, or other information, would be material, i.e., important to PTO in making its decision, failure to disclose that art or information can be sufficient proof that wrongful intent existed to mislead PTO, and may result in finding of what has come to be called "fraud" on PTO; however, fact finder must determine not only that un-

through seed, fertilizer, and lawn care companies; and that liquid copper fungicides are not used in either the industrial enamels of applicant or, as far as applicant knows, in other industrial enamels. Industrial enamels, according to applicant, are organic paint compositions which are sold to persons who are sophisticated and knowledgeable as to their suppliers and, moreover, would have no use for liquid copper fungicides.

The Examiner has taken the position that the goods here are related sufficiently to give rise to confusion in trade because a multitude of paints are available with special chemical ingredients designed for specific uses or applications including caulking paint, damp resistant paint, fire retardant paint, insulating or heat-resistant paints, and fungus resistant paints; and that "it is quite logical to assume that the same purchaser could purchase and use the registrant's 'Copoloid' liquid copper fungicides to treat or prepare a surface prior to painting, same with the applicant's 'Copoloid' industrial enamel." The Examiner has made of record pages from The Thomas Register which reveal a listing of "PAINTS - FUNGUS RESISTANT" and advertisements by a number of companies listing a variety of different types of paints, coatings, enamels, chemical resistant fungicides and fungus resistant compounds.

[2, 3] Section 2(d) of the statute precludes registration of a mark which consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." It is apparent from the underlined portion of the section that prior rights or use do not play a decisive factor in ex parte and even opposition proceedings wherein a registered mark is cited or an opposer chooses to rely upon ownership of a registered mark. See: *In re Calgon Corporation*, 168 USPQ 278 (CC-PA, 1971) and *King Candy Company v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA, 1974). This is not to imply that long and extensive contemporaneous use of the marks of the involved parties without evidence of actual confusion arising is not a viable factor that may be cranked into a resolution of the question of likelihood of confusion, but the application thereof in an ex parte proceeding wherein the registrant has no opportunity to be heard thereon is of dubious probative value. And, it has been held that any doubt that may arise on the

question of likelihood of confusion in a proceeding of this character should be resolved in behalf of the prior registrant. See: *In re Apparel, Inc.*, 151 USPQ 353 (CCPA, 1966).

[4] The adoption of the words "as applied to the goods of the applicant," in Section 2(d) of the Lanham Act in lieu of the phrase "goods of the same descriptive properties" previously employed in Section 5 of the Act of 1905 reflects an intent to transcend class restrictions and, a recognition that confusion in trade can occur between goods falling within different classes as well as within a single class in view of the advances made in marketing techniques and communications media as well as the industrial trend toward expansion, diversification and the like, often under the same or similar marks. As set forth by the Commissioner in *Ex parte Quaker Hair Goods Co.*, 82 USPQ 445 (1949).

"Under the Act of 1905 (Section 5), a prior registration could be considered as a bar to registration only when it was appropriated to merchandise of the same descriptive properties." The elimination of this language in the new Act apparently provides a more flexible test and will require refusal of registration in cases where there is likelihood of confusion, mistake, or deception, even though the goods fall into different categories, while presumably permitting registration in the case of goods which fall within the same general class, but as to which it is apparent that confusion is unlikely."

[5, 6] The respective arguments of applicant and the Examiner have been considered in light of the foregoing and the evidence adduced by the Examiner revealing the existence of fungus resisting and inhibiting paints as one of many types of paints offered by a number of paint and chemical manufacturers. Upon due consideration, it is our opinion that it is not unreasonable to assume that an industrial owner producing products that may be exposed in use to a fungus inducing environment may elect to treat the exposed surfaces of the goods with a liquid fungicide either before or after applying an enamel coating. Thus, if the individuals responsible for the purchase or use of these products were to encounter them under the identical arbitrary mark "COPOLOID", it is within the parameters of reason to suppose that they would mistakenly assume that they emanate from the same source. The fact that these purchasers may be, as described by applicant, careful and sophisticated in-

dividuals does not preclude the result reached herein because they, more than the average person, would be aware of the diversity of products marketed by chemical and paint companies and would therefore be more apt to be misled by the identity of the marks into equating the situation herein with such knowledge and hence the products with a single source.

Decision

The refusal of registration is affirmed.

Patent and Trademark Office Trademark Trial and Appeal Board

In re TMS Corporation of the Americas

Decided Aug. 15, 1978

TRADEMARKS

1. Marks and names subject to ownership — Descriptive — How determined (§67.5073)

Question of whether particular term is merely descriptive within meaning of Lanham Act Section 2(e)(1) must be determined not in abstract, but in relation to goods or services for which registration is sought, context in which it is used, and significance it is likely to have to average purchaser as he encounters goods or services in marketplace.

2. Marks and names subject to ownership — Descriptive — In general (§67.5071)

Marks and names subject to ownership — Descriptive — How determined (§67.5073)

Marks and names subject to ownership — Secondary meaning (§67.5073)

Marks and names subject to ownership — Suggestive (§67.5078)

There is but thin line of demarcation between suggestive term and merely descriptive designation, and it is often quite difficult to determine permissible scope of

suggestiveness, and impermissible descriptive connotation of term; distinction is often made on intuitive basis rather than as result of logical analysis susceptible of articulation; consensus of criteria to be used in determining when term is suggestive and when it enters into realm of merely descriptive designation that should remain in lexicon of language peculiar to marketing area or business absent showing of secondary meaning is that term is suggestive if it requires imagination, thought, and perception to reach conclusion as to nature of goods or services; term is descriptive if it forthwith conveys immediate idea of ingredients, qualities or characteristics of goods or services, and, test is whether term is so close and direct that it is apparently descriptive and generally useful in approximately that form to all merchants marketing such goods or services or is so remote and subtle that it is fanciful and not needed by other merchants of similar goods or services.

3. Marks and names subject to ownership — Descriptive — Misdescriptive or not descriptive — Particular marks (§67.5078)

"The Money Service" is suggestive and not merely descriptive of financial services in which funds are transferred to and from savings account from locations remote from associated financial institution.

Appeal from Examiner of Trademarks.

Application for registration of service mark of TMS Corporation of the Americas, Serial No. 52,794, filed May 19, 1975. From decision refusing registration, applicant appeals. Reversed.

Edmond T. Parraude, and Carl C. Batz, both of Oak Brook, Ill., for applicant.

Before Lefkowitz, Rice, and Fowler, Members.

Fowler, Member.

An application has been filed by TMS Corporation of the Americas to register the notation "THE MONEY SERVICE" as a service mark for financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution, use of the mark since December 12, 1974 being asserted.

* Application Serial No. 52,794, filed May 19, 1975.

Registration has been refused under Section 2(e)(1) of the Trademark Act on the ground that the mark as applied to the goods is merely descriptive thereof.

Applicant has appealed.

The record shows that applicant's service operates in the following manner:

A holder of a savings account in a licensed institution is issued an identification card bearing the mark proposed for registration, and including certain magnetically encoded information. The licensed savings institution arranges with one or more retail establishments to open accounts at the institution, and to install electronic service terminals at its stores. The terminals are connected via telephone lines to the central computer of the savings institution. Each card holder may then go to one of the stores, present his card, provide his own secret security code, and via a telephone connection between the remote service terminal at the store and the central computer, an instantaneous transaction is effected whereby funds are transferred between the card holder's savings account and the account of the retail establishment.

It is the position of the Examiner that the mark proposed for registration, namely, "THE MONEY SERVICE" describes the purpose of applicant's service which is to arrange for the transfer of funds (or money) to and from savings accounts from remote locations. The Examiner further contends that the purpose of Section 2(e)(1) of the Statute is to prevent ordinary or descriptive language from being appropriated as a trademark, thereby preventing others offering the same or similar services from using such language in a descriptive way, and that so far as the instant case is concerned, banks and the financial community as a whole would be unnecessarily damaged if they were deprived of the right to use the term "THE MONEY SERVICE" to advertise or generally promote a variety of "money services" identical or similar to applicant's.

Applicant, on the other hand, contends that the term "THE MONEY SERVICE" suggests some form of monetary service, but that it does not in any way describe applicant's actual service; that there are many types of services involving money which are commonly offered to the public, such as check cashing, coin and bill changing, operation of loan offices, banking and checking services, and exchange of foreign currencies, but none known as "THE MONEY SERVICE", and, furthermore,

applicant's mark does not describe the purpose of its service nor is it merely descriptive of the service offered under the mark.

[1] It is well settled that the question of whether a particular term is merely descriptive within the meaning of Section 2(e)(1) of the Act must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is used, and the significance it is likely to have to the average purchaser as he encounters the goods or services in the marketplace. See: *Rosslux Chemical Co., et al. v. Parsons Ammonia Company, Inc.*, 132 USPQ 627 (CCPA, 1962); *O-Tips, Inc. v. Johnson & Johnson*, 95 USPQ 264 (DC N.J., 1952); and *In re Chicago Pneumatic Tool Company*, 160 USPQ 628 (TT&A Bd., 1968).

[2] It is also well settled that there is but a thin line of demarcation between a suggestive term and a merely descriptive designation, and that it is often quite difficult to determine the permissible scope of suggestiveness and the impermissible descriptive connotation of a term. And as indicated in *Union Carbide Corporation v. Ever-Ready Incorporated, et al.*, 188 USPQ 623 (CA 7, 1976) the distinction is "undoubtedly often made on an intuitive basis rather than as a result of a logical analysis susceptible of articulation." See also *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 189 USPQ 759 (CA 2, 1976); and *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 160 USPQ 777 (DC N.Y., 1968). Many tribunals have formulated criteria to be used in determining when a term is suggestive and when a term enters into the realm of a merely descriptive designation, that, absent a showing of secondary meaning, should remain in the lexicon of the language peculiar to a marketing area or business. It is believed that a consensus of these criteria has been appropriately and cogently stated in *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, supra as follows:

"A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods (or services). A term is descriptive if it forthwith conveys an immediate idea of ingredients, qualities or characteristics of goods (or services). The test is whether the term is so close and direct that it is apparently descriptive and generally useful in approximately that form to all merchants marketing such goods (or services) or is so remote and subtle that it is

fanciful and not needed by other merchants of similar goods (or services)."

[3] After considering carefully applicant's mark "THE MONEY SERVICE" in relation to the services set forth in its application papers, namely, financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution, it is our opinion that because the mark "THE MONEY SERVICE" is composed of commonly used words of the English language, it suggests a number of things, but yet falls short of describing applicant's services in any one degree of particularity. To effect a readily understood connection between applicant's mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation. In short, what we are saying is that applicant's mark "THE MONEY SERVICE" does not directly or indirectly convey any vital purposes, characteristics or qualities of applicant's services. Thus, the mark is suggestive and not a merely descriptive designation.

Decision

The refusal to register under Section 2(e)(1) of the Statute is reversed.

2. Title — Employer and employee — Assignment (\$66,303)

Company, whose employee had task of developing new products for company and did so with company assistance is entitled to patent granted; fiduciary duties of loyalty, good faith, and fair dealing, which are owed by employee-inventor that is president and director of company to employer as prescribed by Minn. Stat. Sec. 301.3, require that he make assignment of patent rights to company; agreement stating that "any idea, patent application or patent, in connection with product development or manufacturing techniques or operation will be fully assigned to the company, without direct additional remuneration" is not lacking in mutuality of obligation, invalid for being unlimited in time, is sufficiently limited as to scope of invention and is valid and enforceable.

Particular patents — Texture Composition

3,897,577, Hynes, Dry Particulate Blend Containing Binder/Dispersion Aid Component Comprising Cellulosic and Vinylic Acetate and/or Alcohol Materials and Method of Using Blend in a Roll-On Texture Composition, title determined.

Action by National Texture Corporation, against Richard H. Hynes, for declaratory judgment of patent ownership, and for assignment of patent rights. Judgment for plaintiff.

Alan G. Carlson, Thomas M. Meschesher, and Merchant, Gould, Smith, Edell, Welter & Schmidt, P.A., all of Minneapolis, Minn., for plaintiff.

Orrin M. Haugen, Salvatore S. Cecere, and Kressel & Cecere, all of Minneapolis, Minn., for defendant.

Posten, Judge.

Minnesota District Court, Hennepin County, Fourth Judicial District
National Texture Corporation
v. Hynes
No. 722018
Decided Dec. 21, 1977

PATENTS

1. Title — In general (\$66,001)

Title — Employer and employee — In general

Identity of party that pays legal fees for patent is significant factor in deciding patent ownership.

The above-entitled matter came on for trial before the undersigned, one of the judges of the above-named court, without a jury, commencing on May 4, 1977, and concluding on May 25, 1977. Alan G. Carlson, Esq., and Thomas M. Meschesher, Esq., appeared as counsel for and on behalf of plaintiff. Orrin M. Haugen, Esq., and Salvatore S. Cecere, Esq., appeared as counsel for and on behalf of defendant.

The Court after hearing the evidence adduced at trial and the arguments of counsel, and after reviewing the briefs submitted, and upon all the files, records, and proceedings herein, makes the following:

two marks convey a single commercial impression. This theory is essential to its case because Brunswick clearly has superior rights in the marks "IMPERIAL" and the design of a crown, considered separately. Thus, the earliest conceivable date that Betti could establish for its claim of prior rights to "IMPERIAL" for billiard equipment is December 31, 1968. Brunswick, on the other hand, has unchallenged evidence of continuous use of "IMPERIAL" on bowling balls since May 3, 1961.³⁰ The earliest conceivable date Betti might prove for its crown design is the same date, i.e. December 31, 1968; however, Brunswick has continuously used its crown design on bowling pins since the mid-1930's.³¹ Thus, opposer's claim of superior rights hangs on the tiny thread that, whereas Brunswick might have priority of use of the two marks separately, Betti was first to put the marks together, hence it has superior rights to the combination.

The problem with opposer's theory is that it is not supported by the facts. None of the materials introduced by opposer shows that its products were ever referred to as "CROWN IMPERIAL" products. In its presentation of the marks, the crown design is used in association with "IMPERIAL," merely because the association is appropriate i.e. "IMPERIAL" relates to sovereigns and sovereigns wear crowns. However, no purchaser would be likely to verbalize Betti's crown design together with the word "IMPERIAL" because the two signs do not go together logically in the minds of purchasers. The combination "CROWN IMPERIAL" has no meaning in respect of bowling balls, or billiards, or anything else. Its only meaning is that which is conveyed by its two separate parts, "CROWN" and "IMPERIAL." As to the first part, since opposer has pleaded that the design of a crown and the word "crown" convey the same commercial impression, it cannot contest Brunswick's right to use the word "CROWN," based on its priority as to the same design. Similarly, Brunswick has priority as to the word "IMPERIAL."

Furthermore, Brunswick's use of the combination word mark "CROWN IMPERIAL" is supported by its prior use of the same mark on capital bowling equipment. Because of the nature of use of this capital equipment, there is no question that the subsequent use of the same mark on

bowling balls is closely related in the minds of purchasers, as it must be for tracking of the uses to apply. *Viking Boat Co. v. Viking Camera Supply, Inc.*, 191, USPQ 297 (1976). We have no doubt that many, if not most, bowlers are avid in their devotion to the game. There are also many who remain avid over a long period of their active lives. Accordingly, the consumer impressions gained by bowlers through their exposure to marks used in association with capital equipment in the alleys which they frequent are apt to be significant and lasting impressions. Therefore, even though the active sales of "CROWN IMPERIAL" capital bowling equipment terminated in 1961, the fact that the sales were so extensive, that the mark continued to be exposed to many bowlers in the United States, and that Brunswick continued to use other marks comprising one or the other of the elements of which the mark was comprised leads us to conclude that there was a sufficient awareness of this mark among bowlers in 1976 to support the new, related use on bowling balls. It is conceded that fifteen years is a long period of time. However, the Brunswick situation is uniquely different than any we have found in the reported cases. It is also important to note that we are concerned here with priority rights of an applicant, not an opposer. In this environment, it is inconceivable to us on the facts presented, that a bowler purchasing a bowling ball would associate the mark "CROWN IMPERIAL" used thereon with any other source than Brunswick. This is precisely the trade identity right that applicant seeks to register.

Decision

The opposition is dismissed.

Patent and Trademark Office Trademark Trial and Appeal Board

Plus Products v. Medical Modalities Associates, Inc.

Decided Sept. 4, 1981

TRADEMARKS

1. Marks and names subject to ownership — Descriptive — Misdescriptive or not descriptive — Particular marks (§67.507.6)

Marks and names subject to ownership — Suggestive (§67.528)

Registration — Effect (§67.747)

Lanham Act Section 7(b) presumptions that would be afforded registrations of unitary or composite marks "Ca-PLUS," "Zn-PLUS," and "Mn-PLUS," would extend only to marks as whole and not to any of their components separate and apart from each other; under these circumstances, registrations of these terms cannot serve to preclude opposer or others in trade from making fair use of chemical symbols in describing particular nature of products that they sell; none of these marks possesses merely descriptive significance; at most, each of these marks suggests presence in particular product of chemical material identified by symbol and something more as other ingredients; to extent that there is nothing in marks or, in particular, term "PLUS" to indicate with any degree of particularity just what this something is, marks fall within suggestive range of trademark spectrum although possibly somewhere in far end of this range of marks; "Zn-PLUS," "Ca-PLUS" and "Mn-PLUS," for nutritional supplements, do not per se fall within category of marks proscribed by Section 2(e)(1).

2. Estoppel — Trademarks — In general (§35.351)

Laches — Trademarks (§44.25)

Equitable defenses of estoppel and laches are not available in proceeding wherein adverse party is claiming that mark in question inherently cannot function as trademark under statute; rationale is that it is within public interest to avoid registration of non-registrable subject matter that falls within public or private domain and that this interest or concern cannot be waived by inaction of any single person or concern; no matter how long delay persists.

3. Defenses — Trademark cases (§30.20) Estoppel — Trademarks — In general (§35.351)

Laches — Trademarks (§44.25)

Equitable defenses enumerated in Lanham Act Section 19 are available in opposition proceeding; elements necessary to establish equitable defense of laches normally involve knowledge, actual or constructive, of subsequent party's use of same or similar mark for like or related goods, inordinate delay under particular fact situation in taking some affirmative action to preclude such further use, and reliance on such inaction or silence by junior user; estoppel is based upon ethical consideration of not allowing party to preclude course of conduct that he tolerated, when result will be prejudicial to person who relied on and acted on belief that activity was sanctioned by that party.

4. Registration — Effect (§67.747)

Registration — Supplemental Register (§67.665)

Supplemental registration is not entitled to constructive notice provisions of Lanham Act Section 22.

5. Laches — Trademarks (§44.25)

Opposer that learned of applicant's use of marks in latter part of 1974, objected to such use in January 1975, and filed opposition proceedings in 1976 and 1977, did not delay too inordinately after putting applicant on notice of its objection.

6. Acquisition of marks — Use of plurality of marks (§67.087)

It must be demonstrated not only that number of similarly composed marks enjoy viable life, but that number of them have been promoted together in such manner and to such extent over period of years so as to create association by purchasing public of these marks through common feature or common structures of marks, in order to establish or achieve family of marks; however, where adverse party's use of similarly composed term antedates claimant's use, and registration of first member of asserted family, question arises as to whether doctrine of family of marks can properly be asserted in proceeding involving prior user.

7. Identity and similarity — Words — Similar (§67.4117)

Highly suggestive character of "Zn-PLUS," "Mn-PLUS," and "Ca-PLUS" for nutritional supplements, creates

³⁰ Supra, at fn. (11).

³¹ Supra, at fn. (12).

different commercial impression from that projected by "Plus," per se, for food supplements and cosmetic products.

Trademark oppositions No. 57,922, 58,798, and 59,496, by Plus Products, against Medical Modalities Associates, Inc., applications, Serial Nos. 31,625, 31,606, and 31,618, filed Sept. 9, 1974. Oppositions dismissed.

Bechter, Mockabee, Arant, Jagger & Bachard, Los Angeles, Calif., and Rogers, Hoge & Hills, New York, N.Y., for Plus Products.

Hill, Gross, Simpson, Van Santen, Stredman, Chiara & Simpson, Chicago, Ill., for Medical Modalities Associates, Inc.

Before Lefkowitz, Kera*, and Allen, Members.

Lefkowitz, Member.

Medical Modalities Associates, Inc., assignee of Miller Pharmaceutical Company, is seeking to register the mark "Zn-PLUS" for a nutritional supplement including zinc, with use thereof since October 1969 being claimed; the mark "Mn-PLUS" for a nutritional supplement including manganese protein complex, with a claimed date of first use of September 15, 1970,² and "CA-PLUS" for a calcium protein complex, with a date of first use of May 26, 1969.³

In each of the applications, applicant was able to persuade the Trademark Attorney that the mark in question has become distinctive of its goods in commerce.

Registration, in each instance, has been opposed by Plus Products on substantially the same grounds, namely, that opposer has made prior use of the designation "PLUS" as the significant feature of its trade name and as a trademark in connection with the sale and advertising of food supplements of a general nature and cosmetic products; that opposer's business under its "PLUS" trade designations has been substantial, and its products have been advertised, sold and used throughout the country; that opposer is the owner of Registration No. 789,307,

issued May 11, 1965, covering the mark "PLUS" for high protein vitamin products and mineral food fortifiers as well as for food supplements and fortifiers and of Registration No. 1,035,610, issued March 16, 1976 for "PLUS" for cosmetics; that the goods to which applicant applies its marks are sufficiently related to those of opposer so that they appeal to the same trade and to the same purchasers and prospective purchasers; that applicant's trademarks are sufficiently related to and suggestive of "PLUS" with respect to connotation, meaning, imagery and appeal "in light of current and prevailing attitudes with respect to food supplements and cosmetics generally" * * *, and that the registration of the marks "Zn-PLUS", "Mn-PLUS", and "CA-PLUS" by applicant would cause damage to opposer.

"* * * because of the likelihood of creating confusion, mistake and deception on the part of the public and would cause an erroneous assumption on the part of the public that goods of applicant's manufacture carrying the trademark ZN-PLUS [MN-PLUS and CA PLUS] were goods emanating from Opposer" [or that goods of Opposer's manufacture carrying the trademark PLUS were goods emanating from Applicant].

Applicant, in its answers to the oppositions, has denied and/or left opposer with the burden of establishing the allegations upon which it has predicated its claim; that the contemporaneous use of applicant's marks and that of opposer for their respective products will be likely to conflict in the marketplace and cause confusion or mistake as to the origin of the products.

Applicant, by leave of the Board, subsequently amended its answers to include, as an affirmative defense, the following:

"That Opposer is estopped from any opposition to Applicant's registration(s) due to laches and acquiescence; that Opposer, based on applicant's information and belief, knew or should have known for many years of applicant's use of its family of marks including 'Fe-PLUS' (first claimed use October 31, 1962, and registered on Supplemental Register October 4, 1966, No. 816, 369), 'Mg-Plus' (first claimed use April 12, 1965, and registered on Supplemental Register February 21, 1967, No. 824,634), 'Zn-PLUS' (first claimed use October 1969), 'Ca-PLUS' (first claimed use May 26, 1965), and 'Mn-PLUS' (first claimed use September 15, 1970).

"That Opposer by its knowing silence for many years in allowing applicant to make extensive advertising expenses and develop a valuable reservoir of good will associated with its family of marks is guilty of laches and has acquiesced to Applicant's use of its family of marks such that it should not now be permitted to deny registration to Applicant."

Opposer, in turn, was permitted to amend the oppositions to allege that each of the terms "Zn-PLUS", "Mn-PLUS" and "Ca-PLUS" as used by applicant

"* * * does not indicate origin of the goods, does not serve as Applicant's trademark, is primarily descriptive of the goods, and as a consequence is not registrable on either the Principal Register or the Supplemental Register."

Applicant has denied that the marks in issue, as it uses them, are primarily descriptive and that they fail to designate the origin of applicant's goods.

Opposer's motion to consolidate the three oppositions was granted on the ground that they presented common issues that could be determined on the basis of common facts, and they moved to final hearing on the same record and briefs.

The record consists of the pleadings in the oppositions; the files of applicant's application, status and title copies of opposer's pleaded registrations introduced in accordance with Rule 2.122(c) revealing their currency and that a combined Section 8 and 15 affidavit has been filed by opposer in connection with Registration No. 793,307; the discovery depositions of two officials of opposer corporation taken by applicant; answers by each party to interrogatories and requests for admissions propounded by the other; documents and/or things produced by each party in response to the other's request for production pursuant to a stipulation of the parties; a declaration of an employee of opposer corporation "Respecting Products Available", a letter plus exhibits from applicant's counsel to opposer's counsel, and sales figures given by telephone to opposer's counsel by applicant's counsel, all by stipulation; trial testimony in behalf

of applicant; and copies of official records noticed by each party under Rule 2.122(c). The issues have been extensively briefed by the parties who were represented at the oral argument on this matter.

According to the record, opposer and its predecessor, a partnership, Plus Products, composed of two brothers, James and Arthur Ingoldby, have continuously, since 1940 in intrastate commerce and 1971 in interstate commerce, used the designation "PLUS" as the salient feature of their trade names and/or as a mark, per se, in connection with an extensive and expanding line of vitamins, minerals, food supplements, high protein products and similar goods for human consumption. Opposer has used the trademark "PLUS" in several guises, including capital letters, block lettering, lower case type with a capital "P", lower case type with lower case "p", sometimes in what might be designated as printed script, and in a form in which a "bullseye" design is incorporated in the letter "P".

Opposer has marketed Vitamin A and D preparations, Vitamin B complex, Vitamin C & E products, Multiple Vitamin Formulas, and Mineral Supplements since 1940; proteins and liver preparations and digestive aids since prior to 1954; "Tiger's Milk" high protein products since 1955; lecithin and oils as well as yeast from about 1956; skin and hair products since 1963; and "Better Way Granola" since about 1975. Included among the many products sold by opposer are manganese and magnesium supplements, chelated zinc, iron, calcium, copper, and chromium products; a potassium complex, and a chelated multi-mineral preparation. The "PLUS" mark appears on the labels for the products generally in a prominent fashion above and separated from the product designation for the goods contained therein, whether it be "FORMULA 21", "Iron Supplement", "Magnesium Oxide", or the like. The only exception to this practice has been the sale of a "YEAST PLUS" product.

Opposer's "PLUS" products are available in various forms, including powders, tablets, capsules, liquids, some coated and non-coated, some chewable forms, and some carried in vegetable oil as Vitamin E. These products are also offered in different size containers including containers holding from fifty to a thousand tablets and capsules and holding from one ounce to three and a half ounces of liquids or powders. All of these containers, as previously indicated, bear the notation "PLUS" in a prominent fashion.

* Board Member Kera resigned from Government service before an opinion was drafted in this case and hence did not participate in the resolution of the issues herein.

¹ Ser. No. 31,625 [Opposition No. 57,922].
² Ser. No. 31,618 [Opposition No. 59,496].
³ Ser. No. 31,606 [Opposition No. 58,798].

In the 1940's, opposer and its predecessor distributed their "PLUS" products essentially to chiropractors by mail. In the early 1950's, in addition to chiropractors, opposer sold directly to consumers through mail-order techniques. Starting in the mid-1950's, opposer began distributing its products largely through health food distributors to health food stores, grocery stores, drug stores, etc. It has been estimated that currently five percent of opposer's sales are direct mail-order sales, ten percent of the sales are made to drug stores and supermarkets, and eighty-five percent of the total are through health food jobbers or distributors largely to health food stores, although assertedly no restriction as to trade channels are placed on the distributors. Sales of "PLUS" products have been made in all fifty states of the United States.

Opposer has promoted "PLUS" products through the distribution of catalogs, brochures, pamphlets, price lists, and similar material and by advertising in the publications "Better Nutrition," "Let's Live," "Health Food Retailing," "Foods for Health and Enjoyment," "Today's Living," "Family Health," "Prevention," "World Health Ecology News," "Health Food Age," "Balanced Foods Magazine," "Best Ways," and "Organic Gardening." Opposer's advertisements are directed to its "PLUS" products generally rather than to any one specific preparation.

Opposer's products are not prescription items and, as such, are not detailed to physicians although there is testimony that some mailings have been made to doctors; that opposer has exhibited "a couple of years" at conventions of nutritionists and chiropractors; and that opposer "tries" to attend "conventions that are nutritionally oriented." While "PLUS" products have been sold to some extent in drug stores, opposer has not directed any advertising to the retail drug trade. Opposer's advertising and promotional expenditures directed to "PLUS" products totaled more than one million three hundred thousand dollars for the period from 1970 through 1974. Over five hundred thousand dollars were spent in 1975 and about four hundred and seventy thousand dollars in 1976.

These expenditures generated sales in excess of forty million dollars (at prices to distributors) for the same five-year interval through 1974; sales in 1975 were larger than those in 1975 and approximated thirteen million dollars in 1976, and, in 1977, sales totaled around sixteen and a half million dollars. One hundred percent of these sales

were under the "PLUS" marks and/or trade name.

There is testimony to the effect that it is a normal procedure for opposer's salesmen to look for competitive products under marks similar to "PLUS" and to inform the Vice-President of Sales Marketing of any such findings; that this information eventually is passed on to opposer's counsel for appropriate action; that applicant's use of its mark first came to opposer's attention sometime in 1974, that a letter was sent to applicant's distributor, Miller Laboratories in St. Louis, Missouri, on January 25, 1975 charging that the use of the marks "Min-PLUS" and "Zn-PLUS" infringed opposer's "PLUS" marks; and that a similar letter was sent to applicant in March 1975. The subject oppositions were filed in early 1976 and 1977.

There is also testimony by opposer's Executive Vice-President to the effect that he maintains a "Physicians Desk Reference" so as to be aware of what is happening in the field of nutrition.

It has generally been conceded by opposer that it is unaware of any actual confusion, misdirected mail or any other indicia of trade or consumer confusion, or mistake arising from the contemporaneous activities of the parties under their respective marks.

Applicant, Medical Modalities, Inc., is the successor in interest to the business of Miller Pharmaceutical Company and the assignee of all rights of said company in the trademarks sought to be registered together with the goodwill of the business under said marks as a result of an assignment dated July 10, 1976. Today, Miller Pharmaceutical Company operates as the Miller Pharmaceutical Division of applicant company. Applicant's predecessor, Miller Pharmaceutical Company, was formed in 1958 by John Miller, a noted biochemist and a pioneer in efforts to bring nutrition and mineral therapy into widespread use in human medicine through mineral supplements to improve bodily use of the minerals and treat human deficiencies therein. Under his direction and specifications, pharmaceuticals were produced and marketed for human consumption by Miller Pharmaceutical through its sales force and under the company name and mark. In conjunction with these sales, the Miller Pharmaceutical Company undertook to educate the medical profession as to the benefits and the importance of mineral supplements and vitamins and, in particular, the advantages of chelatin minerals. This was accomplished through the conduct

of professional seminars throughout the country, contacting and detailing physicians and medical institutions, attending medical conventions and monthly mailings of medical literature in the field along with and the house organ, "Miller News and Excerpts" to physicians. As a consequence, Miller Pharmaceutical Company achieved a degree of recognition and notoriety in the field. The initial products produced and sold by Miller Pharmaceutical Company in 1958 were used in treating arthritis; they were distributed nationally to physicians, druggists, and drug wholesalers; and they were advertised in journals and reference books directed to physicians and druggists. Again, it should be noted that these products were marketed under the Miller name or mark.

In 1962, Miller Chemical Company conceived of the idea of marketing a series of pharmaceutical products in the nature of single, mineral specific dietary supplements to an imbalance therein. It was also decided that these "mineral specific" products be marketed under a common trademark style consisting of the chemical symbol for the specific mineral and the word "PLUS".

The program was initiated on October 31, 1962 with the introduction and marketing of an iron protein complex under the mark "Fe-PLUS". The product was and continues to be an enhanced chelatin iron complex. Before adopting the "Fe-PLUS" mark, Miller Pharmaceutical assertedly researched all available medical journals including the "Red Book", the "Blue Book", the "Physician's Desk Reference" and similar publications, from which it was concluded that the company could go forward with its use of the mark. Miller Pharmaceutical went national with the product and achieved distribution substantially throughout the forty-eight contiguous states. An application to register the mark "Fe-PLUS" on the Principal Register, was filed on October 1, 1966, but it subsequently issued on the Supplemental Register on October 4, 1966 [Registration No. 816,369]. An affidavit under Section 8 was accepted.

In accordance with its intent to market a line of related single mineral specific products under a common related trademark, Miller Pharmaceutical introduced

and marketed a magnesium protein complex under the mark "Mg-PLUS" on April 12, 1965. An application to register the mark "Mg-PLUS" on the Principal Register was filed on October 1, 1965, but this mark was also registered on the Supplemental Register on February 21, 1967 [Registration No. 824,634]. A Section 8 affidavit was also accepted in connection with this registration.

The product line moved on with the introduction and sale of a calcium protein complex under the mark "Ca-PLUS" in May 1969. This was followed with the offering and marketing of a zinc supplement under the designation "Zn-PLUS" in October 1969. On or around September 15, 1970, Miller Pharmaceutical began to sell a manganese supplement under the designation "Mn-PLUS". Additionally, a magnesium and ascorbic acid supplement was added under the mark "Mg & C". The most recent addition to the line is a copper protein complex marketed under the mark "Cu-PLUS". There is testimony that applicant has plans for the future marketing of a potassium supplement under the mark "K-PLUS", a selenium protein complex identified by the term "Se-PLUS" and possibly a chromium supplement under the mark "Cr-PLUS".

Both applicant and its predecessor have marketed these mineral supplements in containers bearing a common label format featuring the particular supplement mark as the trademark for the product with the term "MILLER" displayed at the bottom of the letter in a stylized logo. These products have been continuously sold throughout all of the United States with the exception of Alaska through drug wholesalers, druggists, and physicians. Although available in over-the-counter sections of drug stores, the products have been extensively distributed and promoted to physicians who frequently write prescriptions for the preparations. Mail orders are filled for wholesale customers. Although applicant and its predecessor have, over the years, distributed their mineral supplements through drug and medical channels primarily, there is testimony acknowledging distribution in some areas in health food stores, namely, in Arizona and in California where there are "a couple of health food stores" that carry the products.

The products are produced to applicant's specifications by the Heun/Norwood Company, now the Mogul Corporation, and shipped on order from applicant's Miller Pharmaceutical Division, by Miller Laboratories, Inc. of St. Louis, Missouri.

¹ While the records presented for registration show use of the chemical symbols in capital letters, the symbols are consistently used by applicant as "Fe", "Ce", "Mg", and so forth.

Applicant and its predecessor have continued to promote its mineral supplements through the distribution of educational flyers and reprints of various research articles, drug cards bearing the various trademarks and including information on each of the products, individual product brochures, and similar literature directed to physicians and others in the medical profession, as well as to druggists and drug wholesalers, through personal contact with physicians and druggists, and through advertisements in national professional magazines such as "Official Journal of the International College of Surgeons," "American Osteopathic Association Yearbook and Directory of Osteopathic Physicians," "The America's Druggists Blue Book," "The Drug Topics Red Book," and "The Physicians Desk Reference." In addition, applicant has utilized medical conventions, symposia, and similar professional meetings to promote its products. Applicant's printed material, as well as its advertising and promotional material have been directed to and have included references to all of its trademarks for its mineral supplements along, on occasion, with the slogan "When You Think of Minerals Think of Miller." Applicant spent a total of about one million dollars promoting its products up to about September 1974 and over one and a half million dollars up to 1976. There is an indication in the record that applicant's advertising and promotional expenditures for all of its products amount to around three hundred thousand dollars a year.

Prior to the filing of these oppositions, about eight hundred thousand bottles of "Zn-PLUS" supplement, fifty thousand bottles of "Ca-PLUS" supplement, and eighty thousand bottles of the "Mn-PLUS" products were sold. Applicant sells approximately fifteen thousand bottles per year of the "Fe-PLUS" complex, with a dollar value of about forty-five thousand dollars. Sales of the new "Cu-PLUS" product have amounted to less than ten thousand dollars a year. No specific sales figures were furnished for the "Mg-PLUS" preparation, but it was estimated that currently sales of all mineral supplements are running at an annual rate of about one hundred thousand bottles, each of which bears one of applicant's mineral supplements trademarks, which corresponds to about six hundred thousand dollars. This represents thirty percent of the gross business of applicant corporation.

There are some twenty-five to twenty-eight products marketed by applicant in addition to the mineral supplements detailed in this opinion.

Although applicant is charged with constructive notice of opposer's Registration No. 789,307, as of the date of registration on May 11, 1965, a time long prior to the filing of the subject application [See Section 22], there is nothing to dispute applicant's testimony that it had no personal knowledge of opposer and its "PLUS" products at any time prior to receipt of opposer's letter in January 1975. Before applicant became aware of opposer's existence, it had introduced and marketed the "Fe-PLUS," "Mn-PLUS," "Ca-PLUS," "Zn-PLUS" and "Mg-PLUS" mineral supplements without any evidence of confusion or association with opposer and/or its "PLUS" products coming to applicant's attention.

[1] Turning to the issues joined in the pleadings, the first one to consider is opposer's claim that the marks in issue "Zn-PLUS," "Ca-PLUS" and "Mn-PLUS" are "primarily" descriptive of applicant's mineral supplements, and that the registration thereof would be inconsistent with opposer's right to utilize the chemical symbols as descriptive designations in connection with its goods. Initially, it should be noted that applicant is not claiming any proprietary rights in the chemical symbols, per se, or in the term "PLUS" alone. Applicant is asserting a right of registration only to the unitary or composite marks "Ca-PLUS," "Zn-PLUS" AND "Mn-PLUS" and the Section 7(b) presumptions that would be afforded registrations of these terms would extend only to the marks as a whole and not to any of their components separate and apart from each other. Under these circumstances, registrations of these terms cannot serve to preclude opposer or others in the trade from making fair use of chemical symbols in describing the particular nature of the products that they sell. See: Pacific Industries, Inc. v. Minnesota Mining and Manufacturing Co., 165 USPQ 631 (CCPA 1970), and Exxon Corporation v. Full-R-Up Systems, Inc., 182 USPQ 443 (TTAB 1974). Significantly though, none of these marks possess a merely descriptive significance. At most, each of these marks suggest the presence in the particular product of the chemical material identified by the symbol and something more as other ingredients. To the extent that there is nothing in the marks or, in particular, the term "PLUS" to indicate with

any degree of particularity just what this something more is, the marks fall within the suggestive range of the trademark spectrum enumerated by various tribunals although possibly somewhere in the far end of this range of marks. In sum, the marks "Zn-PLUS," "Ca-PLUS", and "Mn-PLUS" as used by applicant do not per se fall within the category of marks proscribed by Section 2(e)(1). Butressing applicant's contention that these composite marks function, as trademarks for its goods, apart from applicant's use, and promotion, of these marks, is the testimony of a past Vice-President of applicant corporation and now a direct competitor that these marks have achieved wide recognition in the medical profession, as identifying products of applicant; testimony of two pharmacists and a physician-pharmacist who have been familiar with applicant and its predecessor for a number of years, to the effect that they associate these marks with applicant, and that their customers call for applicant's products by these marks; and testimony by the president of Alcorn, Inc., a company that owns eighty percent of the outstanding stock of applicant corporation to the effect that the single most important factor in the purchase of control of applicant was the existence and success of these marks. All in all, the record does not support opposer's claim for relief on Section 2(e)(1).

[2] Before turning to the salient issue herein, namely, the claim that the registrations sought by applicant are precluded by Section 2(d) of the Statute, the affirmative defense of estoppel by reason of laches raised in the pleadings by applicant must be considered.*

* The affirmative defense was not considered in relation to the Section 2(e)(1) claim because the equitable defenses of estoppel and laches have been held not to be available in a proceeding wherein, as here, the adverse party is claiming that the mark in question inherently cannot function as a trademark under the trademark statute. See: Hanover Star-Milling Co. v. Eisner & Mendelson Co., 240 US 403 (Sup. Ct. 1916); Saxeliner v. Eisner & Mendelson Co., 179 US 19 (Sup. Ct. 1900); My-T-Fine Corporation v. Gertrude Samuels et al., 21 USPQ 94 (2nd Cir. 1934); Ever-Dry Corporation v. Consolidated Cosmetics, 82 USPQ 158 (Cont. 1949); Academy of Motion Picture Arts & Sciences v. Schur & Cohan, Inc., 99 USPQ 316 (Cont. 1953); and W. D. Bryon & Sons, Inc. v. Stein Bros. Mfg. Co., 146 USPQ 313 (TTAB 1965), affirmed, 153 USPQ 749 (CCPA 1967). The rationale behind these series of cases is that it is within the public interest to avoid registration of non-registrable subject matter that falls within

[3] The Board has held that the equitable defenses enumerated in Section 19 of the Statute are available in an opposition proceeding. See: State Steamship Company v. State Marine International, Inc., 183 USPQ 561 (TTAB 1974). The elements necessary to establish the equitable defense of laches normally involve knowledge, actual or constructive, of the subsequent party's use of the same or similar mark for like or related goods; an inordinate delay under the particular fact situation in taking some affirmative action to preclude such further use, and reliance on such inaction or silence by the junior user. The estoppel is based upon the ethical consideration of not allowing a party to preclude a course of conduct that he tolerated, where the result will be prejudicial to the person who relied on and acted on the belief that the activity was sanctioned by said party. See: CBS, Inc. v. Merit Publishing Company, 205 USPQ 470 (TTAB 1980); Loma Linda Food Company v. Thompson's Taylor Spice Co., 126 USPQ 261 (CCPA 1960); and Ralston Purina Company v. Midwest Cordage Company, Inc., 153 USPQ 73 (CCPA 1967).

Applicant has predicated its affirmative defense essentially on the argument that opposer knew or should have known of its composite mineral supplement trademarks by virtue of applicant's open and notorious use thereof in commerce beginning in 1962; applicant's registrations of "Fe-PLUS" and "Mg-PLUS"; the fact that opposer maintains at least one copy of the "Physicians Desk Reference", in which applicant has advertised for years, so as to be aware of what is "happening in the field of nutrition"; and the testimony in behalf of opposer that opposer tries to be aware of its competition. This plus opposer's silence over the years, according to applicant, should estop opposer from now asserting damage from the registrations sought by applicant.

[4, 5] Apart from the fact that applicant's Supplemental Registrations cover marks other than those involved herein, a Supplemental Registration is not entitled to

the public or private domain and that this interest or concern cannot be waived by the inaction of any single person or concern, no matter how long the delay persists.

Section 19 of the statute provides that:

"In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable, may be considered and applied."

the constructive notice provision of Section 22 of the statute. See: Section 26 and R. H. Macy and Co., Inc. v. The Richter and Phillips Company, 115 USPQ 342 (Com. 1957); and Swank, Inc. v. Betty Ann Hats, Inc., 119 USPQ 334 (TTAB 1958). The record supports applicant's use of its mineral compound marks, including the "Zn-PLUS", "Mn-PLUS" and "Ca-PLUS" for a number of years, but considering, for the purpose of the affirmative defense, that applicant has sold and sought to sell its products through physicians and druggists primarily a source only incidentally tapped by opposer, and that applicant's advertising and promotional efforts have been in media not ordinarily utilized by opposer, knowledge of applicant's trademarked goods by opposer cannot be conclusively established in this marketing and promotional environment. Nor can the fact that opposer maintains a copy of the "Physicians Desk Reference" in which applicant has advertised serve to bestow constructive notice of applicant's marks upon opposer. Constructive notice, as distinguished from actual notice, must necessarily be based on a situation or set of circumstances that makes it inconceivable that a party did not know of the other's existence. This is hardly the case herein. In view of opposer's record since 1968 or thereabout in seeking to preclude others from using and/or registering marks consisting of or containing the term "PLUS", it seems inconceivable that, if opposer had known of applicant's use of its mark, it would not have voiced its objections to such use at an earlier time. As it is, the record indicates that opposer learned of applicant's use of the instant marks in the latter part of 1974, objected to such use in January 1975, and filed these proceedings in 1976 and 1977, a not too inordinate delay after putting applicant on notice of its objection. Cf. Bellbrook Dairies, Inc. v. Bowman Dairy Company, 124 USPQ 316 (CCPA 1960) and New England Provision Company, Inc. v. Engelhorn Packing Co., 126 USPQ 522 (TTAB 1960). Moreover, even before opposer's protest, applicant continued to use its marks and to adopt other similarly constructed marks, at least as far as this record shows, not on opposer's inaction, but rather on the belief that there was no conflict between its marks and that of opposer and therefore no likelihood of confusion or infringement — a belief that will not support applicant's equitable defense. See: Clinton Detergent Company v. The Procter & Gamble Company, 133 USPQ 520 (CCPA 1962); Field Enterprises Educational Corporation v. Grosset & Dunlap, Inc., et

al., 150 USPQ 517 (DC NY 1966); Manpower, Inc. v. Manpower Information, Inc., 190 USPQ 18 (TTAB 1976); and Hitachi Metals International v. Yamakyu Chain Kabushiki, 209 USPQ 657 (TTAB 1981). The facts adduced by applicant in this case are, therefore, insufficient to support applicant's affirmative defense.

Now, as to the question of likelihood of confusion under Section 2(d), although priority of use is not ordinarily an issue in an opposition where, as here, opposer is the owner of existing registrations for the mark on which it relies [See: King Candy Company v. Eunice King's Kitchen, Inc., 182 USPQ 108 (CCPA 1974)], the record clearly supports opposer's use of "PLUS" since a time prior to applicant's adoption and its use of its compound marks. As for the goods of the parties, whether they are considered for purposes herein on the basis of the identification of goods in applicant's applications and in opposer's registrations taking into account the lack of any restrictions therein as to trade channels or classes of purchasers or, in light of what the record discloses as to the nature of such goods, their trade channels, and classes of purchasers, it must be held that the parties are offering competitive products to the same classes of purchasers either through the same trade channels or through some of the same outlets including drug stores, health food stores, and similar outlets. See: General Shoe Corp. v. Lever Bros. Mfg. Co., Inc., 117 USPQ 281 (CCPA 1958); United States Steel Corp. v. Bijur Lubricating Corp., 128 USPQ 347 (CCPA 1961); Paula Payne Products Company v. Johnson Publishing Co., Inc., 177 USPQ 76 (CCPA 1973); and Ford Motor Co. v. Ford, 174 USPQ 456 (CCPA 1972). This serves to narrow the issue down to the question as to whether the contemporaneous marketing of these products by the parties under their respective "PLUS" marks is reasonably likely to cause confusion or mistake as to source or product.

On this point, opposer has urged that applicant has incorporated opposer's "PLUS" mark in the marks "Zn-PLUS", "Mn-PLUS" and "Ca-PLUS", and the addition thereto of the known chemical symbols "Zn" [Zinc], "Ca" [Calcium] and "Mn" [manganese] are insufficient to distinguish these marks as a whole from "PLUS", per se, and to avoid confusion in the marketplace.

Applicant, in turn, has argued that the word "PLUS" is a "weak" mark because of its suggestive connotation and its common

use and registration as a component of marks in connection with vitamin, mineral supplements, and medical products; that, as a consequence, opposer possesses limited rights and a limited scope of protection in its "PLUS" marks; and that this limited right cannot extend to preclude applicant from registering its "Zn-PLUS", "Ca-PLUS" and "Mn-PLUS" marks in view of the differences between them and applicant's acquisition of a family of marks in the field characterized by the term "PLUS" preceded by the chemical symbol for a particular mineral supplement.

In regard to the nature of the term "PLUS", applicant has made of record over ninety third-party registrations for marks containing "PLUS" as a suffix in connection with vitamins and related products including such marks as: "VITAMINS PLUS", "VITA PLUS", "FEOSOL PLUS", "4-T PLUS", "PLUS FORM", "PLUS-FACTOR", "SIMRON PLUS", "A PLUS", "STANDARD PLUS", "FOODS PLUS", "IRON PLUS", "FERRO PLUS", "GELETTIN PLUS", "ACEROLA PLUS", "ROSE HIPS PLUS", and "CITRAMINS PLUS"; and actual bottles of vitamins purchased by a witness in the open market bearing the marks "WINDMILL NATURAL SUPER-B PLUS", "WINDMILL NATURAL SUPER-E PLUS", and "IRON-PLUS". In addition, applicant made of record state registrations for a number of marks including "NUTRI-PLUS", "B-PLUS", "VALU-PLUS", "PRO-PLUS", "THERAPEUTIC PLUS", "E PLUS", "OB PLUS", "IRON PLUS" and "URBITRON PLUS". Applicant also directed an attorney on its counsel's staff to review the 1977 "Drug Topics Red Book" to find listings of marks containing the word "PLUS" for pharmaceutical preparations

* Applicant has also contended that its marks are as different from opposer's "PLUS" mark as are the marks "MILK PLUS" and "FOOD PLUS". This is a reference to the fact that, in its application to register the "PLUS" mark, opposer had to distinguish its mark from the cited registered marks "MILK PLUS" and "FOOD PLUS". Opposer was successful in arguing that the initial words of the cited marks distinguished them from opposer's "PLUS" mark. This is obviously a factor to be considered herein, but it does not negate the need to consider whether the use of known chemical terms in conjunction with the term "PLUS" can otherwise serve to distinguish the marks from opposer's "PLUS" mark.

and to write letters to the various parties listed as owners of the marks for information concerning current usage of the marks. Applicant received some seventy answers to its letters, but opposer has objected to these letters largely because of the reference therein to opposer's objections to applicant's mark. The answers to these letters can also be objected to on the ground that the authors or writers of these responses were not available to be questioned about the nature and extent of use of their "PLUS" marks. It would, however, serve no useful purpose to discuss the merits of opposer's objections to the letters and applicant's response thereto because the introduction of such documents would serve only as an "overkill". That is, the record otherwise is sufficient to establish that the term "PLUS" has been frequently adopted and registered as a component of many marks in the vitamin and nutrition field because of its suggestive connotation; and that this Office, at least, has recognized the character of the term to the extent that it has registered compound "PLUS" marks over opposer's "PLUS" mark and over other differences, however, slight between the initial or terminal portions of the marks. As stated by the Board in Plus Prods. v. Redkin Laboratories, Inc., 199 USPQ 111 (TTAB 1978),

"PLUS" is a dictionary word which denotes something better or an additional quality or quantity and, as such, possesses a highly suggestive significance as applied to most classes of goods. The suggestiveness of the term, manifestly is the reason why opposer, applicant, and others in the same or related fields have adopted and used and/or registered as trademarks for their goods designations containing the word "PLUS". While the third-party evidence adduced by applicant cannot, per se, justify the registration of what may be considered to be another confusingly similar mark (See: AMF Incorporated v. American Leisure Products, Inc., 177 USPQ 268 (CCPA 1973) and cases cited therein), it is admissible and competent to delineate opposer's rights in the term "PLUS" and thereby negate any claim of exclusivity in the cosmetic and toiletry fields (See: The Conde Nast Publications, Inc. v. American Greetings Corporation, 141 USPQ 249 (CCPA, 1964)) as well as to suggest that purchasers would be reasonably likely upon encountering these various marks, to attribute to the term "PLUS" its or-

dictionary meaning. See: The Conde Nast Publications, Inc. v. Miss Quality, Inc., 184 USPQ 422 (CCPA, 1975) and Tektronix, Inc. v. Daktronics, Inc., 189 USPQ 693 (CCPA, 1976). The third-party registrations as well as the history of opposer's registration efforts also reflect a practice on the part of the Patent and Trademark Office to register marks containing the term "PLUS" over opposer's mark "PLUS", per se, as well as over other composite marks containing "PLUS" on the basis of other matter associated therewith notwithstanding the descriptive character thereof and notwithstanding that the goods marketed or covered thereby are identical in kind or closely related and would be encountered in the same retail outlets.

This indicates that, although opposer's rights in "PLUS", per se, may not be ignored, the inclusion of the term "PLUS" in two marks utilized in the vitamin and nutrition field may not be a sufficient basis upon which to hold them to be in conflict. It is manifest that it depends upon what has been added to the term "PLUS" and the probable impact of the mark upon purchasers of such goods who are familiar with opposer's "PLUS" products. Compare, for example, American Dietetics Co., Inc. v. Plus Products, 191 USPQ 146 (DC NY, 1976), affirmed (2nd Cir. 1976) ["ACEROLA PLUS" held not to be confusingly similar to "PLUS"]; and Plus Products v. Redkin Laboratories, Inc., supra ["PH-PLUS" held not likely to conflict with "PLUS"]; with Plus Products v. Physicians Formula Cosmetics, 198 USPQ 111 (TTAB 1978) ["FORMULA PLUS" held to be confusingly similar to "PLUS"]; and Plus Products v. Don Hall Laboratories, 191 USPQ 585 (TTAB 1976) ["EARTH PLUS" held to conflict with "PLUS"].

Thus, the question now is whether the addition of the chemical symbols "Ca", "Mn", and "Zn" to "PLUS" is sufficient to create unitary or compound marks that do not and are not likely to conflict with opposer's "PLUS" mark and products in the marketplace. This brings into play applicant's contention that it possesses a family of marks in the mineral nutritional field consisting of the term "PLUS" preceded by the chemical symbols for the products sold thereunder; and that this family of marks possesses its own niche in the field separate and apart from and without impinging upon any goodwill existing in opposer's "PLUS" mark.

[6] In order to establish or achieve a family of marks, it must be demonstrated not only that a number of similarly composed marks enjoy a viable life, but that a number of them have been promoted together in such a manner and to such an extent over a period of years so as to create an association by the purchasing public of these marks through the common feature or common structure of the marks. See: Witco Chemical Co., Inc. v. Whitefield Chemical Co., Inc., 164 USPQ 43 (CCPA 1969) and cases cited therein. However, where an adverse party's use of a similarly composed term antedates the claimant's use and registration of the first member of the asserted family, a question arises as to whether the doctrine of a family of marks can properly be asserted in a proceeding involving the prior user. See: Dap, Inc. v. Flex-O-Glass, Inc., 196 USPQ 438 (TTAB 1976) and Warnaco, Inc. v. Adventure Knits, Inc., 210 USPQ 307 (TTAB 1981).

Applicant has established that it has, since 1962 with the introduction of the "Fe-PLUS" iron supplement, intended to create a line of different mineral supplements under a common format namely, the chemical symbol for the mineral followed by the word "PLUS", that, in the ensuing years, applicant has adopted and used the marks "Zn-PLUS", "Mg-PLUS", "Ca-PLUS" and "Mn-PLUS" in addition to the "Fe-Plus" mark, in connection with specific mineral complexes; that there has, over the years, been a commonality of styling of the marks on the labels for the containers for the goods as well as in applicant's advertising material; that applicant has extensively advertised all of its marks, as they developed through the years, in the same publications; and that applicant has achieved a measure of commercial success in marketing products so marked.

⁹ In an apparent attempt to rebut applicant's claim of a family of marks, opposer has introduced evidence by its National Sales Manager to the effect that he requested his sales staff to visit health food stores conveniently located in California and the West Coast area to purchase dietary supplements which carry a mineral identification in their labels, whether by chemical symbols or full name, coupled with the name "PLUS". In conjunction therewith, opposer has offered copies of the labels located by its staff covering the marks "CALCIUM PLUS", "IRON PLUS", "IRON PLUS TABLETS", "MAGNESIUM OXIDE PLUS", "SUPER SELENIUM PLUS", "NUCLEIC ACID PLUS", "DOLOMITE PLUS", "PREVENTION PLUS DOLOMITE" and "K-PLUS". These marks must first be plac-

Applicant has also adduced testimony by a doctor-pharmacist and two pharmacists, alluded to previously, to the effect that they recognize and associate these marks with applicant, as well as by a former official, now a competitor, and by the president of the company controlling applicant corporation wherein they indicate that these marks are a significant factor in the industry and in applicant's commercial value. Finally, applicant has made of record letters from a number of persons including two manufacturers of pharmaceuticals, one being a competitor and the other both a competitor and supplier, doctors, pharmacists, and customers attesting, inter alia, that they "recognize that Miller Pharmacal Company has a family of PLUS marks". These letters, which appear to be identical except for the identification and background of the writer and are copies of letters submitted in support of applicant's claim of distinctiveness in the ex parte prosecution of the subject applications and are entitled to little, if any, probative value herein notwithstanding that opposer has not specifically and vigorously argued that they should not be considered in resolving the question for which they were offered. The trier of fact has an obligation to evaluate evidence submitted by the parties to determine, apart from any objection thereto, what probative value should be accorded the evidence. In this regard, the following evaluation of similar evidence offered by applicant as petitioner in Medical Modalities Associates, Inc. v. ARA Corp., supra, for a similar purpose, is likewise applicable herein.

"These letters, which appear to be, in essence, identical except possibly for the identification and background of the writer, are entitled to little, if any,

ed in their right perspective in regard to applicant's claim. The family characteristic asserted by applicant is the abbreviation of the chemical symbol promoted in graphics such as "Zn", "Ca" and the like followed by the word "PLUS". All of these marks, with the exception of "K-PLUS" ["K" for potassium] do not follow this pattern, although they are in certain cases equivalents, and applicant was successful in precluding the registration of "K-PLUS" in Medical Modalities Associates, Inc. v. ARA Corp., 203 USPQ 295 (TTAB 1979). Interestingly enough, opposer did not see fit to challenge the registration of the mark "K-PLUS". Moreover, there is nothing to suggest the nature and scope of use of these marks and for what it is worth, it has not been made to appear that opposer has taken steps to prohibit their use.

probative value in an inter partes proceeding, as distinguished from the ex parte application for which they were directed, because the authors were not called as witnesses by petitioner so that they could be interrogated by respondent as to the significance and reasoning behind their statements and especially their understanding of a 'family of marks' which is predicated upon a legal principle, the significance of which would be unfamiliar to the average non-lawyer. This is most significant in view of what was previously alluded to namely, the inference that may be drawn from the sameness of the letters to the effect that this phrase was inserted therein by petitioner's counsel. This is not to suggest that the writers did not agree with this concept but our query is as to what they understood to be the meaning and effect thereof. To accept these letters at their face value as urged by petitioner would do an injustice to our adversary practice as well as to the accepted rules of evidence which provide, in most instances, an opportunity for a party to a proceeding to confront and interrogate witnesses for the other party. And petitioner is clearly attempting to use the writers of these letters as witnesses in its behalf which it cannot properly do by this method in this type of a proceeding."

[7] Notwithstanding the foregoing, the record supports as it did in the above-cited decision that, whether designated as a family of marks or as a family of products similarly constructed, applicant moved into the crowded field of "PLUS" marks in the vitamin and related fields with its "Zn-PLUS", "Ca-PLUS" and "Mn-PLUS" marks, among others, and has established a beachhead therein, although possibly a narrow one, through use and promotion over the years that has survived the test of time by avoiding any known conflict with opposer's mark. That is, in all of the discovery and testimony in this case, no one, applicant or opposer, has been able to claim that any confusion has ever occurred, in spite of long contemporaneous advertising and marketing of competitive type products under their different "PLUS" marks.¹⁰ The only logical conclusion that can be deduced

¹⁰ There is nothing even to suggest that when opposer did learn of applicant, it was the result of a situation wherein someone was confused or misled by applicant's mark.

therefrom is that the highly suggestive character of applicant's mark creates a different commercial impression from that projected by "PLUS", yet so, and that this difference has been sufficient to enable purchasers to avoid being confused as to the origin of the products sold thereunder or from mistakenly purchasing the product of one party when the product of the other party was desired.

Decision

The oppositions are dismissed.

amount of purchase price actually paid or payable.

3. Taxation — Federal on patents and inventions (§65.5)

Stock options given in payment for patents, that did not have readily ascertainable fair market value that could be determined with fair certainty as giving cost basis of patents acquired, are valued by taking value of stock issued under options and subtracting options' exercise price.

4. Taxation — Federal on patents and inventions (§65.5)

Amortization over useful life of most significant patent rather than over average useful life of all patents acquired, is more appropriate, given patent's importance at time of acquisition, and subsequently.

5. Reissue — In general (§38.1)

Reissue patent continues only for unexpired term of original patent.

U.S. Tax Court
Simmonds Precision Products, Inc.
v. Commissioner of Internal Revenue

No. 3130-76

Decided Oct. 14, 1980

PATENTS

1. Taxation — Federal on patents and inventions (§65.5)

Patents constitute intangible property which may be subject of depreciation allowance, or amortization, over their useful lives, under Section 167(a). Internal Revenue Code of 1954, which authorizes, as depreciation deduction, reasonable allowance for exhaustion, wear and tear, including obsolescence, of property used in taxpayer's trade or business.

2. Taxation — Federal on patents and inventions (§65.5)

Total purchase price constitutes basis on which depreciation may be taken by taxpayer who purchased patent for non-contingent, fixed amount; if, however, sales price of patent is expressed by formula by which fixed dollar amount cannot be ascertained until future years, such as royalties that are fraction of sales, purchaser may deduct each year, as depreciation, only

amount of purchase price actually paid or payable.
3. Taxation — Federal on patents and inventions (§65.5)
Stock options given in payment for patents, that did not have readily ascertainable fair market value that could be determined with fair certainty as giving cost basis of patents acquired, are valued by taking value of stock issued under options and subtracting options' exercise price.
4. Taxation — Federal on patents and inventions (§65.5)
Amortization over useful life of most significant patent rather than over average useful life of all patents acquired, is more appropriate, given patent's importance at time of acquisition, and subsequently.
5. Reissue — In general (§38.1)
Reissue patent continues only for unexpired term of original patent.

Petition by Simmonds Precision Products, Inc., against the Commissioner of Internal Revenue, for determination of tax Decision for petitioner.

Sidney I. Roberts, Laurence Goldstein, and Larry Wolf, all of New York, N.Y., for petitioner.

Larry Kars for Commissioner of Internal Revenue.

Hall, Judge.

Respondent determined deficiencies in petitioner's income tax as follows:

| Year | Deficiency |
|------|---------------|
| 1967 | \$ 157,101.66 |
| 1968 | 1,146,581.30 |
| 1969 | 238,562.22 |

Petitioner exchanged its stock and options for patents and other rights owned by Sir Oliver Simmonds and/or his wholly-owned corporations. The primary issue is whether the options had an ascertainable fair market value. If not, and the transaction remained open until the options were exercised, we must determine the proper years for amor-

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tizing and expensing the patents and other rights acquired with the options. If the options had an ascertainable fair market value, we must determine what it was on May 20, 1960.

Findings Of Fact

Some of the facts have been stipulated and are found accordingly.

Petitioner is a New York corporation which had its principal office in Larrytown, New York, when it filed the petition in this case.

Petitioner was incorporated in 1936 under the name of Simmonds Aeroaccessories, Inc. During the period 1960 through the present, petitioner was engaged primarily in the design and manufacture of electronic, hydromechanical, and mechanical systems, instruments, controls and devices for use in connection with missiles, military and commercial aircraft and engines used in aircraft, small boats and vehicles. Its principal product line was fuel gauging systems, primarily for aircraft.

Sir Oliver E. Simmonds ("Sir Oliver") founded petitioner and was a shareholder. Sir Oliver was a nonresident alien of the United States and during the 1960's resided in Nassau, Bahamas. In the 1920's and 1930's, Sir Oliver was a pioneer in the aircraft industry in Britain.

During the 1930's, Sir Oliver established his instrument and equipment companies. He formed an English holding company, Matera Limited ("Matera"), of which he and his wife owned all of the stock. He established Simmonds Development Company Limited ("Simmonds Development"), another English company to hold his patents and licensing agreements. He also established a series of manufacturing companies in various countries, each called Simmonds Aeroaccessories. The manufacturing company in the United States was the predecessor in interest to petitioner.

Sir Oliver moved from England to the Bahamas in the late 1940's. In 1953, Simmonds Development was liquidated and Engineering Research Company, Limited ("Engineering Research"), a Bahamian company controlled by Sir Oliver, succeeded to the assets of Simmonds Development.

When we hereafter refer to Engineering Research, we shall be referring not only to it but also its predecessor, Simmonds Development.

Sir Oliver formed another Bahamian corporation, Twenty First Century Corporation Limited ("Twenty First Century"), which he controlled.

Prior to May 20, 1960, petitioner sold products embodying inventions in the fields of fuel gauging systems and self-locking nuts. The rights to these inventions were licensed to petitioner from Engineering Research under a series of agreements entered into between 1939 and 1957. The basic terms of each of the license agreements with Engineering Research with respect to which petitioner produced fuel gauging systems, provided for a royalty of 5 percent of net sales (of products sold pursuant to the agreement), free of all taxes, and minimum annual royalties to be paid by petitioner to Engineering Research. Royalty payments by petitioner to Engineering Research were subject to withholding tax at a rate of 30 percent under section 871.

These license agreements were incorporated into a single agreement between Engineering Research and petitioner dated October 1, 1956. This agreement increased the minimum annual royalty to \$52,500, net of the 30 percent tax on royalties, or a gross royalty of \$75,000. The 1956 agreement was automatically renewable until January 15, 1969, provided certain sales levels were met. The sales levels necessary for renewal were met.

Among the patents licensed under the 1956 Agreement were U.S. patent No. 2,582,399 issued January 15, 1952, and reissue patent No. 24,082 dated November 1, 1955. These patents were for Adjustable In-Tank Capacitors and Contoured In-Tank Measuring Capacitors, which were essential components of the fuel gauge systems manufactured by petitioner in the 1950's and 1960's and were embodied in all such systems.

Petitioner entered into a sales commission agreement with Twenty First Century on January 31, 1957. Under this agreement, Sir Oliver carried on selling activities and served as a goodwill ambassador for petitioner's products outside of the United States and Canada. Sir Oliver was never employed by

Petitioner entered into a separate sales agreement, dated March 19, 1958, with Simmonds Aeroaccessories of Canada Limited ("SAC"), which was controlled by Sir Oliver. SAC would purchase merchandise from petitioner at a discount of no more than 10 percent, which it then sold to its customers in Canada. This arrange-